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In the Supreme Court of the United States

October Term, 1985

MORGAN ADHESIVES COMPANY,
Petitioner,

vs.

CHEMTROL ADHESIVES, INC.,
Respondent.

ON CERTIORARI TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED FOR REVIEW

Petitioner Morgan Adhesives Company ("Morgan") requests review and reversal of a decision which is in conflict with the decisions of this Court that a patent, once granted, may be invalidated only by a Court properly exercising jurisdiction in a case or controversy in which the validity of the patent is in issue. The questions presented for review are:

1. Is a patentholder denied due process of law when he requests a stay in a patent infringement proceeding in United States District Court in order to seek an advisory opinion on certain prior art from the Patent and Trademark Office pursuant to 37 C.F.R. §1.175(a)(4), appeals the advisory opinion to the Court of Customs and Patent Appeals, and is subsequently held by the Court conducting the infringement suit, as affirmed by the Court of Appeals for the Federal Circuit, to be precluded from asserting the validity of the patent in the infringement proceeding?

2. Does the Patent and Trademark Office or a reviewing appellate court have the power to invalidate a patent in a proceeding for an advisory opinion pursuant to 37 C.F.R. §1.175(a)(3)?

3. When appellate court review is part of the regulatory scheme available to patent reissue applicants, does a patentholder surrender all property rights in the patent by invoking that review?

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OPINIONS

Reference to official and unofficial reports of opinions delivered by the Patent and Trademark Office, Court of Customs and Patent Appeals, Federal District Court for the Northern District of Ohio, Eastern Division, and Court of Appeals for the Federal Circuit are as follows:

1. Patent Examiner's Rejection of Morgan's Reissue Application (October 11, 1978). App., p. A77.
2. Patent Examiner's Rejection of Morgan's Amendatory Matter (March 2, 1979). App., p. A83.
3. Patent Examiner's Rejection of Morgan's Supplemental Response (July 9, 1979). App., p. A86.
4. Patent Office Examiner's Rejection of Amended Reissue Application (November 16, 1979). App., p. A91.

5. Affirmance of the Patent Examiner's Decision by the Board of Appeals for the United States Patent and Trademark Office (October 30, 1980). App., p. A4.

6. Decision of United States Court of Customs and Patent Appeals Affirming Decision of the United States Patent and Trademark Office Board of Appeals (July 9, 1981). App., p. A12.

7. Memorandum of Opinion of Federal District Court for the Northern District of Ohio, Eastern Division, Granting Defendant's Motion for Summary Judgment (May 20, 1983). App., p. A15.

8. Affirmance of the District Court Decision by the United States Court of Appeals for the Federal Circuit (February 7, 1985). App., p. A1.

RULE 28.1 DISCLOSURE

Pursuant to Rule 28.1. Supreme Court Rules, and as previously stated in a letter to this Court dated June 14, 1985, 86.8% of the stock of Petitioner Morgan Adhesives Company is owned by Bemis Company, Inc. This represents full disclosure as required by Rule 28.1.

JURISDICTION

Petitioner seeks review of a decision of the United States Court of Appeals for the Federal Circuit dated February 7, 1985, and entered that same date. App., p. A35. Petitioner's Petition for Rehearing was denied March 8, 1985. App., p. A36. On May 30, 1985, this Court granted Petitioner's request for an extension of time in which to file this Petition until July 6, 1985. Jurisdiction is based upon 28 U.S.C. §1254(1).

PERTINENT CONSTITUTIONAL PROVISIONS, STATUTES AND REGULATIONS

This case involves the following constitutional provisions, statutes, and regulations.

1. Fifth Amendment, United States Constitution:

> No person shall be held to answer for a capital, or otherwise infamous crime, unless on a presentment or indictment of a Grand Jury, except in cases arising in the land or naval forces, or in the Militia, when in actual service in time of War or public danger; nor shall any person be subject for the same offence to be twice put in jeopardy of life or limb; nor shall be compelled in any criminal case to be a witness against himself, nor be deprived of life, liberty, or property, without due process of law; nor shall private property be taken for public use, without just compensation.

2. 35 U.S.C. §141:

> An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Appeals for the Federal Circuit, thereby waiving his right to proceed under section 145 of this title. A party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority may appeal to the United States Court of Appeals for the Federal Circuit, but such appeal shall be dismissed if any adverse party to such interference, within twenty days after the appellant has filed notice of appeal according to section 142 of this title, files notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 146 of this title. Thereupon the appellant shall

have thirty days thereafter within which to file a civil action under section 146, in default of which the decision appealed from shall govern the further proceedings in the case.

3. 35 U.S.C. §251:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commission shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The Commissioner may issue several reissued patents for distinct and separate parts of the thing patented, demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

4. 37 C.F.R. §1.175(a)(1), (2), and (3):

§1.175 Reissue oath or declaration.

(a) Applicants for reissue, in addition to complying with the requirements of § 1.63, must also file with their applications a statement under oath or declaration as follows:

(1) When the applicant verily believes the original patent to be wholly or partly inoperative or invalid, stating such belief and the reasons why.

(2) When it is claimed that such patent is so inoperative or invalid "by reason of a defective specification or drawing," particularly specifying such defects.

(3) When it is claimed that such patent is inoperative or invalid "by reason of the patentee claiming more or less than he had the right to claim in the patent," distinctly specifying the excess or insufficiency in the claims.

5. 37 C.F.R. §1.175(a)(4) (42 Fed. Reg. 5594 (January 28, 1977)), repealed, 47 Fed. Reg. 21,748 (May 19, 1982), providing that a reissue application may be filed:

When the applicant is aware of prior art or other information relevant to patentability, not previously considered by the Office which might cause the examiner to deem the original patent wholly or partly inoperative or invalid, particularly specifying such prior art or other information and requesting that if the examiner so deems, the applicant be permitted to amend the patent and be granted a reissue patent.

6. 37 C.F.R. §1.178:

§1.178 Original patent.

The application for a reissue must be accompanied by an offer to surrender the original patent. The application should also be accompanied by the original patent, or if the original is lost or inaccessible, by an affidavit or declaration to that effect. The application may be accepted for examination in the absence of the original patent or the affidavit or declaration, but one or the other must be supplied before the case is allowed. If a reissue be refused, the original patent will be returned to applicant upon his request.

7. Manual of Patent Examining Procedure, Section 1414.02, App., p, A37.

STATEMENT OF THE CASE

The prematurely invalidated Morgan patent in suit, U.S. No. 3,900,645, was issued on August 19, 1975. The patent covers laminated, pressure-sensitive paper stock used in the production of labels, stickers, tapes and similar items. The patent called for the use of score lines to embrittle, but not cut, the paper stock used as a backing for these labels, thereby facilitating the use of the label. If given its day in Court, Morgan will show that its patented product, sold under the name of "MACbak," and "Starliner," has enjoyed considerable commercial success over the past ten years; so much so, that Morgan's invention is currently being used by all of its major competitors.

On or about February 2, 1976, Morgan filed an infringement action against Chemtrol, which produced similar labels under the name "Chembak." The thrust of Chemtrol's defense was that the Morgan patent was invalid.

Specifically, Chemtrol claimed that some five examples of prior art had not been disclosed to the Patent and Trademark Office ("PTO") at the time the Morgan patent was issued and, if then disclosed, would have prevented issue of the patent.

Morgan moved for a stay of the infringement action to permit it to initiate proceedings before the PTO for an advisory opinion on the effect of the prior art on the Morgan patent, pursuant to 37 C.F.R. §1.175(a)(4). App., p. A41. Under this relatively new procedure, made available for the first time in early 1977, Morgan could obtain consideration of the prior art without surrending its patent to the patent office and without making any changes or amendments to the claims of the patent. Chemtrol was permitted to participate in the proceedings.

The PTO refused to grant Morgan's petition for reissue—i.e., to reflect on the record that the patent had been issued with consideration of the prior art—on the ground that a single example of prior art, the "Karn patent," made the Morgan patent obvious. App., p. A41. The PTO's Board of Appeals affirmed. App., p. A4. The decision was appealed to the United States Court of Custom and Patent Appeals ("CCPA"), as permitted under 35 U.S.C. §141, and that Court affirmed the examiner in a split decision. App., p. A12.

Following the ruling of the CCPA, Chemtrol moved for summary judgment in Morgan's District Court infringement action on its counterclaim of invalidity. Chemtrol claimed that the PTO's actions, as affirmed by the CCPA, collaterally estopped Morgan from arguing the validity of its patent before the District Court.

The District Court granted Chemtrol's Motion for Summary Judgment on alternative grounds: (1) that

Morgan had converted the advisory reissue proceeding into a "regular" reissue proceeding (37 C.F.R. §1.175 (a)(1), (2), and (3)) by making certain amendments to its specification in response to the PTO's "rejection."[1] The District Court held that as a regular reissue, the action was no longer advisory, and the finding that the Morgan invention was obvious in light of Karn was controlling on the issue of validity in the District Court action; or, (2) even if the reissue proceeding was advisory, Morgan was essentially attempting to collaterally attack the jurisdiction of the CCPA to review that advisory opinion and was not allowed to do so under the doctrine enunciated in *Chicot County Drainage District v. Baxter State Bank*, 308 U.S. 371 (1940). App., pp. A15 et seq.

Morgan appealed and the U.S. Court of Appeals for the Federal Circuit ("CAFC") affirmed on the sole ground that Morgan's amendment to its specification had converted the no-defect, advisory reissue proceeding into a regular reissue. Therefore, the CAFC held, a case or controversy was decided which estopped Morgan from asserting the validity of its patent in the District Court infringment suit.

In sum, Morgan was denied its valuable patent without a trial on the validity of the patent as it exists today—ten years after its issue and after ten years of commercial success.

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1. The specification changes actually were made in response to an "objection," not a "rejection." App., p. A78. The holding further conflicts with the Board of Appeals' decision that the reissue is filed on the basis of prior art and the claims are "substantially the same." App., pp. A4-5.

ARGUMENT

I. IT IS A DENIAL OF DUE PROCESS OF LAW TO DEPRIVE AN INVENTOR OF A VALUABLE PATENT WHERE THERE HAS BEEN NO VOLUNTARY SURRENDER OF THAT PATENT AND NO COURT HAS DETERMINED THE VALIDITY OF THE PATENT.

A. Patents Are Property Rights Protected by Due Process of Law.

This Court has long recognized an inventor's property right in a patent. As stated in *Hartford-Empire Co. v. United States*, 323 U.S. 386 (1944):

> That a patent is property, protected against appropriation both by individuals and by government, has long been settled. [footnote omitted]

323 U.S. at 415.

As property, patents can be taken away through invalidation only after the patentholder has been accorded due process of law. Fifth Amendment, United States Constitution; *Johnson & Johnson, Inc. v. Wallace A. Erickson & Co.*, 627 F.2d 57, 59 (7th Cir. 1980). Although the PTO has the power to grant a patent, only the courts of the United States have the power to invalidate a patent. As stated in *McCormick Machine Co. v. Aultman*, 169 U.S. 606 (1897) (hereinafter "*McCormick*"):

> The only authority competent to set a patent aside, or to annul it, or to correct it for any reason whatever, is vested in the Courts of the United States, and not in the department which issued the patent.

169 U.S. at 609.

B. The PTO Does Not, and Cannot, Invalidate Patents in Reissue Proceedings.

Federal statutes and regulations, as well as case law, clearly establish that patents are not, and cannot be, invalidated in reissue proceedings conducted by the PTO.

Under 35 U.S.C. §251, the PTO may, upon application of a patentholder, correct errors which render an original patent partly or wholly inoperative or invalid by reissuing the patent. Reissue proceedings do not determine a patent's validity and therefore do not impinge upon the patentholder's property rights in the original patent.

A patentholder seeking a "regular" reissue must submit a statement under oath to the PTO that the original patent is wholly or partly inoperative or invalid through some mistake or omission. 37 C.F.R. §1.175(a). The PTO will reissue the patent only if it finds that the reissue application does not broaden the claims of the original patent and finds a defect in the original patent caused by mistake or omission which is corrected in the reissued patent. *U.S. Chemical Co. v. Carbide Corp.*, 315 U.S. 668 (1942).

The patentholder has no duty to surrender the patent to the PTO until the reissue is granted. Prior to that time, an "offer" to surrender is sufficient. 37 C.F.R. §1.178. If the reissue is not granted, the original patent:

> . . . stands as if no application had ever been made for a reissue.

Allen v. Culp, 166 U.S. 501, 505 (1897). As that Court explained:

> If it were otherwise, every patentee who applies for a reissue would do so at the peril, not only of having his application refused, but of losing what he already possessed.

Id. If the reissue is refused, the patent is returned to the applicant upon request. 37 C.F.R. §1.178.

The *McCormick* case is the landmark decision of this Court on patent reissues. In that case, this Court unequivocally held that an examiner's rejection of certain patent claims during reissue proceedings had no effect on the validity of the patent:

> The object of a patentee applying for reissue is not to reopen the question of the validity of the original patent, but to rectify any error which may have been found to have arisen from his inadvertence or mistake. But until the amended patent shall have been issued, the original stands precisely as if a reissue had never been applied for (*Allen v. Culp,* 166 U.S. 501, 505), and must be returned to the owner upon demand.

169 U.S. at 610. To hold otherwise, the Court noted, would go beyond the patent powers granted in the Constitution:

> . . . to attempt to cancel a patent upon an application for reissue when the first patent is considered invalid by the examiner would be to deprive the applicant of his property without due process of law, and would be in fact an invasion of the judicial branch of the government by the executive.

169 U.S. at 612.

C. Review of a Reissue Proceeding by an Appellate Court Does Not Invalidate a Patent.

Since the PTO does not determine the validity of a patent in reissue proceedings, appellate court review of the PTO decision, available under 35 U.S.C. §141, does not invalidate the patent. The court review is limited to

the question of whether the rejection was correct and does not determine the validity of the patent:

> The Patent Office is not a 'Court,' and because it is not a Court it cannot render a 'judgment,' hence its decisions or other actions cannot give rise to 'res judicata' in the strict legal sense of that term.
>
> * * * * *
>
> The dissent herein suggests that there is some significance to the fact that appeals have been taken outside the Patent Office to 'a Federal appellate tribunal,' seeming to concede that below this level or prior to taking such an appeal a different situation may prevail. I am unable to see a significance in this distinction. If an applicant is entitled to the examination of a new application, as he certainly is under the statute, it seems to me he is entitled to the concomitant rights of review which go with it. It must be remembered that we have a limited jurisdiction. We never decide the *right to a patent.* All we decide is whether a particular *rejection* was right or wrong.

In Re Herr, 377 F.2d 610, 614, 618 (C.C.P.A. 1967), concurring opinion of Judge Rich. Judge Smith also concurs:

> The dissent . . . seems to consider that appellant created the problem by choosing to appeal the earlier board decision. The dissent also portrays, contrary to some undefined public policy, "endless litigation," . . . . The record does not establish or even intimate any wrongdoing on appellant's part. He is but pursuing the procedures afforded him by the patent statute.

377 F.2d at 626-27.

In our case, the lower courts acted contrary to the rulings of this Court by holding that Morgan's patent was invalidated in a reissue proceeding. The taking of Mor-

gan's patent rights is particularly egregious here, where the reissue procedure invoked was purely advisory and the patentholder at no time voluntarily surrendered any rights to the patent.

D. The Reissue Proceedings in Our Case Were Purely Advisory.

In 1977, the Patent Commissioner established, under Rule 37 C.F.R. §1.175(a)(4) (the "Dann Amendments"), a proceeding through which a patentee could obtain an advisory opinion from the PTO with respect to prior art which had not been brought to the attention of the Patent Office at the time of the original application. The advisory application might be filed:

> When the applicant is aware of prior art or other information relevant to patentability, not previously considered by the Office which might cause the examiner to deem the original patent wholly or partly inoperative or invalid, particularly specifying such prior art or other information and requesting that if the examiner so deems, the applicant be permitted to amend the patent and be granted a reissue patent. 42 Fed. Reg. 5594 (January 28, 1977).

No oath that the patent is partly or wholly inoperative or invalid is required. As summarized by Judge Phillips in *Bally Manufacturing Corp. v. Diamond*, 629 F.2d 955 (4th Cir. 1980):

> In January 1977, the Commissioner adopted a new regulation which permits a patentee to use the reissue process *to obtain an advisory opinion* as to the validity of his patent. Under 37 C.F.R. §1.175(a)(4) a patent owner may have new prior art considered by the PTO in a reissue proceeding without making any

> changes in his original claims or specification. The official commentary indicates that the new rule was intended to allow a patentee to file a reissue application *even if he believes his patent is valid over prior art not previously considered by the PTO.* 42 Fed. Reg. 5588 (1977). Since reissue applications can be granted only where the original patent is wholly or partly inoperative or invalid, 35 U.S.C. §251, filing a reissue application subjects the original patent to the patent examiner's determination of validity in light of the new prior art. A reissue rejection, whether based on the finding of the examiner that the original patent is entirely valid or on his finding that the reissue claims do not describe a patentable invention, *is purely advisory.*

629 F.2d at 957-58 (emphasis added). *See also, Johnson & Johnson, Inc., supra,* 627 F.2d at 59-60.

The advisory proceedings themselves proved to be unworkable and were abolished by the patent commissioner as of July 1, 1982:

> The patent examiners in the office are not trained as hearing examiners and have no substantial experience in handling inter-partes matters.
>
> * * * * *
>
> Under Paragraph (a)(4) the Office gave advisory opinions on patentability over additional prior art without any changes in the patent claims. The courts have generally refused to give preclusive effect to these advisory opinions.

47 Fed. Reg. 21,748 (May 19, 1982).

Federal Courts of Appeals also recognized that the advisory reissue proceeding was ill-conceived. *Bally Manu-*

facturing, supra, 629 F.2d at 960, n.7. In *In Re Dien,* 680 F.2d 151 (C.C.P.A. 1982) and *In Re Bose,* 687 F.2d 432 (C.C.P.A. 1982), the CCPA held that it had no jurisdiction to review the advisory opinions issued in no-defect proceedings. The Court in *In Re Dien* admitted its lack of power with candor:

> The fact that the PTO's alleged board "decision," which we are asked to review, is merely an advisory opinion is conclusive of our lack of jurisdiction. To review an advisory opinion would be to give one. We are a court established under Article III of the Constitution. [citation omitted] As such, our power is constitutionally limited to the decision of "cases" and "controversies." [citations omitted] An advisory opinion by the PTO does not fit in either of those categories and *we lack the power to review it.*

680 F.2d at 155 (emphasis added). The Court noted the PTO filed the motions to dismiss the appeals, revealing:

> . . . a most interesting turnabout by that agency which has resulted in confusion reminiscent of parts of the Mad Hatter's Tea Party in *Alice in Wonderland.*

680 F.2d at 153-54.

In our case, Morgan justifiably believed it was seeking a wholly advisory opinion which would "have no legal effect on anyone." *Bally Manufacturing, supra,* 629 F.2d at 960, n.7. It did not submit a statement under oath that its patent was wholly or partly inoperable or invalid due to mistake or error. In fact, Morgan believed—and believes—that its patent was and is perfectly valid. But in light of Chemtrol's allegations, Morgan sought an advisory reissue so that the patent record could disclose that the prior art alleged by Chemtrol to invalidate the patent had been considered in the original proceeding. The PTO

was not asked to, and did not, decide the validity of the patent. It merely issued an advisory opinion on the effect of the prior art on the patent claims.

Nor did the Patent Board of Appeals or the CCPA consider the validity of the patent. Rather, as in *In Re Herr, supra*, those entities merely decided whether the PTO correctly refused to reflect on the original patent record that certain prior art had been considered.

Judge Manos placed Morgan in Alice's Wonderland by holding that a proceeding which was purely advisory by frank admission of the PTO and the Courts nevertheless was a binding adjudication on the merits of the validity of the Morgan patent. In so doing, he deprived Morgan of a valuable property right without due process of law.

E. A Court Cannot Unilaterally "Convert" an Advisory Reissue Into a Regular Reissue and Thereby Invalidate a Valuable Property Right.

No reissue proceeding invalidates a patent. But in our case, two courts have held that it does. This is error because the reissue proceeding involved is not even a regular, defect reissue. Morgan sought only an advisory, no-defect reissue.

In order to circumvent the distinction between regular and advisory reissue, the CAFC based its decision in our case on the technicality that Morgan "converted" its no-defect, advisory reissue into a regular reissue by amending its specification. Even assuming that a regular reissue proceeding could invalidate a patent—which is not the law—any conversion which took place was performed by the Courts in this case, not by Morgan. According to the Court of Appeals and the Trial Court, the conversion took place pursuant to §1414.02 of the Manual of Patent Examining Procedure:

> If a reissue filed under subsection 1.175(a)(4) is amended, even though in response to a rejection, the reissue is thereby converted into an application under subsection 1.175(a)(1), and appropriate subsections 1.175(a)(2) and/or (a)(3), and a new reissue oath or declaration must be filed containing the appropriate averments.

App., p. A37.

The only amendment made to the Morgan patent was in response to an objection, not a rejection, and involved a specification, not a claim. Morgan amended its claims to conform with the original claims (App., p. A48); and the PTO's Board of Appeals recognized that the claims were the same. App., p. A4. App., p. A78. Therefore the Section does not apply at all.

At most, Section 1414.02 stipulates that an amendment to a reissue filed under subsection 1.175(a)(4) prevents a reissue under that section, and would not permit a reissue under subsection (a)(1), (a)(2), or (a)(3) unless a new reissue oath or declaration were filed containing the appropriate averments.

There is nothing in that Section to supply the missing oath of declaration and, without it, there could be no reissue, or adjudication of a right to reissue, in any event.

Section 1414.02 was misinterpreted by the courts below.

F. A Court Rendering an Advisory Opinion Cannot Invalidate a Patent.

The Trial Court based its opinion, in part, on the theory that Morgan no longer owned a patent on which to base its infringement suit since it had appealed the decision of the PTO to the CCPA. App., pp. A29-32. The premise for such a finding—that the CCPA had invalidated

the patent—is faulty. But even if this Court were to accept the argument that the CCPA *could* invalidate Morgan's patent, it did not do so in this case because no case or controversy was presented. Because a Federal Court of Appeals has no jurisdiction to give advisory opinions, the CCPA's decision cannot be binding on Morgan.

The CCPA recognized in 1982 that it had no power to review no-defect reissues because they were advisory opinions presenting no case or controversy:

> Belated though the awakening of the PTO may be—and perhaps ours as well . . . we lack the power to review [a no-defect reissue].

In Re Dien, 680 F.2d 151, 154-55 (C.C.P.A. 1982).

While not denying the CCPA's total absence of jurisdiction to review the reisssue, the Trial Court in our case held that the CCPA's decision was valid and binding because Morgan could not collaterally attack that Court's jurisdiction. App., pp. A26-29, *citing Chicot County Drainage District v. Baxter State Bank,* 308 U.S. 371 (1940). *Chicot* did not establish an absolute rule regarding collateral attacks on final judgment. As this Court held soon after *Chicot:*

> . . . no inflexible rule as to collateral objection and general to judgments was declared [in *Chicot*].

United States v. U.S. Fidelity Co., 309 U.S. 506, 514 (1940). *See also,* WRIGHT, MILLER & COOPER, 13 FEDERAL PRACTICE AND PROCEDURE, §3636; CHAFEE, SOME PROBLEMS OF EQUITY, (Ann Arbor, Mich. 1950) at pp. 319-20, n.42. In *Chicot,* the Court rendered a judgment based upon a statute properly before it. Eight years later, the judgment was attacked after the underlying statute was declared unconstitutional. However, the Court had acted properly in interpreting what was at that time a valid statute.

The case before this Court is completely different. Here, the CCPA reviewed an admittedly advisory opinion despite the constitutional limitation on that Court's jurisdiction to review only cases and controversies. Our case thus falls under the rule set forth in *Arenas v. United States,* 197 F.2d 418 (9th Cir. 1952), that subject matter jurisdiction may be attacked collaterally where the Court exercised jurisdiction "in the teeth" of precedent that no jurisdiction exists. In *Arenas,* the trial court refused to grant res judicata or collateral estoppel effect to a 1945 judgment by a Federal District Court, affirmed by the Ninth Circuit, that Arenas was sole heir to the lands in question. The Ninth Circuit affirmed on the grounds that jurisdiction to decide statutory heirship had been withdrawn from the District Court 35 years prior to its 1945 decision, and the decision was void and of no effect. The Court rejected the argument of the United States that although erroneous, the District Court's decision in 1945 that it had jurisdiction to decide the case was not void or subject to collateral attack. Citing this Court's decisions in *Noble v. Union River Logging Railroad,* 147 U.S. 165 (1893), and *Stoll v. Gottlieb,* 305 U.S. 165 (1938), the Court held:

> Determination of heirship in the former action was in the teeth of the provisions of the Act of June 25, 1910, and therefore the Court in the present action was at liberty to disregard it.

197 F.2d at 421.

In our case, the CCPA recognized "belatedly" in *In Re Dien, supra,* 680 F.2d at 153, that its review of advisory proceedings was in the teeth of its lack of jurisdiction to render advisory opinions. It did not have jurisdiction in 1982 to review advisory opinions and had never had such jurisdiction. Its advisory opinion can thus be col-

laterally attacked and properly declared to be void and of no effect.

G. Morgan Did Not Receive a Full and Fair Hearing on the Issue of Validity Because It Never Had the Opportunity to Argue Commercial Success of Its Patent.

Assuming a valid judgment from the CCPA that Morgan's patent would not have issued ten years ago had the PTO been aware of certain prior art, such a holding does not defeat Morgan's position that its patent today is valid and infringed.

The Trial Court held that Morgan was collaterally estopped from arguing that its patent was valid because it could not meet its burden of proof to show that the prior proceedings were "seriously defective" according to the standards of *Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation,* 402 U.S. 313 (1971). App., p. A32. *Blonder-Tongue, supra,* is inapplicable because there this Court considered the question of whether a judgment of patent invalidity in one suit against an alleged infringer accrues to the benefit of any other against whom infringement of a patent is alleged. In our case, the validity of the patent was never a proper issue in an advisory, no-defect reissue proceeding limited to determining the effect of prior art on patent claims and providing an advisory opinion only.

The purpose of the no-defect reissue proceeding was to determine whether the PTO would allow the record to reflect that, *at the time of issuance,* additional prior art was considered by the PTO in granting the patent. *See,* 42 Fed. Reg. 5588 (January 28, 1977). When considering the validity of a patent, however, the commercial success of the patent between the time of the grant and the

challenge to its validity is relevant. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (C.A.F.C. 1983); *Simmons Fastener Corp. v. Illinois Tool Works, Inc.*, 739 F.2d 1573 (C.A.F.C. 1984), *cert. denied*, 53 U.S.L.W. 3776 (1985). This commercial success was not considered, and would not have been relevant, to the no-defect proceeding. The proceedings, therefore, cannot bind Morgan on the issue of validity.

Commercial success is secondary evidence of nonobviousness. As recently noted by the CAFC:

> Indeed, evidence of secondary considerations may often be the most probative and cogent evidence in the record. It may often establish that an invention appearing to have been obvious in light of the prior art was not. It is to be considered as part of all the evidence, not just when the decisionmaker remains in doubt after reviewing the art.

Stratoflex, Inc. v. Aeroquip Corp., supra, 713 F.2d at 1538-39.

The *Stratoflex* result was recently followed in *Simmons Fastener Corp. v. Illinois Tool Works, Inc., supra*, where the Court held:

> We agree with the Trial Court that the teachings of the prior art prima facie would have suggested to one of ordinary skill in the art the claimed invention. . . . However, the evidence of secondary considerations in this case, particularly commercial success, is extremely strong, and is entitled to great weight. In considering the evidence of obviousness/nonobviousness collectively, we conclude the Trial Court's decision that the claimed invention of the '476 patent would have been obvious under 35 U.S.C. 103 must fall.

739 F.2d at 1575-76.

In our case, Morgan had no opportunity to present evidence of commercial success to rebut any finding of obviousness made by the PTO in its no-defect reissue proceeding and affirmed by the CCPA. It therefore was denied valuable patent rights without a full and fair hearing as required in *Blonder-Tongue*. The lack of opportunity in the advisory proceedings for Morgan to show evidence of post-grant commercial success to rebut a finding of obviousness is a "serious defect," precluding the application of collateral estoppel.

II. THIS COURT SHOULD GRANT CERTIORARI TO REVERSE A DECISION IN CONFLICT WITH ITS OWN PROPER DECISIONS, AND TO REINSTATE MORGAN'S VALUABLE PROPERTY RIGHTS IN ITS PATENT.

Morgan asks this Court to address the balance of an inventor's property interest in a valid patent with the public's interest underlying collateral estoppel. The former must prevail in all cases except where identical issues are involved in subsequent patent litigations. *In Re Russell*, 439 F.2d 1228 (C.C.P.A. 1971); *In Re Craig*, 411 F.2d 1333 (C.C.P.A. 1969).

The appropriate role of a trial court in assessing the findings of the PTO in any reissue proceeding has been set forth in *National Business Systems v. AM International, Inc.*, 743 F.2d 1227 (7th Cir. 1984), *cert. denied*, 53 U.S.L.W. 3808 (1985). In refusing to be bound by the PTO's findings of patent invalidity in reissue proceedings, the Court noted:

> The decision of the Patent Office in the reissue proceeding is neither cloaked in a "presumption of correctness" independent of the patent nor entitled to special deference in a separate federal court adjudication of patent validity.

743 F.2d at 1232. The Court additionally noted: (1) less deference is appropriate for a PTO finding of invalidity in a reissue proceeding as opposed to an original issue proceeding, because patent validity is a question of law reserved exclusively to the Federal courts in de novo proceedings; (2) deference is particularly inappropriate where the patent in question has been in existence for several years.

That the PTO decision in this case was reviewed by the CCPA does not change this result because: (1) the CCPA was reviewing the PTO's rejection of a no-defect reissue, not its decision on the right to a patent; and (2) the Court was without jurisdiction to render a binding decision since it reviewed an advisory opinion in the teeth of its duty to accept only cases and controversies.

We suggest that this Court should further reexamine or clarify *Blonder-Tongue, supra,* 402 U.S. 313 (1971) to prevent its application to patent reissue proceedings where commercial success, years of existence or other secondary evidence of validity is not relevant.

CONCLUSION

As a result of the substantial errors committed in our case, a conflict has been created with decisions of this Court, and Morgan has been deprived of valuable property without due process of law.

For all of these reasons, as more fully set forth above, Morgan respectfully requests review by this Court, reversal of the decisions of the Court of Appeals and the District Court, and remand for trial on the validity of the Morgan patent.

Respectfully submitted,

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APPENDIX

OPINION OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

(Decided February 7, 1985)

Appeal Nos. 83-1258 and 83-1196.

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

MORGAN ADHESIVES COMPANY,
Appellant,

v.

CHEMTROL ADHESIVES, INC.,
Appellee.

Before MARKEY, *Chief Judge,* COWEN, *Senior Circuit Judge,* and BALDWIN, *Circuit Judge.*

BALDWIN, *Circuit Judge.*

DECISION

The decision of the trial court holding that appellant is collaterally estopped from litigating the validity of U.S. Patent No. 3,900,645 ('645 patent) and granting appellee's motion for summary judgment is *affirmed.*

OPINION

Appellant's main argument on appeal is that it launched an advisory opinion no-defect reissue proceeding under 37 C.F.R. § 1.175(a)(4) (1982) (rule 175(a)(4)) (abolished May 1982) which was not converted to a statutory reissue proceeding.

Although appellant withdrew its amendments to the claims, it did not withdraw its amendment to the specification. Appellant, in fact, admits in its brief, "as the case came to the CCPA the patent was in precisely the form in which it had originally issued from the Patent Office, *except* only for the insertion of one sentence in the specification." (Emphasis added.) The sentence was added to overcome a rejection of claim 3 based on the lack of antecedent basis for the limitation in claim 3. The change thereby converted the application into a statutory reissue application.

The cases *In re Dien*, 680 F.2d 151, 214 USPQ 10 (CCPA 1982) and *In re Bose*, 687 F.2d 432, 215 USPQ 1 (CCPA 1982) lend no support to appellant's argument that its proceeding was strictly a rule 175(a)(4) proceeding. In *Dien*, neither the claims nor the specification were changed, and in *Bose*, the court held mere removal of claims by disclaimer for reissue purposes could not turn the rule 175(a)(4) application into a true reissue application. In both cases the proceedings were held to be advisory only. The basis for those conclusions was that no reissue patents could have issued that would have differed from the original patents because no new specifications or claims were present in the reissue applications. By contrast, in the present case, had the Court of Customs and Patent Appeals (CCPA) reversed the rejection, appellant would have received a new patent containing new language specifying that the thickness of the paper backing layer is "less than one-half of the thickness of the sheet 12 paper." The proceedings in the Patent and Trademark Office (PTO) were therefore not advisory in this case.

We further reject appellant's argument that the change could have been made by a certificate of correction, 37 C.F.R. § 1.323. Contrary to appellant's assertions, the

change made was not due to a clerical, typographical, or otherwise minor error. Indeed, the change would have affected the scope or meaning of the patent. Even if the change could have been made by a certificate of correction, appellant's argument is irrelevant, because appellant *did* amend the specification.

Section 1414.02 of the Manual of Patent Examining Procedure, derived from guidelines in the December 12, 1978 Official Gazette and published before appellant made any amendment to its reissue application, clearly states that amendment of a rule 175(a)(4) reissue application converts such application into a statutory reissue application.

In sum, by virtue of appellant's amendment to the specification, the rule 175(a)(4) no-defect reissue proceeding was converted to a statutory reissue proceeding. The proceeding in the PTO was not merely advisory. Therefore, the CCPA had jurisdiction to review the PTO's decision. Appellant's argument that the CCPA's decision was a nullity because there was no jurisdiction, and there could be no application of collateral estoppel must therefore also fail.

The trial court also correctly held that appellant was collaterally estopped from litigating the validity of the '645 patent and was not denied due process via the change in the reissue proceedings. These issues having been dealt with at great length by the trial court, we affirm on the basis of the reasons set forth by the trial court. We agree appellant had a full and fair opportunity to litigate, and was not deprived of due process of law.

The decision granting appellee's summary judgment motion is accordingly affirmed.

BOARD OF APPEALS' AFFIRMANCE

(MAILED OCT. 30 1980 PAT. & T.M. OFFICE
BOARD OF APPEALS)

Art Unit 164 Paper No. 53
Appeal No. 446-55 fh

Heard:
September 18, 1980

UNITED STATES PATENT AND
TRADEMARK OFFICE

BEFORE THE BOARD OF APPEALS

Ex parte Burton D. Morgan

Application filed September 19, 1977, Serial No. 834,136, for the Reissue of Patent No. 3,900,645, granted August 19, 1975, based on application Serial No. 78,887, which is a division of Serial No. 389,435, filed December 11, 1967, U.S. Patent No. 3,570,337, granted March 16, 1971. Scored Adhesive Laminate.

Vern L. Oldham et al and Norman H. Stepno for appellant.

Before Blech and Katz, Examiners-in-Chief, and
Pellman, Acting Examiner-in-Chief.
Katz, Examiner-in-Chief.

Appellant appeals from the final rejection of claims 1 to 4, which are all the claims in the case.

This is a reissue application of Patent 3,900,645. The claims before us are substantially the same as the claims

in the patent, appellant having filed this reissue on the [2] basis of prior art which may affect the validity of the patent.

Claim 1 is illustrative of the appealed claims and reads as follows:

> 1. A flexible laminate for use as a label, decal or the like, comprising:
>
> a face sheet,
>
> a layer of pressure sensitive adhesive secured to the back surface of said face sheet, and
>
> a fiber paper backing layer removably secured to said adhesive layer and having a reduced thickness potential tear line formed in such material, the fibers of the paper backing layer being appreciably compacted at the potential tear line, the paper having a release coating on *its* [an] inner surface *which engages* [engaging] the adhesive layer.

The claimed invention relates to pressure-sensitive adhesive labels having a removable backing sheet. In order to facilitate the gripping of an edge of the backing sheet, the backing sheet has tear lines which are of reduced thickness and which are in compacted form. When the backing sheet is folded at a tear line, a break occurs due to the weakened condition at said tear line.

The references relied on are:

Brady et al	2,434,545	Jan. 13, 1948
Brady	2,681,732	June 22, 1954
Karn	3,230,649	Jan. 25, 1966

Cameron Bulletin 4010.

Paper, Film and Foil Converter, July, 1958, pages 24-28.

All the claims stand rejected under 35 USC 112, first paragraph, for lack of an enabling disclosure.

Claims 1 to 3 stand rejected under 35 USC 112, first and second paragraphs, as failing to sufficiently describe the location of the compacted tear lines.

All the claims stand rejected under 35 USC 102(b) as anticipated by Karn.

[3] Claims 1 to 3 stand rejected under 35 USC 103 as obvious in view of the combination of Karn and Brady (732) or Brady (545).

All the claims stand rejected under 35 USC 103 as obvious in view of the combination of Karn taken with Cameron and Paper, Film and Foil Converter.

We have carefully considered the arguments in this case, including those of the protestor, Chemtrol Adhesives, Inc., and find that we agree with appellant as to the section 112 rejections but with the examiner as to the section 102(b) and 103 rejections.

The examiner has rejected the claims under section 112, first paragraph, as lacking an enabling disclosure. It is the examiner's position that the wire wound roll described having an edge diameter of 0.010 inch will *cut* the paper and will not compact. The examiner may very well be correct that such a roll may be used for cutting; however, we believe that this may depend on the type of paper used and the pressure applied to the roll. The specification describes crushing of the fibers to form a groove. Cutting is not mentioned and may or may not actually be practiced. In any event, we believe that one skilled in this art, understanding the aims described in the specification, would be able, without the use of inventive faculty, to vary the appartus and obtain the structure set forth in the claims. We will not support this rejection.

Also, we will not support the rejection of the claims based on section 112, paragraphs one and two. The examiner contends that only a product having a compacted groove in the side of the backing sheet away from the [4] adhesive has been taught. While the claims do not set forth the side on which the groove is present, the function and purpose of the groove is recited. We believe that one skilled in this art would not be required to exert undue experimentation to place the groove on the side necessary to obtain the described "breaking" ability for the backing sheet. See *In re* Stephens et al, 529 F.2d 1343, 188 USPQ 659 (CCPA 1976).

In our view, the rejection of the claims will stand or fall based on the pertinency of the Karn reference. Karn relates to the same type of subject matter claimed, that is, a label having a pressure-sensitive coating and being adhered to a peelable backing sheet. Both appellant and Karn desire to treat the backing layer so that it is easily removable. Both apply easily breakable score lines or indentations to the backing sheet. The claims call for compacting the surface in the form of lines, which are not cut through to the adhesive layer. The compacted layers are weakened and may be broken by bending. Karn teaches two embodiments. In one, the backing sheet has lines all the way through; in the other embodiment, the backing is cut part-way through by means of "crush-cutting rotary knives." The action of the knives is described* as follows:

> "The channels 25, 26, 27 can be formed by crush-cutting rotary knives which impinge upon the liner 13 before it is laminated to the printable sheet 10, etc., to form the label stock. The liner 13 is passed around a hardened-steel anvil roller, and the knives are ad-

*See column 3, lines 59-65.

justed so that a layer of liner fibers remains unruptured on the side of the liner in contact with the roller."

[5] Appellant contends that the affidavit evidence presented in this case indicates that it is not possible, or at least not practical, to employ a crush-cutter to partially cut through or crush paper. As set forth in the McKee affidavit, the paper will either be untreated or cut all the way through when the knife pressure is increased.

Protestor, on the other hand, points out that the Karn reference specifically teaches the use of the crush-cutter to partially cut through the paper and, most importantly, sets forth the *action* of the crush-cutter. The action is described as forming a weakened tab which may be readily ruptured when sharply bent.

Karn is relied on to anticipate the claimed subject matter and as the key reference in the section 103 rejections.

We agree with the examiner that the remaining references are sufficient evidence that it is known in this art that the score or tear line may be on either side of a backing sheet and that rotary cutters of different edge diameters are known. We also come to the conclusion that it would have been obvious to score or cut the backing sheets of Karn using such teachings.

Also, arguments are presented that appellant, in his corresponding process patent No. 3,900,645, filed a Rule 131 [37 CFR 1.131] affidavit to antedate a cited reference and that, as part of the evidence, appellant indicated that in commercial practice a crush-roller was used to form the product corresponding to that defined in the claims before us.

The main question we have before us is to determine whether Karn is an adequate teaching that crush-rollers may [6] be used for forming a product as defined in the claims.

We have carefully considered all the arguments in this case, including the various exhibits and affidavits, and come to the conclusion that Karn is a valid reference which anticipates the claimed article.

While we agree with appellant that crush-cutting rollers may be used to completely cut through a paper thickness, as evidenced by the McKee affidavit, we also are cognizant of the fact that the extent of cutting may be determined by other factors, such as the sharpness of the roll, and the absence or use of stops to limit the extent of the cutting action. McKee did not use stops but merely increased the pressure on the cutting roll to the point where cutting commenced. Obviously, once the cutting starts, the resistance to cutting is diminished and the cutter will proceed to pass through the thickness of the paper. Also, it is clear that the rolls employed in the McKee tests were exceedingly sharp, being the smallest edge diameter rolls available.

However, Karn does not use the crush-cutter in the manner described by McKee. In the Karn apparatus, the knives are adjusted so that a layer of liner fibers remains unruptured. See column 3, lines 63 and 64.

The Farrell affidavit relates to the use of a sharp cutting wheel of the type employed by McKee.* However, in Farrell's experiments, stops are used to leave different thicknesses in the uncut portions of the paper. The paper did not tear or rupture when bent along the cut lines, even

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*See McKee affidavit.

[7] when exceedingly thin uncut areas remained. This shows that the uncut tabs remained flexible.

We do not doubt that it is possible to partially cut through paper using sharp knives, whether rotary or not, and that the uncut areas may be unaffected and, thus, retain their flexibility. However, Karn describes his "tabs" as being weak and readily rupturable when sharply bent. Such structure does not correspond to that obtained by Farrell. We can only conclude that the type of crush-cutter or manner of using same, as described by Karn, is different from that employed by Farrell.

We believe it is only reasonable to conclude from the evidence presented that, if the claimed sheet is rupturable because it has compressed lines, then the cut lines of Karn also are rupturable for the same reason. As we have pointed out before, Farrell shows that unmodified paper remains flexible, regardless of the depth of the cut. Since the claimed sheet was made by using a treating roll analogous to that described by Karn, and since appellant now uses a crush-cutter roll to manufacture a product corresponding to that set forth in the claims, we must conclude that the Karn structure is as presently claimed and is an anticipation thereof.

Appellant further argues that the Karn patent has cuts. We note that the claims do not exclude the presence of cuts and we see no evidence which would indicate that cuts are deleterious and that they are absent from the claimed product.

[8] The decision of the examiner is affirmed.

AFFIRMED

/s/ SAMUEL BLECH)
Examiner-in-Chief)
)
)
)
/s/ MURRAY KATZ) BOARD
Examiner-in-Chief) OF
) APPEALS
)
)
)
/s/ IRVING PELLMAN)
Examiner-in-Chief)
(Acting)

In accordance with the Decision on Petition, Paper No. 13, copies of this decision are sent to:

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OPINION OF THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEAL

(Decided July 9, 1981)

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

IN RE BURTON D. MORGAN) Appeal No. 81-552.
) Serial No. 834,136.

Before MARKEY, *Chief Judge*, RICH, BALDWIN, MILLER and NIES, *Associate Judges*.

RICH, *Judge*.

DECISION

The decision of the United States Patent and Trademark Office Board of Appeals sustaining the examiner's rejection of claims 1-4 under 35 USC 103 is *affirmed*.

OPINION

A prima facie case of obviousness is established from the Karn crush-cutting disclosure and the known use of crush-cutting blades at the time of the present disclosure. A 45° "B" edge Cameron blade (six to eight thousandths inch radius) was specifically recommmended for cutting Kraft [2] paper in a crush-cutter. In addition, the 45° "C" edge Cameron blade (ten to twelve thousandths inch radius) was specifically recommended for cutting waxed and impregnated paper. Thus, one of ordinary skill in the art would have followed the suggestion of the Cameron reference to employ these blades to achieve a partial cut with label liner paper.

Although the McKee affidavits may successfully rebut the §102 rejection, they fail to rebut the §103 rejection. McKee declares in his affidavit of December 28, 1978, page 4:

> 20) THAT each of the three knife edges shown in Cameron Machine Company Bulletin 4010 would, at operating pressures between particular levels for each such knife, be capable of appreciably compacting paper between the knife edge and a back-up roll without cutting such paper; * * *.

On page 5, he then goes on to state:

> 23) THAT when a crush-cutting rotary knife is brought into contacting engagement with paper against a back-up roll, one skilled in the art would expect either total cutting of the paper or no cutting at all, there being increasing compaction of the paper fibers between the knife and back-up roll as the pressure effectuating forceful engagement increases to a point where a bursting or rupturing of all the fibers between the knife and back-up roll occurs; * * *.

Since these affidavits lack any factual basis to support his assertion that one skilled in the art would not have been able to compact-cut label paper with known blades which admittedly are capable of such operation, we hold that the prima facie case has not been rebutted.

BALDWIN, *Judge*, dissenting.

I do not agree that a prima facie case of obviousness is established by the Karn reference. Karn specifically discloses making cuts "almost, but not completely, through the liner, forming channels." Nowhere does Karn suggest the appreciable compaction of fibers at the potential tear line in lieu of the disclosed cut channels. As presented

in the McKee affidavit, one of ordinary skill in the art would be led by the Karn reference to use increasingly sharper rotary knives to effectuate a cut almost, but not completely, through the thickness of the liner, realizing that a crush-cut knife could not achieve a controlled depth cut. Accordingly, I would reverse the decision of the board.

OPINION GRANTING SUMMARY JUDGMENT

(Filed May 20, 1983)

CIVIL ACTION NO. C-76-101

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF OHIO
EASTERN DIVISION

MORGAN ADHESIVES COMPANY,
Plaintiff,

vs.

CHEMTROL ADHESIVES, INC.
a Delaware Corporation,

C/O HAROLD ROBINSON, President
and Statutory Agent,
Defendant.

On February 2, 1976 plaintiff, Morgan Adhesives Company, (hereinafter, Morgan), filed the above-captioned case seeking injunctive relief, damages and attorney's fees due to the alleged infringement of its United States Letters Patent No. 3,900,645 (hereinafter, '645), by the defendant, Chemtrol Adhesives, Inc., (hereinafter, Chemtrol). Jurisdiction is invoked under 28 U.S.C. § 1338 and 35 U.S.C. § 281.[1] On March 23, 1976 Chemtrol filed an answer and counterclaim seeking declaratory relief regarding the validity of the '645 patent, attorney's fees and treble damages for an alleged violation of Section 2 of the Sherman Antitrust Act of 1890. 15 U.S.C. §§ 2 and 15.[2] **[2]** On January 24, 1983 Chemtrol filed a motion for

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1. 28 U.S.C. § 1338(a) provides as follows:

> The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents, plant variety protection, copyrights and trademarks. Such jurisdiction shall be exclusive of the courts of the states in patent, plant variety protection and copyright cases.

35 U.S.C. § 281 provides as follows:

> A patentee shall have remedy by civil action for infringement of his patent.

2. 15 U.S.C. § 2 provides as follows:

> Every person who shall monopolize, or attempt to monopolize, or combine or conspire with any other person or persons, to monopolize any part of the trade or commerce among the several States, or with foreign nations, shall be deemed guilty of a felony, and, on conviction thereof, shall be punished by fine not exceeding one million dollars if a corporation, or, if any other person, one hundred thousand dollars or by imprisonment not exceeding three years, or by both said punishments, in the discretion of the court.

15 U.S.C. § 15 provides as follows:

> Any person who shall be injured in his business or property by reason of anything forbidden in the antitrust laws may sue therefor in any district court of the United States in the district in which the defendant resides or is

(Continued on following page)

partial summary judgment. Fed. R. Civ. P. 56. For the reasons which follow Chemtrol's motion is granted.

On September 20, 1977 Morgan filed a motion to stay proceedings in this case so that it could file an application for reissue of the '645 patent with the United States Patent and Trademark Office, (hereinafter, patent office). The motion was filed because the patent office had not considered certain prior art during the prosecution of the '645 patent. In its motion Morgan asserted that "[t]he greatest expertise respecting the applicability of prior art to the claimed invention resides in the USPTO . . .". Four (4) protests including one by Chemtrol, were filed in response to Morgan's application for reissue. Morgan filed a brief in support of its application to which Chemtrol

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Footnote continued—

found or has an agent, without respect to the amount in controversy, and shall recover threefold the damages by him sustained, and the cost of suit, including a reasonable attorney's fee. The court may award under this section, pursuant to a motion by such person promptly made, simple interest on actual damages for the period beginning on the date of service of such person's pleading setting forth a claim under the antitrust laws and ending on the date of judgment, or for any shorter period therein, if the court finds that the award of such interest for such period is just in the circumstances. In determining whether an award of interest under this section for any period is just in the circumstances, the court shall consider only—

(1) whether such person or the opposing party, or either party's representative, made motions or asserted claims or defenses so lacking in merit as to show that such party or representative acted intentionally for delay, or otherwise acted in bad faith;

(2) whether, in the course of the action involved, such person or the opposing party, or either party's representative, violated any applicable rule, statute, or court order providing for expeditious proceedings; and

(3) whether such person or the opposing party, or either party's representative, engaged in conduct primarily for the purpose of delaying the litigation or increasing the cost thereof.

filed a reply. On October 11, 1978 the patent office examiner [3] rejected all claims contained in the '645 patent under 35 U.S.C. §§ 102(b),[3] 103[4] and 112.[5] On or about

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3. 35 U.S.C. § 102(b) provides as follows:

A person shall be entitled to a patent unless—

. . .

the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to date of the application for patent in the United States. . . .

4. 35 U.S.C. § 103 provides as follows:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. 35 U.S.C. § 112 provides as follows:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of

(Continued on following page)

January 10, 1979 Morgan filed a "response to [the] [4] patent office action" in which it amended the specification and each of the four (4) claims contained in the '645 patent. Attached to this response were transcripts of depositions taken in this case. On February 7, 1979 Chemtrol filed a reply to Morgan's response and on February 21, 1979 Morgan filed a supplemental response. On March 3, 1979 the patent office examiner repeated and made "final" his rejection of all claims contained in the '645 patent. Once again, Morgan responded by filing an amended application which incorporated discovery obtained in this case. On July 13, 1979 the patent office examiner repeated his rejection of all claims contained in the '645 patent.

On November 9, 1979 Morgan filed a notice of appeal to the United States Patent and Trademark Office Board of Appeals (hereinafter, board). Chemtrol was permitted to participate in the appeal and filed a brief in response to one filed by Morgan. On September 18, 1980 the board heard oral arguments of the parties and on October 30, 1980 affirmed the decision of the patent office examiner. On November 26, 1980 Morgan filed a request for reconsideration which was denied on December 23, 1980.

Footnote continued—

> the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.
>
> An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

On January 12, 1981 Morgan filed a notice of appeal to the United States Court of Customs and Patent Appeals.[6] On March 5, 1981 the CCPA granted Chemtrol's motion to intervene in the appeal. Thereafter, both parties filed briefs and on June 5, 1981 **[5]** oral argument took place. On July 9, 1981 the CCPA held: "The decision of the United States Patent and Trademark Office Board of Appeals sustaining the examiner's rejection of claims 1-4 under 35 U.S.C. § 103 is *affirmed.*" (Emphasis in original). On July 28, 1981 Morgan filed a petition for a rehearing to which Chemtrol filed a brief in opposition. On September 3, 1981 the CCPA denied Morgan's petition.

On September 10, 1981 Morgan filed a request for a continuation application for reissue proceedings in the patent office. On or about about November 1, 1982 the patent office examiner rejected Morgan's claims for several reasons, one of which was that they were barred by the doctrine of *res judicata* under the decision of the CCPA.

In *Lawlor v. National Screen Service Corp.*, 349 U.S. 322, 326, 75 S. Ct. 865, 867 (1955), the United States Supreme Court held that "under the doctrine of *res judicata*,

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6. Effective October 1, 1982 the United States Court of Customs and Patent Appeals and the United States Court of Claims were abolished by the Federal Courts Improvement Act of 1982. The Act created the Court of Appeals for the Federal Circuit. The court was established under Article III of the Constitution of the United States. It is composed of the twelve (12) judgeships of the United States Court of Customs and Patent Appeals and the United States Court of Claims. Its jurisdiction is defined by subject matter and it has exclusive jurisdiction "of an appeal from a final decision of a district court . . . if the jurisdiction of that court was based, in whole or in part, on section 1338 of [Title 28] . . .". 28 U.S.C. § 1295(a)(1). In its first decision, *South Corp. v. United States*, 690 F.2d 1368 (Fed. Cir. 1982), the Court of Appeals for the Federal Circuit held that the holding of its predecessor courts would be binding on it. *See*: 28 U.S.C. § 1296. Hereinafter, the United States Court of Customs and Patent Appeals shall be referred to as "CCPA" and the United States Court of Appeals for the Federal Circuit as "CAFC."

a judgment 'on the merits' in a prior suit involving the same parties or their privies bars a second suit based on the same cause of action." *Accord*: *Kremer v. Chemical Construction Corp.*, ... U.S. ....., 102 S. Ct. 1883, 1889, n. 6 (1982); *Allen v. McCurry*, 449 U.S. 90, 94, 101 S. Ct. 411, 414 (1980). The Court has also held that "[u]nder collateral estoppel, once an issue is actually and necessarily determined by a court of competent jurisdiction, that determination is conclusive in subsequent suits based on a different cause of action involving a party to the prior litigation." *Montana v. United States*, 440 U.S. 147, 153, 99 S. Ct. 970, 973 (1979). *Accord*: *Parklane Hosiery, Inc. v. Shore*, 439 U.S. 322, 326, 99 S. Ct. 645, 649, n. 5 (1979).

In *Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation*, 402 U.S. 313, 91 S. Ct. 1434 (1971), the United States Supreme Court overruled its previous decision in *Triplett v. Lowell*, 297 U.S. 638, 56 S. Ct. 645 (1936), and held that a judgment of invalidity in a suit against one alleged to infringe a patent accrues to the benefit of any other against whom infringement of the patent is alleged unless **[6]** the owner of the patent can show that "he did not have 'a fair opportunity procedurally, substantively and evidentially to pursue his claim the first time'." 402 U.S. at 333, 91 S. Ct. at 1445. (Citation omitted).

In *Blonder-Tongue*, the University of Illinois Foundation, (hereinafter, Foundation), as the owner of the patent in issue, filed an action for infringement against the Winegard Company in the United States District Court for the Southern District of Iowa. The court held the patent invalid and the Court of Appeals for the Eighth Circuit affirmed on appeal.[7] Thereafter, the United States Supreme Court denied the Foundation's petition for cer-

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7. *University of Illinois Foundation v. Winegard Co.*, 271 F. Supp. 412 (S.D. Iowa 1967, *aff'd.*, 402 F.2d 125 (8th Cir. 1968).

tiorari.[8] While the action was pending before the trial court, the Foundation filed another action for infringement against a customer of Blonder-Tongue Laboratories (hereinafter, Blonder-Tongue), in the United States District Court for the Northern District of Illinois. Blonder-Tongue intervened in the action to argue that the patent was invalid. In pertinent part, the United States District Court for the Northern District of Illinois held the patent valid and the Court of Appeals for the Seventh Circuit affirmed.[9] The United States Supreme Court granted a petition for certiorari and directed the parties to brief and argue the following questions:

> 1. Should the holding of *Triplett v. Lowell*, 297 U.S. 638 [56 S. Ct. 645, 80 L.Ed. 949], that a determination of patent invalidity is not res judicata as against the patentee in subsequent litigation against a different defendant, be adhered to?
>
> 2. If not, does the determination of invalidity in the *Winegard* litigation bind the respondents in this case?

[7] 402 U.S. at 317, 91 S. Ct. at 1437. The Court resolved the first question in the negative and remanded the case to permit Blonder-Tongue to plead the defense of collateral estoppel and the Foundation to plead and prove why the defense would not prevail.[10] In pertinent part, the Court held:

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8. 394 U.S. 917, 89 S. Ct. 1191 (1969).

9. *University of Illinois Foundation v. Blonder-Tongue Laboratories, Inc.*, 422 F.2d 769 (7th Cir. 1970).

10. On remand the United States District Court for the Northern District of Illinois granted Blonder-Tongue's motion for summary judgment on the issue of collateral estoppel and the Court of Appeals for the Seventh Circuit affirmed. 334 F. Supp. 47 (N.D. Ill. 1971), *aff'd.*, 465 F.2d 380 (7th Cir.), *cert. denied*, 409 U.S. 1061, 93 S. Ct. 559 (1972).

> Determining whether a patentee has had a full and fair chance to litigate the validity of his patent in an earlier case is of necessity not a simple matter. *In addition to the considerations of choice of forum and incentive to litigate* mentioned above, certain other factors immediately emerge. For example, if the issue is nonobviousness, *appropriate inquiries would be whether the first validity determination purported to employ the standards announced in Graham v. Deere Co., supra; whether the opinions filed by the District Court and the reviewing court, if any, indicate that the prior case was one of those relatively rare instances where the courts wholly failed to grasp the technical subject matter and issues in suit;* and *whether without fault of his own the patentee was deprived of crucial evidence or witnesses in the first litigation.* But as so often is the case, no one set of facts, no one collection of words or phrases, will provide an automatic formula for proper rulings on estoppel pleas. In the end, decision will necessarily rest on the trial court's sense of justice and equity.

402 U.S. at 333-334, 91 S. Ct. at 1445. (Footnotes omitted). (Emphasis added). One commentator has observed that "[l]ower court decisions after *Blonder-Tongue* generally rebuff efforts by patent owners to establish absence of full and fair opportunity to litigate." 4 Chisum, *Patents*, § 19.02[2]. (Footnote omitted). *See: e.g., Westwood Chemical Inc. v. Molded Fiber Glass Body Co.*, 498 F.2d 1115, 1120 (6th Cir. 1974), ". . . Westwood has failed in its burden of showing that it was denied a substantively fair trial . . ."; *Kaiser Industries Corp. v. Jones & Laughlin Steel Corp.*, 515 F.2d 964, 982, *modified on other grounds*, 524 F.2d 1154 (3d Cir. 1975), *cert. denied*, 423 U.S. 876, 96 S. Ct. 150 (1976), ". . . a patentee . . . must persuade

the second court that the additional evidence was crucial to a proper resolution in the first tribunal and [8] that the patentee bore no responsibility for the absence of the evidence in the prior trial." Indeed, in *Kaiser Industries Corp. v. Jones & Laughlin Steel Corp., supra*, 515 F.2d at 987, the Court of Appeals for the Third Circuit held that *Blonder-Tongue* "does not authorize unbridled excursions into the record of the earlier trial before applying the estoppel of the previous judgment."

Morgan contends that it is not collaterally estopped from litigating the validity of the '645 patent before this court because: (1) the decision of the CCPA was advisory only; and (2) "[t]here has not been a full evidentiary hearing on the issue of validity." Plaintiff's Brief in Opposition to Motion of Defendant for Partial Summary Judgment, p. 7. For the reasons which follow the court finds both of Morgan's contentions to be without merit.

In *McCormick Harvesting Machine Co. v. Aultman-Miller Co.*, 169 U.S. 606, 612, 18 S. Ct. 443, 445 (1898), the United States Supreme Court held that when a patent is issued the patent office has "no power to revoke, cancel or annul it." The Court held further that "[u]pon application being made for . . . reissue the patent office [is] authorized to deal with all its claims, the originals as well as those inserted first in the application, and might declare them to be invalid, *but such action would not affect the claims of the original patent which remain . . . in full force, if the application for reissue* [*is*] *rejected or abandoned.*" *Id.* (Emphasis added). *Accord: Allen v. Culp*, 166 U.S. 501, 505, 17 S. Ct. 644, 645 (1897), ". . . if the original application for a reissue be rejected, the original patent stands precisely as though a reissue had never been applied for . . .". Construing these decisions the CCPA has held:

> An application for a reissue is accompanied by a mere offer to surrender the original patent in the event the reissue application is allowed and the patent reissued. However, if the reissue application is not allowed, or if it is abandoned, the original patent is not surrendered, nor is the subject matter of the claims therein relinquished.

[9] *McCoy v. Pfeiffer,* 133 F.2d 913, 917 (CCPA 1943). *See also*: *Bally Mfg. Corp. v. Diamond,* 629 F.2d 955, 958 (4th Cir. 1980), "A reissue rejection, whether based on the finding of the examiner that the original patent is entirely valid or on his finding that the reissue claims do not describe a patentable invention, is *purely advisory.*" (Footnote omitted). (Emphasis aded). Although it is well established that "the Patent Office does not have the power or authority to declare a patent invalid," *United Merchants & Manufacturers, Inc. v. Henderson,* 495 F. Supp. 444, 447 (N.D. Ga. 1980), (citation omitted), it is unquestioned that such rule of law does not resolve the issue presented in this case because Morgan appealed the decision of the patent office to the CCPA which was a court established under Article III of the Constitution of the United States.[11] *See*: *Brenner v. Manson,* 383 U.S. 519, 86 S. Ct. 1033 (1966).

In 1977 the patent office amended Rule 175 to permit the owner of a patent to file an application for reissue proceedings without seeking any change in the specification or claims of the patent and without alleging any defect in order to obtain reexamination of the claims in light of prior art that was discovered after the date upon which the patent was issued. 37 C.F.R. § 1.175(a)(4). The rule provided that "when the applicant is aware of prior art or other information relevant to patentability, not pre-

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11. *See*: F.N. 6, *supra.*

viously considered by the office, which might cause the examiner to deem the original patent wholly or partly inoperative or invalid," an application for reissue would be entertained if it contained "a statement or declaration . . . particularly specifying such prior art or other information and requesting that if the examiner so deems, the applicant be permitted to amend the patent and be granted a reissue patent." In enacting the rule, the patent office reasoned as follows:

> [10] Thus, a patentee may file a reissue if he believes his patent is valid over prior art not previously considered by the Office but would like to have a reexamination. The procedure may be used at any time during the life of a patent. During litigation, a federal court may, if it chooses, stay proceedings to permit new art to be considered by the Office.
>
> If a reissue application is filed as a result of new prior art with no changes in the claims or specification and the examiner finds the claims patentable over the new art, the application will be rejected as lacking statutory basis for a reissue, since 35 U.S.C. 251 does not authorize reissue of a patent unless it is deemed wholly or partly inoperative or invalid. However, the record of prosecution of the reissue will indicate that the prior art has been considered by the examiner.

42 Fed. Reg. 5588 (1977).[12]

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12. In 1982 the patent office abolished Rule 175(a)(4). The purpose related for the change was to "permit some of the Patent & Trademark Office resources now devoted to consideration of the so-called 'no-defect' reissue applications, and to extensive participation by protestors during application examination, to be directed toward reduction of the backlog of pending patent applications." 47 Fed. Reg. 21746 (1982). The patent office also noted that although it "gave advisory opinions on patentability over additional prior art without any changes in the patent claims" the "courts have generally refused to give preclusive effect to these advisory opinions." *Id.*, at 21748-21749.

In *In re Dien*, 680 F.2d 151 (CCPA 1982), the CCPA dismissed an appeal from a decision rendered on an application for reissue proceedings under Rule 175(a)(4) for lack of subject matter jurisdiction. The court held:

> *The fact that the PTO's alleged board "decision," which we are asked to review, is merely an advisory opinion is conclusive of our lack of jurisdiction. To review an advisory opinion would be to give one.* We are a court established under Article III of the Constitution. *Glidden Co. v. Zdanok*, 370 U.S. 530, 584, 587, 82 S. Ct. 1459, 1490, 1492, 8 L.Ed.2d 671 (1962). As such, our power is constitutionally limited to the decision of "*cases*" and "*controversies.*" Const. Art. III, sec. 2; *Muskrat v. United States*, 219 U.S. 346, 31 S. Ct. 250, 55 L.Ed. 246 (1910). *An advisory opinion by the PTO does not fit in either of those categories and we lack the power to review it. Swingline v. Kleinert*, 55 C.C.P.A. 1486, 1489, 399 F.2d 283, 285, 158 U.S.P.Q. 341, 342 (1968), Rich, J., concurring, and authorities therein cited.

680 F.2d at 155. (Emphasis added). *Accord*: *In re Bose*, 687 F.2d 432 (CCPA 1982). Premised on these decisions Morgan argues that the decision of the CCPA which held the '645 patent invalid was "merely an advisory opinion" and, therefore, a "nullity" in law. The court is not persuaded by Morgan's argument.

[11] In *Chicot County Drainage Dist. v. Baxter State Bank*, 308 U.S. 371, 60 S. Ct. 317 (1940), the United States Supreme Court held that although subject to "direct review," a determination by a federal court that it sustains subject matter jurisdiction over a cause of action "*may not be assailed collaterally.*" 308 U.S. at 376, 60 S. Ct. at 319 (Emphasis added). The Court of Appeals for the Third Circuit has held:

> It was settled long ago by *Chicot County Drainage District v. Baxter State Bank*, 308 U.S. 371, 60 S. Ct. 317, 84 L.Ed. 329 (1940), that when a federal court proceeds to final judgment on the merits, the issue of its subject matter jurisdiction is res judicata even though it was not litigated or, indeed, even though the decree was totally uncontested.

Hodge v. Hodge, 621 F.2d 590, 592 (3d Cir. 1980). (Footnote omitted). Indeed, "[a] party is foreclosed from litigating subject matter jurisdiction in a subsequent lawsuit except if the lack of jurisdiction was so clear that its assumption 'was a manifest abuse of authority,' the challenged judgment 'would substantially infringe the authority of another tribunal or [governmental] agency,' or the rendering court was incapable of making an adequately informed assessment of its own jurisdiction." *Id.* at 593.

It is unquestioned that Morgan amended the specification and each of the four (4) claims contained in the '645 patent in response to the first rejection by the patent office examiner. It is equally clear that Morgan filed additional amendments subsequent to the second rejection. Under section 1414.02 of the Manual of Patent Examining Procedure "[i]f a reissue filed under subsection 1.175(a)(4) is amended, even though in response to a rejection, the reissue is thereby converted into an application under subsection 1.175(a)(1), and appropriate subsections 1.175(a)(2) and/or (a)(3) . . .".[13] **[12]** Since the CCPA has in-

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13. *See*: 37 C.F.R. §§ 1.175(a)(1)-(3) which provides as follows:

> Applicants for reissue, in addition to complying with the requirements of the first sentence of § 1.65, must also file with their applications a statement under oath or declaration as follows:

(Continued on following page)

dicated that appeals over applications for reissue proceedings would be appropriate under such circumstances, *In re Bose, supra; In re Dien, supra,* it is unquestioned that it could have considered Morgan's appeal to present a "case" or "controversy" within its subject matter jurisdiction. *See*: 35 U.S.C. §§ 251[14] and 141.[15] **[13]** Therefore, this

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Footnote continued—

When an applicant verily believes the original patent to be wholly or partly inoperative or invalid, stating such belief and the reason why.

When it is claimed that such patent is so inoperative or invalid "by reason of a defective specification or drawing," particularly specifying such defects.

When it is claimed that such patent is inoperative or invalid "by reason of the patentee claiming more or less than he had the right to claim in the patent," distinctly specifying the excess or insufficiency in the claims.

14. 35 U.S.C. § 251 provides as follows:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The Commissioner may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

15. 35 U.S.C. § 141 provides as follows:

(Continued on following page)

court holds that Morgan may not collaterally attack the subject matter jurisdiction of the CCPA. In addition, and for the reasons which follow, the court holds that Morgan is collaterally estopped from litigating the validity of the '645 patent.

In *California Computer Products, Inc. v. Simplicity Pattern Co., Inc.*, 194 U.S.P.Q. 367 (C.D. Cal. 1977), the court was confronted with facts nearly identical to those before this court. The plaintiff filed an action for infringement of its patent. "The parties vigorously prosecuted and

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Footnote continued—

> An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Appeals for the Federal Circuit, thereby waiving his right to proceed under section 145 of this title. A party to an interference dissatisfied with the decision of the board of patent interference on the question of priority may appeal to the United States Court of Appeals for the Federal Circuit, but such appeal shall be dismissed if any adverse party to such interference, within twenty days after the appellant has filed notice of appeal according to section 142 of this title, files notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 146 of this title. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under section 146, in default of which the decision appealed from shall govern the further proceedings in the case.

At the time of Morgan's appeal, 35 U.S.C. § 141 provided as follows:

> An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Customs and Patent Appeals, thereby waiving his right to proceed under section 145 of this title. A party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority may appeal to the United States Court of Customs and Patent Appeals, but such appeal shall be dismissed if any adverse party to such interference, within twenty days after the appellant has filed notice of appeal according to section 142 of this title, files notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 146 of this title. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under section 146, in default of which the decision appealed from shall govern the further proceedings in the case.

defended the action," until the plaintiff filed an application for reissue proceedings with the patent office. 194 U.S.P.Q. at 368. The patent office rejected the plaintiff's application for reissue, the board of patent appeals affirmed and the CCPA affirmed the decision of the board. Thereafter, the United States Supreme Court denied a petition for certiorari. After the CCPA had affirmed but before the petition for certiorari was denied, the plaintiff filed a continuation application for reissue proceedings with the patent office which was denied. On a defense motion for summary judgment which asserted the affirmative defense of collateral estoppel, the court held as follows:

> [14] The decision in Blonder-Tongue approves a plea of estoppel in patent cases where the party asserting the patent had enjoyed a full opportunity to present his side of the case. Blonder-Tongue concerned the effect of a judgment in one patent infringement suit on another infringement suit on the same patent. Where, as here, the litigation centered in the Court of Customs and Patent Appeals, and concerned whether a patent even exists, the logic of Blonder-Tongue is even more compelling. *Plaintiff cannot create a patent in this Court; he must first have one authorized by the Patent Office. Once the Court of Customs and Patent Appeals finally decides that he has no patent, this Court cannot entertain a claim of infringement.*
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> . . .
>
> *Plaintiff has long represented to this Court that we should have the benefit of the expertise of the Patent Office. Now that we have that benefit, plaintiff would have us ignore it because the expertise weighs against him. We decline to follow such an approach.*

194 U.S.P.Q. at 369-370. (Emphasis added). Accordingly, the court granted the defendants' motion. Similarly, in *W. F. Altenpohl, Inc. v. Gainesville Machine Co., Inc.*, 185 U.S.P.Q. 500 (N.D. Ga. 1974), the plaintiff, Altenpohl, filed an action for infringement of its patent against the defendant, Gainesville. After the action was filed, the plaintiff filed an application for reissue proceedings with the patent office. The patent office rejected the plaintiff's application for reissue, the board of patent appeals affirmed and the plaintiff filed an appeal with the CCPA. While that appeal was pending the court ruled on the defendants' motion for summary judgment and for an award of attorneys' fees and the plaintiff's motion to stay proceedings pending disposition of the appeal. The court held as follows:

> *It appears to the court that at present plaintiff does not have a valid patent claim about which to allege infringement.* As matters now stand the Patent Office has ruled that Claims 12, 14, and 16 were fully anticipated by the 265 patent and it is these claims which plaintiff says have been infringed. *The court thus concludes that summary judgment in the nature of a dismissal should be granted; however, the dismissal is stayed until December 1, 1974. If before that date plaintiff is able to obtain a patent on which to base an infringement suit, then plaintiff can at that point move the court to continue the case.*
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> . . .
>
> If plaintiff succeeds before the Court of Customs and Patent Appeals then there will be a full scale law suit to try. If so, the attorneys' fees questioned [sic] could be readily handled. *If plaintiff loses its case before the Court of Customs and Patent Appeals, then the attorneys' fees question will be all that is at issue.* It is the court's view that it should not reach

> the question until it is determined whether there will be a law suit.

[15] 185 U.S.P.Q. at 500-501. (Emphasis added). The court finds these decisions dispositive of the question presented in this case. Accordingly, the court holds that Morgan is collaterally estopped from litigating the validity of the '645 patent.

The court so holds notwithstanding Morgan's contention that it was denied a full and fair opportunity to litigate validity because such a contention is utterly without merit. During the five (5) years that Morgan was before the patent office, the board of patent appeals and the CCPA, it filed numerous briefs and reply briefs, presented affidavits of experts, used deposition testimony taken during discovery in this case and orally argued validity twice. Indeed, when it was before the CCPA Morgan presented a movie and distributed samples of its product. In *Kaiser Industries Corp. v. Jones & Loughlin Steel Corp., supra,* the Court of Appeals for the Third Circuit construed the decision of the United States Supreme Court in *Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation, supra,* and held:

> *The guidelines suggested for reaching a result permitting relitigation are replete with qualifying words making a patentee's burden onerous. In effect, a patentee must persuade a second trial court "that the prior proceedings were seriously defective."*

(Footnote omitted). (Emphasis added). The court holds that Morgan has failed to meet its burden of showing "that the prior proceedings were seriously defective."[16]

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16. The court is also not persuaded by Morgan's claim that "[i]t is a denial of due process to trap a litigant by chang-

(Continued on following page)

Accordingly, the defendant's motion for summary judgment is granted. *See*: *Smith v. Hudson*, 600 F.2d 60 (6th Cir.), *cert. denied*, 444 U.S. 986, 100 S. Ct. 495 (1979).

IT IS SO ORDERED.

/s/ JOHN M. MANOS
United States District Judge

ORDER

Pursuant to the Memorandum of Opinion issued in the above-captioned case this date, the defendant's motion motion for summary judgment is granted.

IT IS SO ORDERED.

/s/ JOHN M. MANOS
United States District Judge

Footnote continued—

ing the rules after he has embarked upon an established course." Brief of Morgan Adhesives Company on Issue of Res Judicata and Collateral Estoppel, p. 10. Since a "court is to apply the law in effect at the time it renders its decision, unless doing so would result in manifest injustice or there is no statutory direction or legislative history to the contrary," *Bradley v. School Board of City of Richmond*, 416 U.S. 696, 711, 94 S. Ct. 2006, 2016 (1975); *Harper-Grace Hospitals v. Schweiker*, 691 F.2d 808, 811 (6th Cir. 1982), and the court finds that Morgan had and utilized a full and fair opportunity to litigate the validity of the '645 patent, its claim of due process is without merit.

JUDGMENT ENTRY OF THE COURT OF APPEALS FOR THE FEDERAL CIRCUIT

(Dated February 7, 1985)

No. 83-1258
83-1196

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

MORGAN ADHESIVES COMPANY,
Appellant,
v.
CHEMTROL ADHESIVES, INC.,
Appellee.

JUDGMENT

ON APPEAL from the U.S. District Court for the Northern District of Ohio (East. Div).

This CAUSE having been heard and considered, it is ORDERED and ADJUDGED: AFFIRMED.

ENTERED BY ORDER
OF THE COURT

GEORGE E. HUTCHINSON, *Clerk*

/s/ DOROTHY I. MYERS
Chief Deputy Clerk

Petition for Rehearing,
Denied, March 8, 1985

ORDER OF THE COURT OF APPEALS FOR THE FEDERAL CIRCUIT DENYING PETITION FOR REHEARING

(Dated March 8, 1985)

No. 83-1258, 83-1196

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

MORGAN ADHESIVES COMPANY,
Appellant,

v.

CHEMTROL ADHESIVES, INC.,
Appellee.

ORDER

A petition for rehearing having been filed in this case,

UPON CONSIDERATION THEREOF, it is Ordered by the court that the petition for rehearing be, and the same is hereby, Denied.

FOR THE COURT:

/s/ GEORGE E. HUTCHINSON
Clerk

1414.02 Reissue Oath or Declaration under § 1.175(a)(4) [R-1]

Subsection 1.175(a)(4) recognizes that reissues may be filed to have the patentability of the original patent, without changes therein, considered in view of prior art or other information relevant to patentability which was not previously considered by the Office.

37 CFR 1.175 (a)(4) has been held to be within the rulemaking power of the Commissioner in *Sheller Globe Co. v. Mobay Chemical Corp.* Civil Action No. 78-70563, (E. D. Mich., Southern Div., 1980) BNA/PTCJ 468: A-8, 9.

Subsection (a)(4) does not contemplate, or permit, the filing of a reissue application without an oath or declaration. To the contrary, an oath or declaration is required, and such oath or declaration must comply with each of subsections (a)(4), (a)(5) and (a)(6) of § 1.175: Potter v. Dann, 201 USPQ 574, 575 (D.C. D.C. 1978).

The reissue oath or declaration of the § 1.175 (a)(4) type must

(1) state that "the applicant is aware of prior art or other information relevant to patentability, not previously considered by the Office, which might cause the examiner to deem the original patent wholly or partly inoperative or invalid",

(2) particularly specify "such prior art or other information"; and,

(3) request "that if the examiner so deems, applicant be permitted to amend the patent and be granted a reissue" (see § 1401.08(b)). In addition a § 1.175(a)(4) type re-

issue oath or declaration must comply with subsections (a)(5) and (a)(6) of § 1.175 (§§ 1401.08(c) and (d)).

However, no reissue application will be passed for issue with only a § 1.175(a)(4) type oath or declaration. Applications filed under § 1.175(a)(4) *cannot* be passed for issue *without* amendment, but will be rejected as lacking statutory basis for a reissue, if there are no other grounds of rejection, since 35 U.S.C. 251 does not authorize reissue of a patent unless the patent is deemed wholly or partly inoperative or invalid. However, the record of prosecution of the reissue will indicate that the prior art has been considered by the examiner. If a reissue filed under subsection 1.175(a)(4) is amended, even though in response to a rejection, the reissue is thereby converted into an application under subsection 1.175(a)(1), and appropriate subsections 1.175(a)(2) and/or (a)(3), and a new reissue oath or declaration must be filed containing the appropriate averments.

The new reissue oath or declaration must comply with subsections (a)(1) and (a)(2)/(a)(3), (a)(5), and (a)(6) of § 1.175, relating to actual errors rather than possible or "what might be deemed to be errors." If such a proper new oath or declaration is not filed, a rejection will be made on the basis that the reissue oath or declaration is insufficient. The supplemental oath or declaration insures compliance with 35 U.S.C. 251 by providing appropriate averments relating to actual errors rather than possible errors.

Thus, a patentee may file a reissue if he or she believes his or her patent is valid over prior art not previously considered by the Office but would like to have a reexamination. The procedure may be used at any time during the life of a patent. During litigation, a federal

court may, if it chooses, stay court proceedings to permit new art to be considered by the Office.

1414.02(a) Information Considered under § 1.175(a)(4) [R-1]

The types of information contemplated under subsection 1.175(a)(4) include any information, not previously considered by the Office, which might cause the examiner to deem the original patent wholly or partly inoperative or invalid. While prior art documents such as patents and publications are most often the kinds of information which are the subject of § 1.175(a)(4) type reissues, subsection 1.175(a)(4) is not limited to prior art documents. Any information "which might cause the examiner to deem the original patent wholly or partly inoperative or invalid" may be the subject of an (a)(4) type reissue. For example, such information which might demonstrate that:

(1) the patented subject matter was publicly known or used by others in this country before the invention thereof by applicant;

(2) the patented subject matter was in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States;

(3) the patentee had abandoned the invention or did not himself invent the subject matter patented;

(4) before patentee's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it;

(5) the disclosure in the patent is insufficient in some respect under 35 U.S.C. 112;

(6) the patent otherwise lacks compliance with any of the statutory requirements for patentability;

(7) "fraud" or "violation of the duty of disclosure" is present.

The information may be in different forms, such as patents or publications. However, the information may also be based on other forms of evidentiary material including, for example, litigation related materials such as complaints, answers, depositions, answers to interrogatories, exhibits, transcripts of hearings or trials, court orders and opinions, stipulations of the parties, etc. Of course, the reissue applicant does not have to, and presumably does not, agree that the errors exist. Applicant does not have to express a personal belief as to the relevancy of the information; it is sufficient that its relevancy has been or might be asserted by someone else such as, for example, an adverse party in litigation. However, the reissue applicant must particularly specify "what might be deemed to be errors relied upon", in the reissue oath or declaration of the § 1.175(a)(4).

MOTION OF PLAINTIFF MORGAN ADHESIVES COMPANY TO STAY PROCEEDINGS

(Filed September 20, 1977)

CIVIL ACTION NO. C-76-101

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF OHIO
EASTERN DIVISION

MORGAN ADHESIVES COMPANY,
Plaintiff,

vs.

CHEMTROL ADHESIVES, INC.
a Delaware Corporation,

C/O HAROLD ROBINSON, President
and Statutory Agent,
Defendant.

Plaintiff, Morgan Adhesives Company (Morgan), respectfully moves this Court for a stay of proceedings in this case during the pendency of a reissue patent application filed with the United States Patent & Trademark Office (USPTO) respecting U.S. Letters Patent No. 3,900,645.

In its COMPLAINT, Morgan charges defendant, Chemtrol Adhesives, Inc. (Chemtrol), with infringement of the claims of Patent No. 3,900,645. Chemtrol's ANSWER AND COUNTERCLAIM, and particularly Exhibits A and B thereof, alleges the patent to be "invalid and void" on the basis of prior art not considered by the USPTO during the patent's prosecution. In considering Patent No. 3,900,645, Chemtrol's BRIEF IN SUPPORT OF DEFENDANT'S MOTION FOR SUMMARY JUDGMENT raises the same prior art presented in Exhibits A and B of its ANSWER AND COUNTERCLAIM as a basis for its request for summary judgment. It is this prior art, to wit: U.S. Patent No. 3,230,649, to Karn; U.S. Patent No. 2,319,272, to Starr; U.S. Patent No. 2,434,545, to Brady; and U.S. Patent No. 2,681,732, to Brady, which Morgan has specifically requested the USPTO to consider during the prosecution of [2] the referenced reissue patent application, forwarded to the USPTO on September 16, 1977.

The MOTION herein is brought for the purpose of availing the Court of the expertise of the USPTO for its consideration of the prior art deemed by Chemtrol to be determinative of the issue of validity of U.S. Patent No. 3,900,645.

Morgan attaches hereto its BRIEF in support of this MOTION.

Respectfully submitted,

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MORGAN'S AMENDED REISSUE APPLICATION

(Dated January 9, 1979)

TO: Commissioner of Patents and Trademarks
Washington, D. C. 20231

RESPONSE TO PATENT OFFICE ACTION

AMENDMENT

Sir:

In response to the Patent Office action mailed October 11, 1978, kindly enter the following amendments:

IN THE SPECIFICATION:

Page 5, line 25, after the period, add —As shown in Fig. 6, the lines 18 of the processed sheet 12 are compacted to a reduced thickness which may, for example, be less than one-half of the thickness of the sheet 12 proper.—

IN THE CLAIMS:

Kindly amend claims 1 and 4 as set forth below:

Claim 1. (amended) A flexible laminate for use as a label, decal or the like, comprising

a face sheet,

a layer of pressure sensitive adhesive secured to the back surface of said face sheet, and

a fiber paper backing layer removably secured to said adhesive layer and having a reduced thickness potential tear line formed in such material, the fibers of the paper backing **[2]** layer being appreciably compacted at the potential tear line, the paper having a release coating

on [its] *an* inner surface [which engages] engaging the adhesive layer.

Claim 4. (amended) A laminate as in Claim 3 where the compaction of said paper layer is from [its] *an* outer surface *opposite said inner surface* to provide a recess at said potential tear line on the outer surface of said paper layer.

REMARKS

FORMAL MATTERS ATTENDED

(Initial Paragraph and Paragraph 2 of Patent Office Action)

The application has been carefully reviewed in light of the complete Patent Office action. An amendment has been made to page 5 of the specification to cause the same to be consistent with the drawing and claims in the application. With the amendment finding antecedent basis in at least Figs. 6 and 7 of the drawing, it is trusted that the Examiner will enter such amendment in due course. Similarly, it is trusted that the Examiner will enter the amendments to claims 1 and 4 which provide for a structural relationship between the "inner" and "outer" surfaces of the fiber paper backing layer. These amendments have been made to correct the shortcomings of claims 1 and 4 as noted in paragraph 2 of the Office action, such that the referenced surfaces bear a relationship to each other and to the laminate as a whole.

The cited references have again been carefully reviewed in light of the complete Patent Office action. Such a review reinforces applicant's contention that the invention claimed in the subject reissue application is noteworthy in the [3] art, having met with outstanding commercial success, and that the claimed invention is

neither anticipated nor rendered obvious by any of the known prior art. The application, as now presented, is believed to be in proper condition for allowance for at least certain of the reasons presented hereinbelow.

Note: The remaining portion of this document has been deleted as it is irrelevant to this appeal.

MORGAN'S AMENDMENTS TO REISSUE APPLICATION

(Dated October 11, 1979)

AMENDMENT

Sir:

In response to the final rejection dated July 13, 1979, kindly enter the following amendments:

IN THE SPECIFICATION: Page 5, line 25, delete the amendatory matter provided in the response of January 10, 1979, "As shown in Fig. 6, the lines 18 of the processed sheet 12 are compacted to a reduced thickness which may, for example, be less than one-half of the thickness of the sheet 12 proper," and substitute therefor—As shown in Fig. 6, the paper backing layer may be less than one-half of its uncompacted thickness at the potential tear line 18.—

IN THE CLAIMS: Kindly amend claims 1 and 4 as set forth below:

Claim 1. (twice amended) A flexible laminate for use as a label, decal or the like, comprising:

a face sheet,

a layer of pressure sensitive adhesive secured to the back surface of said face sheet, and

a fiber paper backing layer removably secured to said adhesive layer and having a reduced thickness potential tear line formed in such material, the fibers of the paper backing layer being appreciably compacted at the potential tear line, the paper having a release coating on its [an] inner surface *which engages* [engaging] the adhesive layer.

[2] CLAIM 4. (twice amended) A laminate as in Claim 3 where the compaction of said paper layer is from *its* [an] outer surface [opposite said inner surface] to provide a recess at said potential tear line on the outer surface of said paper layer.

REMARKS

The application has been carefully reconsidered in light of the various Office actions. It is respectfully presented that the application, as now presented, is in proper condition for allowance for at least certain of the claims presented hereinbelow.

ATTENTION TO MATTERS OF FORM

The specification has been amended to conform to the helpful suggestion of the Examiner as set forth in the Office action dated March 2, 1979. Particularly, line 25 of Page 2 has been amended to include the acceptable language of Claim 3 with respect to the nature of the potential tear line 18.

Claims 1 and 4 have been amended to conform to the language of those claims as originally filed. Claim 1 clearly defines the inner surface of the paper as being that surface having a release coating thereon which engages the adhesive layer. It is a simple matter for one to follow the recitations of Claim 1 and to construct the article defined thereby, for the language of the claim is clear as to the elements comprising the article and their interrelationships with each other.

Claim 4 recites the existence of the paper layer's outer surface. The inner surface of the paper layer is clearly defined in Claim 1 and, since the paper has but two sides, it is inherent that the outer surface must be that opposite

the inner surface. [3] Further, by following the structure of Claim 1 it is apparent that the inner surface is that surface which is unexposed, engaging the adhesive layer, and the outer surface must then be one which is exposed. Accordingly, it is presented that the claims particularly point out and distinctly claim the subject matter of the invention as required by 35 USC 112.

Note: The remaining portion of this document has been deleted as it is irrelevant to this appeal.

APPELLANT'S PETITION FOR REHEARING SUPPLEMENTAL SUBMISSION IN THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

(Dated March 8, 1985)

Appeal Nos. 83-1258 and 83-1196

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

MORGAN ADHESIVES COMPANY,
Appellant,

vs.

CHEMTROL ADHESIVES, INC.,
Appellee.

APPEAL FROM JUDGMENT OF JUDGE JOHN M. MANOS IN THE UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF OHIO, EASTERN DIVISION

PETITION OF MORGAN ADHESIVES COMPANY FOR REHEARING UNDER CAFC RULE 19 SUPPLEMENTAL SUBMISSION

Appellant submits the further argument set forth hereinbelow to supplement its Petition for Rehearing of the Decision rendered by the Court on February 7, 1985.

1. The Appellant Morgan Adhesives Company has not been granted due process of the law by having

the opportunity to prove that the invention of the Morgan Patent 3,900,645 has enjoyed outstanding commercial success and should therefore have been entitled to an evaluation on patentability in accordance with the line of CAFC decisions represented by *Stratoflex, Inc., the Aero Equipment Corp.*, 218 USPQ 871, which was decided July 25, 1983 by the Court of Appeals for the Federal Circuit.

Additional law that commercial success is now a significant consideration on obviousness is *Simmons Fastener vs. Illinois Tool Works*, 222 USPQ 744, (CAFC - 1984).

At the time of the progress of the reissue application through the Patent Office the impact of commercial success on patentability was quite uncertain, and, in fact, the office would probably not have considered any evidence in that regard. The clarification of the impact of commercial success on obviousness has occurred through the CAFC during the pendency of this case and that has denied Appellant to due process.

This invention is now being copied by nearly every competitor in the trade, these comprising about nine or ten pressure sensitive adhesive manufacturers, including Fasson, a Division of Avery International. It comprises a significant advancement in the pressure sensitive industry, and represents millions of dollars in product sales.

Appellant has been denied due process by not having the opportunity to present live testimony regarding this commercial success, and respectfully urges this Court to remand to the District Court so that live testimony and other factual evidence on the tremendous commercial

success of this invention can be presented and considered with regard to the question of obviousness.

Remand is respectfully requested.

Respectfully submitted,

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EDWIN W. OLDHAM
RAY L. WEBER

Date: March 8, 1985

Office - Supreme Court, U.S.
FILED
JUL 3 1985
ALEXANDER STEVAS,

85- 20

No.

In the Supreme Court of the United States

October Term, 1985

MORGAN ADHESIVES COMPANY,
Petitioner,

vs.

CHEMTROL ADHESIVES, INC.,
Respondent.

ON CERTIORARI TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

SUPPLEMENTAL APPENDIX TO PETITION FOR WRIT OF CERTIORARI

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July 6, 1985

THE GATES LEGAL PUBLISHING CO., CLEVELAND, OHIO—TEL. (216) 621-5647

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EXHIBIT 6

United States Patent [19]

Morgan

[11] **3,900,645**

[45] **Aug. 19, 1975**

[54] **SCORED ADHESIVE LAMINATE**

[75] Inventor: **Burton D. Morgan**, Hudson, Ohio

[73] Assignee: **Morgan Adhesives Company**, Stow, Ohio

[22] Filed: **Oct. 7, 1970**

[21] Appl. No. **78,887**

Related U.S. Application Data

[62] Division of Ser. No. 680,435, Dec. 11, 1967, Pat. No. 3,570,337.

[52] U.S. Cl. 428/41; 156/247

[51] Int. Cl. B32b 3/00

[58] Field of Search 229/56, 43; 161/167, 406, 161/116, 117

[56] **References Cited**

UNITED STATES PATENTS

1,967,444	7/1934	Lowe	161/406
2,303,346	12/1942	Flavel	161/406
2,606,141	8/1952	Eckman	156/257
3,008,792	10/1961	Wheeler	161/406
3,035,937	5/1962	Morgan	161/406
3,194,479	7/1965	Rumberger	229/43

Primary Examiner—George F. Lesmes
Assistant Examiner—R. J. Roche
Attorney, Agent, or Firm—Oldham & Oldham Co.

[57] **ABSTRACT**

Apparatus for scoring paper and other sheet materials which thereafter are formed into a laminate with an adhesive sheet. The scoring is not continuous but facilitates tearing the sheet at a later time to facilitate use of the laminate as a label or similar product.

4 Claims, 8 Drawing Figures

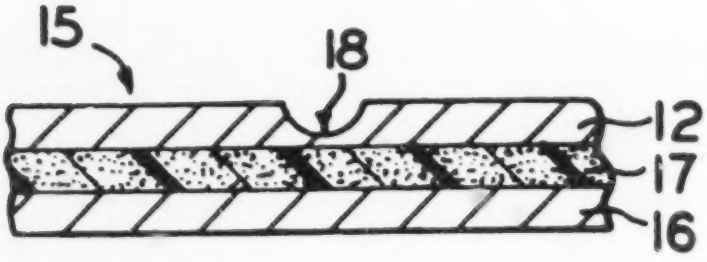


FIG. 1

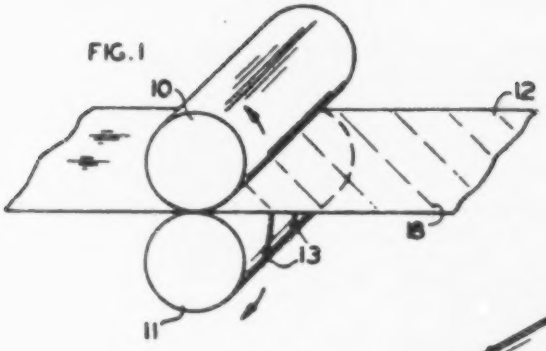
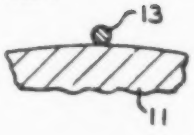


FIG. 4



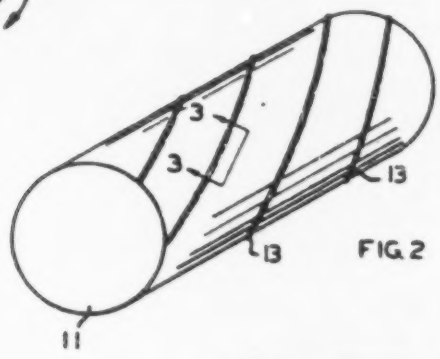


FIG. 2

FIG. 5

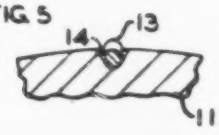


FIG. 3

FIG. 6

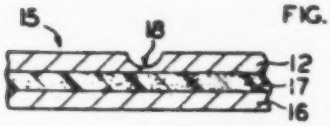
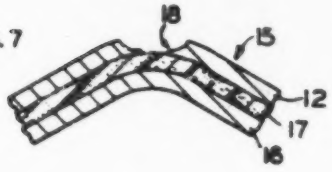


FIG. 8

FIG. 7



INVENTOR
BURTON D. MORGAN
BY Oldham & Oldham
ATTORNEYS

SCORED ADHESIVE LAMINATE

This is a division of my prior Application Serial No. [illegible] filed Dec. 11, 1967, now U.S. Pat. No. 3,570,137.

Reference is made to my own prior U.S. Pat. No. 3,039,917 which discloses one type of an adhesive product with special embossed tear zones provided therein.

This invention further relates to adhesive products such as labels, stickers, tapes and similar articles wherein the article comprises, normally, a surface sheet, a layer of adhesive secured to the back face of such surface sheet, and a removable paper backing sheet secured to the adhesive layer for ultimate removal when the label, sticker or the like is to be affixed to an article for end use purposes. It is difficult to strip labels, stickers and the like of their backing sheets to prepare them for use because no available edge of the backing sheet usually is exposed to facilitate grasping the backing sheet for its removal. U.S. Pat. No. 2,364,607 is one of the adhesive tape or label of this same general type as made heretofore, but which label or laminate provided does not in many instances accept printing uniformly.

The general object of the present invention is to provide a novel and improved laminate including a surface sheet, an adhesive layer, and a scored paper backing sheet which can readily be removed.

Another object of the invention is to form scored sheets of material, such as paper backing sheets, that are used in forming adhesive laminates or the like and wherein the backing sheet of the laminate must be removed before use of the product.

The foregoing and other objects and advantages of the invention will be made apparent as the specification proceeds.

Reference now is made to the accompanying drawings in which:

FIG. 1 is a perspective view of apparatus which is diagrammatically shown and used in forming a laminate of the invention.

FIG. 2 is an enlarged elevation of one of the rolls of FIG. 1.

FIG. 3 is a fragmentary enlarged section taken on line 3—3 of FIG. 2.

FIG. 4 is a fragmentary enlarged vertical section taken on line 4—4 of FIG. 3.

FIG. 5 is a fragmentary enlarged vertical section taken on line 5—5 of FIG. 3.

FIG. 6 is a fragmentary enlarged section of an adhesive laminate made using a sheet processed by the apparatus of FIG. 1.

FIG. 7 shows the step of splitting the adhesive laminate of FIG. 6 along a weakened area provided in the backing sheet of the laminate, and

FIG. 8 is an elevation of a modified roll of the apparatus.

When referring to corresponding members shown in the drawings and referred to in the specification, corresponding numerals are used to facilitate comparison therebetween.

Attention now is directed to the details of the structure shown in the drawings, and a pair of rolls 10 and 11, which normally are cylindrical and are made from metal, are shown in operative association to form a roll bight therebetween. Normally, at least one of the rolls is driven whereby pressure engagement is provided at

the roll bight for a sheet or strip of material 12 which will be drawn through the roll bight. Normally in the practice of use of the apparatus of the invention, the sheet or strip 12 would be formed from a fibrous material, such as paper, of the type that conventionally is used for forming backing sheets in adhesive laminates. Adhesive laminates using the sheets 12 may be used for making stickers, labels or other articles therefrom. Normally the sheets 12 are quite thin such as in the range of from about 0.001 inch to about 0.005 inches in thickness.

It is an important feature of the present invention that the roll 11 has one or more metal wires 13 secured to the surface thereof. These wires 13 preferably would be made from spring steel and, for example, would have a diameter of approximately 0.010 inch but the wire thickness can be varied dependent upon the thickness of the sheets 12 being processed and the desired amount of scoring to be provided thereon. The wire or wires 13 can be secured to the periphery of the roll 11 in any desired manner, as by spot welding or otherwise securing at least the ends of the wire 13 to the metal roll 11. However, if desired, the wire 11 could be affixed to the roll by a suitable adhesive, such as a conventional epoxy type of an adhesive which will set up at room temperature or at slightly elevated temperatures to give a good bond of the wire 13 to the roll. The wires are helically positioned on the roll 11.

It is another feature of the present invention that parts of the wires 13, at longitudinally spaced sections of the wire would have complementary shaped recesses 14 formed in the surface of the roll 11 for receiving a length of the wire 13 when the rolls 10 and 11 operatively engage whereby the wire 13 will not form a continuous scored or weakened area, zone or line in the sheet 12 being processed. Intermittent lengths of the sheet 12 would not be effected at all because the wire 13 would have sufficient resilience or stretch, and would have no backing provided therefor at the longitudinally spaced portions of the wires lying over the recesses 14 so that portions of the wire will just be pushed into the recesses 14 when the rolls engage. This particular construction of the wires and rolls leaves sufficient strength in the sheet 12 whereby it can be readily further processed without any danger of splitting or tearing while being processed or prepared for use. At the same time, the recesses 14 would only be provided at, for example, intervals of 1 or 2 inches along the periphery of the roll 11, and such recesses 14 necessarily could be quite short, such as approximately ¼ to ½ inch or so.

By passing the sheet 12 through the roll bight, the fibrous material forming the sheet 12 will be crushed or weakened by a compaction of the fibres in the sheet in lineal zones or lines 18 of the sheet where the wire 13 contacts it and where the wire is backed up by the surface of the roll 11.

FIG. 3 shows how a plurality of the small recesses 14 could be formed in the periphery of the roll for receiving longitudinally spaced portions of the wire 13 thereon when the roll 11 is operative. FIG. 5 in turn indicates how this wire can be received in the recess for passing portions of the sheet 12 through the roll bight without any scoring action on spaced areas of the sheet 12.

After the sheet 12 has been processed by being fed through the roll bight between the rolls 10 and 11, then

it can be thereafter treated in any conventional manner. Thus, for example, a layer of a release material of a conventional nature, such as a silicone base composition, can be applied to one surface of the sheet 12 and thereafter a laminate 15 can be made in a conventional manner and which laminate could, for example, include a surface layer 16, a layer of a conventional adhesive composition 17 attached to the layer 16, and then the release coated surface of the sheet 12 would be releasably affixed to the opposite face of the adhesive layer 17. Any desired pressure sensitive or other adhesives can be used in forming the laminate 15 and such adhesives may, for example, be of the compositions described on Page 506 of "Handbook of Adhesives" by Skeist.

After the laminate 15 has been fully prepared for use as by printing any desired data thereon after the laminate is made, or before the components thereof are assembled, as desired, then the laminate 15 can be cut to a desired shape, or otherwise be prepared for use. When the laminate is to be used, it is a relatively simple matter to fold or bend the laminate 15 in a direction as shown in FIG. 7 so as to tension the weakened zone or line 18 provided on the sheet 12 whereby such backing paper will split or tear along this line 18, the sheet 12 is removed, and the adhesive layer 17 can be exposed for securing the label product to a carrier surface for use. Thus, it is believed that the objects of the invention have been achieved and that a new and improved apparatus has been provided for creating or weakening ultimate tear lines or zones in sheet material, such as paper and the like, and a new laminate is provided.

In some instances, it may be desirable to use a roll such as a roll 20 shown in FIG. 8 rather than the roll 11 in combination with the roll 10 for forming weakened zones, areas or lines in a processed sheet of material. The roll 20 has wires 21 secured thereto similar to the wires 13. In this instance, however, the wires 21 may extend axially of the roll 20 inasmuch as the sheet material processed between the rolls 20 and 21 will still have sufficient strength for processing and handling even though spaced score lines or zones are provided in sheets of material processed between the rolls.

While several complete embodiments of the invention have been disclosed herein, it will be appreciated that modification of these particular embodiments of the invention may be resorted to without departing from the scope of the invention as defined in the appended claims.

What is claimed is:

1. A flexible laminate for use as a label, decal or the like, comprising

a face sheet,

a layer of pressure sensitive adhesive secured to the back surface of said face sheet, and

a fiber paper backing layer removably secured to said adhesive layer and having a reduced thickness potential tear line formed in such material, the fibers of the paper backing layer being appreciably compacted at the potential tear line, the paper having a release coating on its inner surface which engages the adhesive layer.

2. A laminate as in claim 1 where said backing sheet is weakened at said tear line.

3. A laminate as in claim 1 where the paper backing layer is less than one-half of its uncompacted thickness at said potential tear line.

4. A laminate as in claim 3 where the compaction of said paper layer is from its outer surface to provide a recess at said potential tear line on the outer surface of said paper layer.

* * * * *

MORGAN REISSUE APPLICATION

(Filed September 19, 1977)

REISSUE

5

9-[illegible]-77

834136	Patent Date		REISSUE PATENT NUMBER		
834,136	09/19/77	428	40	164	Van Balen

APPLICANT'S: DURTON D. MORGAN, HUDSON, OHIO

TITLE OF INVENTION: SCORED ADHESIVE LAMINATE

ADDRESS FOR CORRESPONDENCE TO: [illegible] & OLDHAM CO.
627 FIRST NATL. TOWER
AKRON, OHIO 44308

ATTORNEY(S): JOHN L. OLDHAM, ET. AL.

ASSOCIATE ATTORNEY: NONE

SER. NO.	STATE OR COUNTRY	SHEETS DRAWING	TOTAL CLAIMS	INDEP. CLAIMS	FILING FEE RECEIVED	ATTORNEY'S DOCKET NO.	CLAIMS ALLOWED	CLASS	SUBCLASS
[illegible]	OH	1	[illegible]	[illegible]	[illegible]	[illegible]			

CONTINUING DATA: THIS APPLICATION IS A REISSUE OF PAT. NO. 3,900,651 A DIV OF S. 667,435, 12/11/67 PATENT 3,537,337.

FOREIGN APPLICATIONS: NONE

PATENT CONTRACTS SPECIFIED IN 35 USC 119 YES ☐ NO ☐

ASSIGNEE: MORGAN ADHESIVES COMPANY, STOW, OHIO, A CORP. OF OHIO

U.S. DEPT. OF COMMERCE - PATENT AND TRADEMARK OFFICE

PARTS OF APPLICATION FILED SEPARATELY

PREPARED FOR ISSUE

(Assistant Examiner) (Docket Clerk)

EXAMINED AND PASSED FOR ISSUE

(Primary Examiner) (Group)

Estimate of printed pages: Drawing [illegible] Sheet (s) [illegible] Issue fee due (___)

Number of allowance and issue fee due (___)

Date mailed

[THIS SPACE RESERVED FOR RETENTION LABEL]

[THIS SPACE RESERVED]

834136

CONTENTS

1. Application _____ papers.
2. Title Report Sept 28 1977
3. Req for Lic Sept 15, 1977
4. Rely Granted Sept 22, 1977
5. _____
6. _____
7. _____
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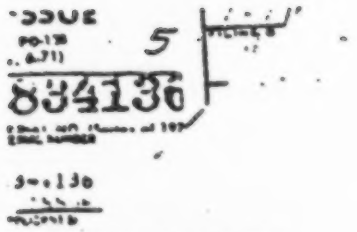


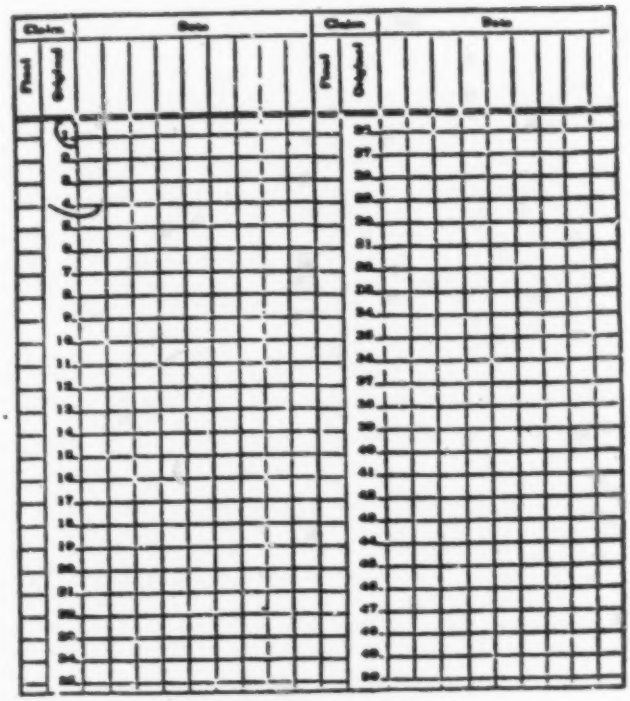
SEARCHED

Class	Sub	Date	Ex'r

INTERFERENCE SEARCHED

Class	Sub	Date	Ex'r

INDEX OF CLAIMS



SYMBOLS

STATUS

F_____ Rejected

=_____ Allowed

– (Through numeral)__ Canceled

C_____ Restriction requirement

N_____ Nonelected invention or species

I_____ Interference

A_____ Appeal

O_____ Objected

FORM PTO-875
(REV. 12-74)
(FORMERLY PTO-431)

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

PATENT APPLICATION FEE DETERMINATION RECORD

SERIAL NUMBER	FILING DATE
834,136	9-19-77
APPLICANT (First Named Only)	
Morgan	

CLAIMS AS FILED - PART I

(1) FOR	(2) NUMBER FILED	(3) NUMBER EXTRA	(4) RATE	(5) BASIC FEE $65.00
TOTAL CLAIMS	-10=	0 *	x $2.00	
INDEPENDENT CLAIMS	- 1=	0 *	x $10.00	
			TOTAL FILING FEE →	65

CLAIMS AS AMENDED - PART II

	(1)	(2) CLAIMS REMAINING AFTER AMENDMENT	(3)	(4) HIGHEST NO PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEE
AMENDMENT	TOTAL	*	MINUS	**	=	x $2	=
	INDEP.	*	MINUS		=	x $10	=
				TOTAL ADDITIONAL FEE FOR THIS AMENDMENT →			
AMENDMENT	TOTAL	*	MINUS	**	=	x $2	=
	INDEP.	*	MINUS		=	x $10	=
				TOTAL ADDITIONAL FEE FOR THIS AMENDMENT →			
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	INDEP.	*	MINUS		=	x $10	=
				TOTAL ADDITIONAL FEE FOR THIS AMENDMENT →			
AMENDMENT	TOTAL	*	MINUS	**	=	x $2	=
	INDEP	*	MINUS		=	x $10	=
				TOTAL ADDITIONAL FEE FOR THIS AMENDMENT →			

* If the entry in Column 2 is less than the entry in Column 4, write "0" in Column 5.

** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 10, write "10" in this space.

The "Highest Number Previously Paid For" ("Total" or "Indep.") is the highest number found in the appropriate box in Column 2.

834136

SCORED ADHESIVE LAMINATE

ABSTRACT OF THE DISCLOSURE

Apparatus for scoring paper and other sheet materials which thereafter are formed into a laminate with an adhesive sheet. The scoring is not continuous but facilitates tearing the sheet at a later time to facilitate use of the laminate as a label or similar product.

09/27/77 034136 3 111 AS.00CK

SCORED ADHESIVE LAMINATE

This is a division of my prior Application Serial No. 689,435 filed December 11, 1967, now U.S. Patent No. 3,570,337.

Reference is made to my own prior U.S. Patent No. 3,035,957, which discloses one type of an adhesive product with special embrittled tear zones provided therein.

This invention further relates to adhesive products such as labels, stickers, tapes and similar articles wherein the article comprises, normally, a surface sheet, a layer of adhesive secured to the back face of such surface sheet, and a removable paper backing sheet secured to the adhesive layer for ultimate removal when the label, sticker or the like is to be affixed to an article for end use purposes. It is difficult to strip labels, stickers and the like of their backing sheets to prepare them for use because no available edge of the backing sheet usually is exposed to facilitate grasping the backing sheet for its removal. U.S. Patent No. 2,364,607 is on one adhesive tape or label of this same general type as made heretofore, but which label or laminate provided does not in many instances accept printing uniformly.

The general object of the present invention is to provide a novel and improved laminate including a surface sheet, an adhesive layer, and a scored paper backing sheet which can readily be removed.

Another object of the invention is to form scored sheets of material, such as paper backing sheets, that are used in forming adhesive laminates or the like and wherein the backing sheet of the laminate must be removed before use of the product.

The foregoing and other objects and advantages of the invention will be made apparent as the specification proceeds.

Reference now is made to the accompanying drawings in which:

Fig. 1 is a perspective view of apparatus which is diagrammatically shown and used in forming a laminate of the invention;

Fig. 2 is an enlarged elevation of one of the rolls of Fig. 1;

Fig. 3 is a fragmentary enlarged section taken on line 3-3 of Fig. 2;

Fig. 4 is a fragmentary enlarged vertical section taken on line 4-4 of Fig. 3;

Fig. 5 is a fragmentary enlarged vertical section taken on line 5-5 of Fig. 3;

Fig. 6 is a fragmentary enlarged section of an adhesive laminate made using a sheet processed by the apparatus of Fig. 1;

Fig. 7 shows the step of splitting the adhesive laminate of Fig. 6 along a weakened area provided in the backing sheet of the laminate; and

Fig. 8 is an elevation of a modified roll of the apparatus.

When referring to corresponding members shown in the drawings and referred to in the specification, corresponding numerals are used to facilitate comparison therebetween.

Attention now is directed to the details of the structure shown in the drawings, and a pair of rolls 10 and 11, which normally are cylindrical and are made from metal, are shown

in operative association to form a roll bight therebetween. Normally, at least one of the rolls is driven whereby pressure engagement is provided at the roll bight for a sheet or strip of material 12 which will be drawn through the roll bight. Normally in the process of use of the apparatus of the invention, the sheet or strip 12 would be formed from a fibrous material, such as paper, of the type that conventionally is used for forming backing sheets in adhesive laminates. Adhesive laminates using the sheets 12 may be used for making stickers, labels or other articles therefrom. Normally the sheets 12 are quite thin such as in the range of from about 0.001 inch to about 0.005 inches in thickness.

It is an important feature of the present invention that the roll 11 has one or more metal wires 13 secured to the surface thereof. These wires 13 preferably would be made from spring steel and, for example, would have a diameter of approximately 0.010 inch but the wire thickness can be varied dependent upon the thickness of the sheets 12 being processed and the desired amount of scoring to be provided thereon. The wire or wires 13 can be secured to the periphery of the roll 11 in any desired manner, as by spot welding or otherwise securing at least the ends of the wire 13 to the metal roll 11. However, if desired, the wire 11 could be affixed to the roll by a suitable adhesive, such as a conventional epoxy type of an adhesive which will set up at room temperature or at slightly elevated temperatures and give a good bond of the wire 13 to the roll. The wires are helically positioned on the roll 11.

It is another portion of the present invention that parts of the wires 13, at longitudinally spaced sections of th

wire would have complementary shaped recesses 14 formed in the surface of the roll 11 for receiving a length of the wire 13 when the rolls 10 and 11 operatively engage whereby the wire 13 will not form a continuous scored or weakened area, zone or line in the sheet 12 being processed. Intermittent lengths of the sheet 12 would not be effected at all because the wire 13 would have sufficient resilience or stretch, and would have no backing provided therefor at the longitudinally spaced portions of the wires lying over the recesses 14 so that portions of the wire will just be pushed into the recesses 14 when the rolls engage. This particular construction of the wires and rolls leaves sufficient strength in the sheet 12 whereby it can be readily further processed without any danger of splitting or tearing while being processed or prepared for use. At the same time, the recesses 14 would only be provided at, for example, intervals of 1 or 2 inches along the periphery of the roll 11, and such recesses 14 necessarily could be quite short, such as approximately 1/4 to 1/2 inch or so.

By passing the sheet 12 through the roll bight, the fibrous material forming the sheet 12 will be crushed or weakened by a compaction of the fibers in the sheet in lineal zones or lines 18 of the sheet where the wire 13 contacts it and where the wire is backed up by the surface of the roll 11.

Fig. 3 shows how a plurality of the small recesses 14 could be formed in the periphery of the roll for receiving longitudinally spaced portions of the wire 13 therein when the roll 11 is operative. Fig. 5 in turn indicates how this wire can be received in the recess for passing portions of the sheet 12 through the roll bight without any scoring action on spaced areas of the sheet 12.

After the sheet 12 has been processed by being fed through the roll bight between the rolls 10 and 11, then it can be thereafter treated in any conventional manner. Thus, for example, a layer of a release material of a conventional nature, such as a silicon base composition, can be applied to one surface of the sheet 12 and thereafter a laminate 15 can be made in a conventional manner and which laminate could, for example, include a surface layer 16, a layer of a conventional adhesive composition 17 attached to the layer 16, and then the release coated surface of the sheet 12 would be releasably affixed to the opposite face of the adhesive layer 17. Any desired pressure sensitive or other adhesives can be used in forming the laminate 15 and such adhesives may, for example, be of the composition described on Page 586 of "Handbook of Adhesives" by Skeist.

After the laminate 15 has been fully prepared for use as by printing any desired data thereon after the laminate is made, or before the components thereof are assembled, as desired, then the laminate 15 can be cut to a desired shape, or otherwise be prepared for use. When the laminate is to be used, it is a relatively simple matter to fold or bend the laminate 15 in a direction as shown in Fig. 7 so as to tension the weakened zone or line 18 provided on the sheet 12 whereby such backing paper will split or tear along this line 18, the sheet 12 is removed, and the adhesive layer 17 can be exposed for securing the end product to a carrier surface for use. Thus, it is believed that the objects of the invention have been achieved and that a new and improved apparatus has been provided for scoring or weakening ultimate

tear lines or zones in sheet material, such as paper and the like, and a new laminate is provided.

In some instances, it may be desirable to use a roll such as a roll 20 shown in Fig. 8 rather than the roll 11 in combination with the roll 10 for forming weakened zones, areas or lines in a processed sheet of material. The roll 20 has wires 21 secured thereto similar to the wires 13. In this instance, however, the wires 21 may extend axially of the roll 20 inasmuch as the sheet material processed between the rolls 20 and 21 will still have sufficient strength for processing and handling even though spaced score lines or zones are provided in sheets of material processed between the rolls.

While several complete embodiments of the invention have been disclosed herein, it will be appreciated that modification of these particular embodiments of the invention may be resorted to without departing from the scope of the invention as defined in the appended claims.

What is claimed is:

1. A flexible laminate for use as a label, decal or the like, comprising

a face sheet,

a layer of pressure sensitive adhesive secured to the back surface of said face sheet, and

a fiber paper backing layer removably secured to said adhesive layer and having a reduced thickness potential tear line formed in such material, the fibers of the paper backing layer being appreciably compacted at the potential tear line, the paper having a release coating on its inner surface which engages the adhesive layer.

2. A laminate as in Claim 1 where said backing sheet is weakened at said tear line.

3. A laminate as in Claim 1 where the paper backing layer is less than one-half of its uncompacted thickness at said potential tear line.

4. A laminate as in Claim 3 where the compaction of said paper layer is from its outer surface to provide a recess at said potential tear line on the outer surface of said paper layer.

DECLARATION, POWER OF ATTORNEY & PETITION

DECLARATION

Burton D. Morgan, the above-named petitioner, declares that he is a citizen of the United States of America, and a resident of Hudson in the State of Ohio; that he verily believes himself to be the original, first, and sole inventor of the invention described and claimed in Letters Patent No. 3,900,645 and in the foregoing specification and for which improvement he solicits a patent; that he does not know and does not believe that said improvement was ever known or used in the United States before his invention thereof, that he acknowledges a duty to disclose information of which he is aware which is material to the examination of the foregoing reissue application; and that he is aware of prior art which may be relevant to the patentability of his invention and which may not have been previously considered by the Patent Office, which might cause the Examiner to deem the original patent wholly or partially inoperative or invalid, to wit: U.S. Patent #3,230,649 to Korn, U.S. Patent #2,319,272 to Starr, U.S. Patent #2,434,545 to Brady, and U.S. Patent #2,681,732 to Brady; and that he requests that if the Examiner so deems, the applicant be permitted to amend the patent and be granted a reissue patent.

The undersigned petitioner declares further that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Inventor 's Full Name is Burton D. Morgan.

Burton D. Morgan

Date: 3 12 1977

Post office address 302 Aurora Street, Hudson, Ohio 44236

POWER OF ATTORNEY

Morgan Adhesives Company, 4560 Darrow Road, Stow, Ohio 44224, incorporated under the laws of the State of Ohio, the sole owner by assignment of United States Letters Patent No. 3,900,645, for "SCORED ADHESIVE LAMINATE", hereby appoints the firm of Oldham and Oldham Co., L.P.A., 627 First National Tower, Akron, Ohio 44308, telephone 216-762-6416, comprised of Vern L. Oldham, Registration No. 14,363; Edwin W. Oldham, Registration No. 22,003; Daniel J. Hudak, Registration No. 25,879; and Ray L. Weber, Registration No. 26,519, its attorneys, with full power of substitution and revocation, to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith.

MORGAN ADHESIVES COMPANY

By: Blake H. Hooper
Blake H. Hooper, President
Chief Executive Officer

ATTEST:

By: F. Ward Ponser
F. Ward Ponser, Vice President & Treasurer

PETITION FOR REISSUE APPLICATION

Your petitioner, Burton D. Morgan, a citizen of the United States of America and a resident of Village of Hudson, State of Ohio, whose post office address is 302 Aurora Street, Hudson, Ohio 44236, prays that he may be allowed to surrender the Letters Patent for an improvement in SCORED ADHESIVE LAMINATE, No. 3,900,645, granted to him on August 19, 1975, whereof Morgan Adhesives Company, a corporation incorporated under the laws of the State of Ohio, on whose behalf and with whose assent this application is made, is now sole owner, by assignment, and that the Letters Patent may be reissued to the said Morgan Adhesives Company, for the same invention upon the following specification, With this Petition is filed an order for a title report, as required in such cases.

Burton D. Morgan

ASSENT OF ASSIGNEE TO REISSUE

The undersigned, assignee of the entire interest in the above-mentioned Letters Patent, hereby assents to the accompanying application.

MORGAN ADHESIVES COMPANY

By: _____
Blake H. Hooper, President

ATTEST:

_____
F. Ward Ponser, Vice President, Treasurer

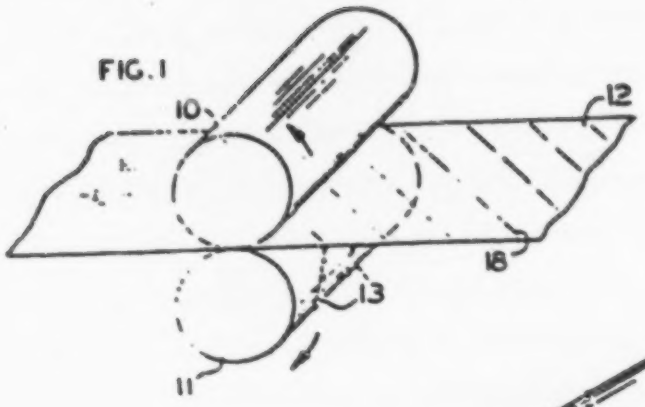


FIG. 1

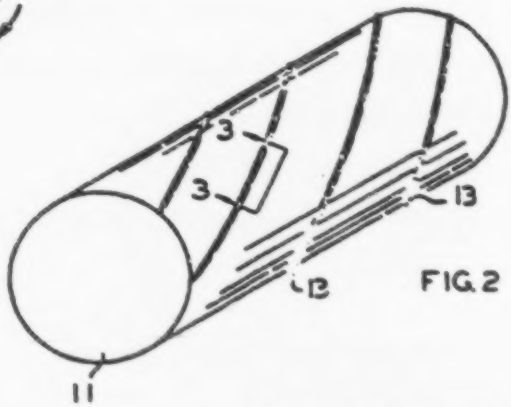
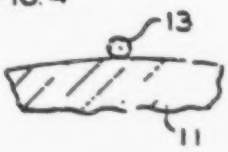


FIG. 2



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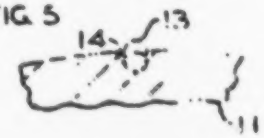


FIG. 5

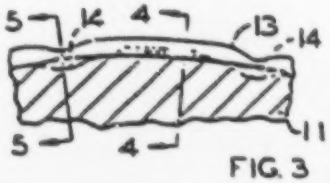


FIG. 3

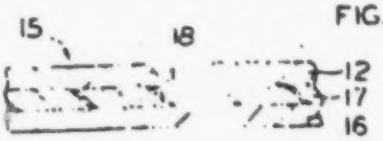


FIG. 6

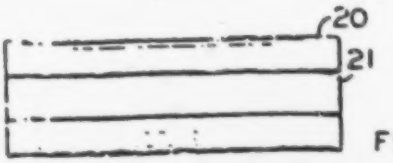


FIG. 8

FIG. 7

INVENTOR.
BURTON D. MORGAN

ATTORNEYS

U. S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

TITLE REPORT

PAPER NO. 2

A. APPLICATION FILE DATA

(1.) SERIAL NO.

(2.) FILED

(3.) INVENTOR(S) - FULL NAME(S)

Burton D. Morgan.

(4.) DIVISION OF

(5.) CONTINUATION OF

(6.) REISSUE OF

(7.) SUBSTITUTE OF

B. ASSIGNMENT RECORD DATA

The assignment records reveal that the Title appears to be vested in:

(1.) ☐ INVENTOR(S)

(2.) ☐ AS ENDORSED

(3.) ☐ AS THE RECORD NOW STANDS, THE PATENT, WHEN GRANTED, WILL ISSUE IN THE NAME OF THE INVENTOR(S).

(4.) ☒ ~~OTHER~~

Morgan Lubricator Company
Lima, Ohio
Assignee of Ohio

EXAMINED TO AND INCLUDING 2-16-77

THIS CERTIFICATE DATED 2-28-77

HEAD OF ASSIGNMENT DIVISION Rec'd-2-28-77
S.M. HAYDEN (Rec'd 26 Pages 453. (N.J.A.

834136

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Burton D. Morgan Examiner:

Serial No.: Group Art Unit:

Filed:

For: "SCORED ADHESIVE LAMINATE" (New, reissue application)

Commissioner of Patents & Trademarks
Washington, D.C. 20231

CERTIFICATE OF MAILING

Sir:

This is to certify that the foregoing NEW, REISSUE PATENT APPLICATION was mailed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231, with sufficient first-class U.S. postage prepaid no special handling charges, this 16th day of September, 1977, at approximately 4:00 PM, thereby ensuring that such document(s) will be in the hands of the U.S. Postal Service by the close of business this day. Thus, response has been made to the outstanding Patent Office action prior to expiration of the statutory period for the same ending NONE.

Respectfully submitted,

OLDHAM & OLDHAM CO. L.P.A.

By: Roy L. Walker

627 First National Tower, Akron, Ohio 44308

1-77-1-DIV-1

03413C

Commissioner of Patents & Trademarks
Washington, DC 20231

APPLICATION TRANSMITTAL LETTER

Sir:

Enclosed please find for filing a reissue patent appliration, based on U.S. Letters Patent No. 3,900,645, issued August 19, 1975, for "SCORED ADHESIVE LAMINATE," as follows:

INVENTOR: Burton D. Morgan

FOR: "SCORED ADHESIVE LAMINATE"

ENCLOSURES: Reissue application, comprised of seven pages specification, one page claims; original U.S. Letters Patent document; Declaration; Power of Attorney; Petition; informal drawing (copy of original drawing attached to bristol board); filing fee (by check).

The Commissioner is hereby requested to transfer the original drawings from the prosecution file to the reissue application file, and to prepare and furnish to the reissue application file a title report respecting U.S. Letters Patent No. 3,900,645.

The filing fee for the herein application is calculated to be $65.00 (4 claims total, 1 independent claim, no extra claims), and our check in this amount is enclosed.

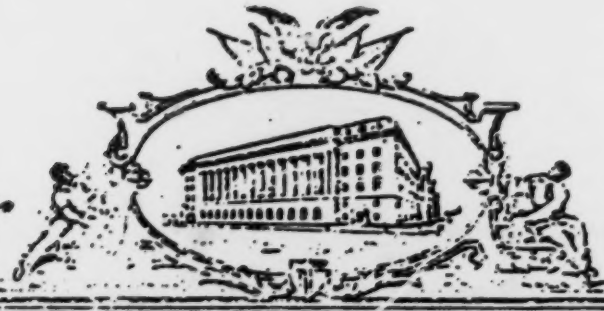
The Commissioner is authorized to charge any additional fees or credit any overpayments incident to the filing of this application to our Deposit Account No. 15-0450. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OLDHAM & OLDHAM CO. L.P.A.

By: Ray L. Weber

RLW/mr
Enclosures
627 First National Tower
Akron, Ohio 44308
Telephone: 216-762-6416
Docket No. J-2750-1-DIV-Re.



C21

3900645

UNITED STATES PATENT OFFICE

TO ALL TO WHOM THESE PRESENTS SHALL COME:

Whereas, THERE HAS BEEN PRESENTED TO THE

Commissioner of Patents and Trademarks

A PETITION PRAYING FOR THE GRANT OF LETTERS PATENT FOR AN ALLEGED NEW AND USEFUL INVENTION THE TITLE AND DESCRIPTION OF WHICH ARE CONTAINED IN THE SPECIFICATIONS OF WHICH A COPY IS HEREUNTO ANNEXED AND MADE A PART HEREOF, AND THE VARIOUS REQUIREMENTS OF LAW IN SUCH CASES MADE AND PROVIDED HAVE BEEN COMPLIED WITH, AND THE TITLE THERETO IS, FROM THE RECORDS OF THE PATENT AND TRADEMARK OFFICE IN THE CLAIMANT(S) INDICATED IN THE SAID COPY, AND WHEREAS, UPON DUE EXAMINATION MADE, THE SAID CLAIMANT(S) IS (ARE) ADJUDGED TO BE ENTITLED TO A PATENT UNDER THE LAW.

NOW, THEREFORE, THESE Letters Patent ARE TO GRANT UNTO THE SAID CLAIMANT(S) AND THE SUCCESSORS, HEIRS OR ASSIGNS OF THE SAID CLAIMANT(S) FOR THE TERM OF SEVENTEEN YEARS FROM THE DATE OF THIS GRANT, SUBJECT TO THE PAYMENT OF ISSUE FEES AS PROVIDED BY LAW, THE RIGHT TO EXCLUDE OTHERS FROM MAKING, USING OR SELLING THE SAID INVENTION THROUGHOUT THE UNITED STATES.

In testimony whereof *I have hereunto set my hand and caused the seal of the* Patent and Trademark Office *to be affixed at the City of Washington this* nineteenth *day of* August, *in the year of our Lord one thousand nine hundred and* seventy-five, *and of the Independence of the United States of America the two hundredth*

Acting Director

Commissioner of Patents and Trademarks

PATENT EXAMINER'S REJECTION OF REISSUE

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office
ADDRESS: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

OCT 11 1978

[W. J. Van Balen Art Unit 164
834,136 09/19/77
Burton D. Morgan]

OCT 16 1978

Oldham & Oldham Co.
627 First NATL. Tower
Akron, Ohio 44308

☒ This application has been examined.
☐ Responsive to communication filed on _____.
☐ This action is made final.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE 3 months
90 DAYS FROM THE DATE OF THIS LETTER.
FAILURE TO RESPOND WITHIN THE PERIOD FOR RESPONSE WILL CAUSE THE APPLICATION TO BE ABANDONED

PART I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited, Form PTO-892.
2. ☐
3. ☐ Notice of Informal Patent Application, Form PTO-152
4. ☐

PART II SUMMARY OF ACTION

1. ☒ Claims 1-4 are pending in the application.
   Of the above claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-4 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ The proposed drawings filed on _____ are accepted.
8. ☐ The drawings, corrected in response to the letter of _____ have been ☐ approved. ☐ disapproved.
9. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119.
   ☐ Receipt is acknowledged of certified copies of priority documents which have been filed in parent application, serial no. _____, filed on _____.
   ☐ Receipt is acknowledged of certified copies of priority documents which have been received.
10. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.
11. ☐ Other

Form PTO-326 (rev. 11/77)

Serial No. 834,136
Art Unit 164

[2] Objection is made to the specification since there does not appear to be antecedent basis therein for the limitation in claim 3.

(1). Claims 1-4 are rejected under 35 USC 112, first paragraph for lack of an enabling disclosure. Apparatus for scoring the paper sheet is described in the specification as a roll 11 having one or more metal wires 13 secured to the surface thereof. Wires 13 are disclosed to be made from spring steel and are stated to have a diameter of approximately o.010 inch (i.e. edge radius of 0.005 inch). It is noted that the wire thickness can be varied depending upon the thickness of the sheets 12 being processed and the desired amount of scoring to be provided thereon; see specification page 3, lines 15-19. The score lines 18 imparted to paper sheet 12 (Figure 6) are the result of the wires 13 contacting sheet 12 through a crushing or weakening by compaction of the fibers in the sheet. It appears to be well known however, that steel wire having an edge radius of 0.005 inch (diameter of 0.01 inch) is sufficiently sharp to provide a knife edge for cutting the paper as opposed to compacting the sheet. For example, Bulletin 4010 of the Cameron Machine Company discloses that score cut knives are well known for slitting papers, laminates and the like. In the Cameron Bulletin, three knife edges are disclosed. These edges are indentified as edges "A", "B", and "C" with edge "B" having a radius of .006 to .008 inch. The "B" edge is thus slightly larger than the "A" edge which has a radius of .002 to .004 inch. The wire radius of the Morgan application (.005 inch) thus falls between the Cameron "A" edge and "B" edge and appears to be incapable of compacting or crushing paper.

[3] Rather the wire edge radius disclosed by Morgan seems to be a knife edge which will cut paper.

The term "score cut" as used in the Cameron Bulletin 4010 is well known in the industry. As pointed out in *Paper, Film and Foil Converter,* score cutting is an operation in which a score cut slitter is pressed against a hardened steel backup roll and the web of material passed between the wheel and the roll. As noted in the article, score cutting produces "a severing of the fibers by wheel pressure". (Page 24, column 2). As further noted in the article, the included angle of the score slitter may vary from 30 to 60 degrees and the radius of the wheel edge may vary from .002 inch to 0.12 inch depending upon the type of the material being slit. (Page 24, column 3). The edge radii as disclosed in the article are thus identical to the radii disclosed in the Cameron bulletin 4010. Since the apparatus disclosed herein appears to be a score cutting apparatus for slitting or cutting paper, there is no disclosure of how the wire wound roll apparatus acts to compact or crush rather than cut the paper. Thus, there appears to be no enabling disclosure which would permit one skilled in the art to practice the invention since the apparatus of the application seems to be a score cutting apparatus for cutting paper that doesn't differ in any material respect from Figure 1, *Paper, Film and Foil converter* article (page 24). The disclosure [4] is therefore totally deficient as to apparatus or means for achieving a crushed or compacted backing paper.

(2). Claims 1-4 are further rejected under 35 USC 112, first and second paragraphs. There is no antecedent basis for "the outer surface" in claim 4. The outer surface has not been defined with respect to an inner surface. Moreover, the only surface of a fiber paper backing layer having a reduced thickness potential tear line formed

in such material, the fibers of the paper backing layer being appreciably compacted at the potential tear line, is that surface of the paper opposite the surface removably secured to an adhesive layer exemplified by Figures 6 and 7 in the drawing.

(3). Claims 1-4 are rejected under 35 USC 102(b) as clearly anticipated by Karn such as column 1, lines 8-12; column 2, lines 23-32; column 3, lines 51-64 and 70-73, and Figure 5. The "crush-cutting" technique of Karn (column 3, line 59) is presumed to yield appreciable compacting at the potential tear line. The "thin membranes" (column 3, line 59 and Figue 5) indicate that the paper backing layer is less than one-half of its uncompacted thickness at the potential tear line.

(4). Claims 1-4 are rejected under 35 USC 103 as obvious over Karn in view of Brady (732) or Brady, Jr. et al (545). This rejection assumes that the "potential tear line", score or indentation can be on that surface of the paper in contact with an adhesive. Each of Brady (732) such as Figure 3 and Brady (545) such as Figures 2 and 3 disclose a similar laminate having the tear line on the [5] adhesive side of the paper. For the tear line of Karn to be on the adhesive side of the paper would be obvious in view of Brady (732) or Brady (545).

(5). Claims 1-4 are rejected under 35 U.S.C. 103 as obvious over Karn in view of Cameron Machine Co. Bulletin 4010 and Paper, Film and Foil Converter Publication. This rejection assumes that there is some structural distinction in the configuration of the tear line of Karn. However, it would be obvious to employ the apparatus of the Bulletin 4010 and the Converter Publication which show rounded means conventionally used for scoring the paper of Karn.

(6). The Examiner has considered whether the disclosure is limited solely to forming interrupted score lines. Beginning at line 25 on page 2 through line 27 on page 3 and lines 3-12 on page 6 in the specification, there appears to be an enabling disclosure with reference to continuous score lines. The completeness of the disclosure in this respect is reinforced by the express teaching on page 3, lines 28 et seq. that in "another portion of the present invention that parts of wires 13, at longitudinally spaced sections of the wire would have complementary shaped recesses 14 formed in the surface of the roll 11 for receiving a length of wire 13 when the rolls 10 and 11 operatively engage whereby the wire 13 will not form a continuous scored or weakened area, zone or line in the sheet 12 being processed."

[6] The patent to Starr is not considered pertinent enough to use in a rejection because there is no disclosure therein of a paper backing nor a corresponding structure whereby the "fibers of the paper backing layer being appreciably compacted at the potential tear line" as claimed, notwithstanding the teaching in the patent of suitable lines of special weakness as by reducing the cross sectional area (column 3, lines 40-42) such as by suitably scoring, scorching, abrading or corroding (column 1, lines 19-22).

The prior art cited but not applied against the claims have been given careful consideration but is not seen to be as pertinent as the art that has been applied against the instant claims.

WJVanBalen:bh
(703) 557-1897
09/19/78

WILLIAM J. VAN BALEN
Examiner
Group Art Unit 164

TO SEPARATE, HOLD TOP AND BOTTOM EDGES APART AND DISCARD CARBON

FORM PTO-892 (Rev. 7-76) U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

NOTICE OF REFERENCES CITED

APPLICATION NO.	GROUP ART UNIT	ATTACHMENT
84,134		

APPLICANT(S)

U.S. PATENT DOCUMENTS

*		DOCUMENT NO.	DATE	NAME	CLASS	SUBCLASS
✓	A	2,319,272	5/1943	[illegible]	[illegible]	[illegible]
✓	B	4,134,545	1/1979	[illegible]	[illegible]	[illegible]
✓	C	2,636,247	4/1953	[illegible]	[illegible]	[illegible]
✓	D	2,681,729	6/1954	[illegible]	[illegible]	[illegible]
✓	E	2,800,144	7/1957	[illegible]	[illegible]	[illegible]
✓	F	2,956,703	10/1960	[illegible]	[illegible]	[illegible]
✓	G	3,006,011	10/1961	[illegible]	[illegible]	[illegible]
✓	H	3,028,870	4/1962	[illegible]	[illegible]	[illegible]
✓	I	3,031,259	4/1962	[illegible]	[illegible]	[illegible]
✓	J	3,035,577	5/1962	[illegible]	[illegible]	[illegible]
✓	K	3,043,309	7/1962	[illegible]	[illegible]	[illegible]

FOREIGN PATENT DOCUMENTS

*		DOCUMENT NO.	DATE	COUNTRY	NAME	CLASS	SUB CLASS
	L						
	M						
	N						
	O						
	P						
	Q						

OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, Etc.)

✓	R	Bulletin 4010, Cameron Machine Co. [illegible] (no date)
✓	S	"Cage Type [illegible]" (1 page of 29-2)
	T	
	U	

EXAMINER: WILLIAM I. VAN BALEN

DATE

GROUP ART UNIT 104

A copy of this reference is not being furnished with the office action.
(See Manual of Patent Examining Procedure, section 707.05 (a).)

PATENT EXAMINER'S REJECTION OF AMENDED REISSUE APPLICATION

(Filed March 2, 1979)

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
834,136	09/19/77	SURTON D. MORGAN	

ODLHAM & OLDHAM CO.
627 FIRST NATL. TOWER
AKRON, OHIO 44308

EXAMINER	
VAN BALEN	
ART UNIT	PAPER NUMBER
164	24

DATE MAILED: 2 MAR 1979

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined. ☒ Responsive to communication filed on Jan. 16, 1979 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 months, ____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of Reference Cited, Form PTO-892.
2. ☐ Notice of Informal Patent Drawing, PTO-948.
3. ☐ Notice of Informal Patent Application, Form PTO-152.
4. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 1-4 are pending in the application.
   Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-4 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ The formal drawings filed on _____ are acceptable.
8. ☐ The drawing correction request filed on _____ has been ☐ approved. ☐ disapproved.
9. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has
   ☐ been received. ☐ not been received. ☐ been filed in parent application, serial no. _____;
   filed on _____.
10. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
11. ☐ Other

PTOL-326 (rev. 10-78)

EXAMINER'S [redacted] ACTION

Art Unit 164
Serial No. 834,136

[2] 1. Objection is made to the entire amendatory matter inserted on Page 5, line 25 after the period for containing new matter and as being inaccurate and misdescriptive. 37 C.F.R. 175(d)(1) in part reads "the terms and phrases used in the claims must find clear support or antecedent basis in the description" (specification). The language acceptable to the Examiner is found in claim 3 beginning with "the" to the end of said claim. In the present amendment the plural form for "lines" and "are" are inaccurate and misdescriptive for Fig. 6. The expression "sheet 12 proper" is speculative as to what constitutes a "proper" sheet. Cancellation of the new matter is required.

2. Claims 1-4 are rejected under 35 USC 132 as being based on new matter or under 35 USC 112 first and second paragraphs for the reasons set out immediately above.

3. Applicant's arguments and affidavit together with exhibits filed January 10, 1978 have been given careful consideration, however, they are not deemed to be persuasive of any error for the position taken by the Examiner. The affidavit is insufficient for being highly opinionated and speculative at best. Further, the exhibits and affidavit point out the fact that, as a whole, undue experimentation was required such as constructing a wire wound roll, numerical thickness of paper (thickness not in exhibits), determination of properly applied pressure, determination of roll bight, concentricity of rolls, varying thickness of paper related to required pressure, load applied between rolls, design of rotary knife blade having a rounded edge, and edge radius of the blade.

[3] Applicant's affidavit together with exhibits is further not persuasive since it fails to present a side-by-side comparison with the Karn reference.

4. Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph for the reasons set out in paragraph (1) of the previous Action mailed October 11, 1978. Hereafter referred to as "the previous Office Action".

5. Claims 1-3 are rejected under 35 USC 112, first and second paragraphs. The only disclosed surface of a fiber paper backing layer being appreciably compacted at the potential tear line, is that surface of the paper opposite the surface removably secured to an adhesive layer exemplified by Figures 6 and 7 in the drawing.

6. Claims 1-4 are rejected under 35 USC 102 (b) as clearly anticipated by Karn for the reasons set out in paragraph (3) of the previous Office Action.

7. Claims 1-3 are rejected under 35 USC 103 as obvious over Karn in view of Brady (732) or Brady, Jr. et al (545) for the reasons set out in paragraph (4) of the previous Office action.

8. Claims 1-4 are rejected under 35 U.S.C. 103 as obvious over Karn in view of Cameron Machine Co. Bulletin 4010 and Paper, Film and Foil Converter Publication for the reasons set out in paragraph (5) of the previous Office action.

This rejection is made FINAL.

WVANBALEN/dev
703/557/1952
February 28, 1979

/s/ W. J. Van Balen
Examiner
Group Art Unit 164

PATENT OFFICE EXAMINER'S REJECTION OF MORGAN'S SUPPLEMENTAL RESPONSE

(Filed July 9, 1979)

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
834,136	09/19/77	BURTON D. MORGAN	NONE

EXAMINER
J. Van Balen

PAPER NUMBER
32

DATE MAILED
JUL 13 1979

OLDHAM & OLDHAM CO.
627 First Natl. Tower
Akron, Ohio 44308

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined. ☒ Responsive to communication filed on May 9, 1979 and June 4, 1979. ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), ____ days from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:
1. ☐ Notice of References Cited, PTO-892
2. ☐ Notice of Informal Patent Drawing, PTO-948
3. ☐ Notice of Informal Patent Application, Form PTO-152
4. ☐

Part II SUMMARY OF ACTION
1. ☒ Claims 1-4 are pending in the application.
   Of the above, claims ____ are withdrawn from consideration.
2. ☐ Claims ____ are allowed.
3. ☐ Claims ____ are rejected.
4. ☒ Claims 1-4 are subject to restriction or election requirement.
5. ☐ Claims ____ are objected to.
6. ☐ Claims ____ are subject to restriction or election requirement.
7. ☐ The proposed drawing(s) filed on ____ are acceptable.
8. ☐ The drawing correction request filed on ____ has been: ☐ approved ☐ disapproved.
9. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has
   ☐ been received ☐ been received in application serial no. ____ filed on ____
   ☐ been filed in parent application serial no. ____ filed on ____
10. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.
11. ☐ Other.

PTOL-326 (rev. 10-78)

[2] The finality of the previous Office action mailed March 2, 1979 is withdrawn in order to amplify the Examiner's position and clarify the issues as per Applicant's request of May 9, 1979. A new statutory period of three months is set to commence with the mailing of this letter.

Applicant's arguments filed May 9, 1979 (paper No. 29) and June 4, 1979 (paper No. 31) have been given careful consideration; however, it is noted that no reply has been made to paragraphs *one* and *two* as set out in the final rejection dated March 2, 1979.

The Examiner's discussion below is keyed to the numbered paragraphs in the response filed June 4, 1979.

(Paragraph 1) Exhibits F1 and F2 correspond to Exhibits E1 and E2 filed March 17, 1978 (paper No. 9). No wire radius is given. Claims 1-4 are still rejected for lack of enabling disclosure as in the first Office action and as maintained in the previous final rejection. Instant Exhibit G refers to the type of paper used, i.e. "release paper" whereas Exhibit K2 refers to "stock paper". It is not known just what significance the respective papers have.

(Paragraphs 2 and 3) The qualifications of Robert C. McKee in paragraphs 1-12 of the Affidavit filed January 10, 1979 have never been in question. Paragraphs 13-28 have been considered insufficient for being highly opionated [sic] and speculative at best.

[3] (Paragraph 4) Exhibits H-K2 which are copies of the sworn deposition testimony of Jerome Wise (for protestor) firm up the opinion of the Examiner that beginning with the language "sketching a blade, knife, compacting roll, to produce the chemback product" in Exhibits H through K2 and including determination of variables such as applied pressure, shape and radius of the blade

to act upon the paper stock, appear to be undue experimentation, applicant's remarks on pages 6 and 7 of paper No. 21 filed January 10, 1979 to the contrary notwithstanding. Any further discussion regarding said exhibits is considered irrelevant since it is the Examiner's opinion that enablement of the instant disclosure and patentability of the claims are the issues to be decided.

(Paragraph 5) The proposition which provides that knife edges are neither cutting edges nor compacting edges merely by definition, but may be used in either mode by persons skilled in the art is incomplete. Exhibit I points up the fact that there is another mode i.e. "As soon as the air pressure was taken up sufficiently to compact, it also cut."

(Paragraphs 6 and 7) Karn such as column 1, lines 8-12; column 2, lines 23-32; column 3, lines 51-64 and 70-73, and Figure 5 is the evidence or factual basis of inherent compaction. Further, there is no actual disclosure in Karn that that which is cut is also removed to form the channels such as 25, 26, and 27. In light of the Karn disclosure the dictionary definition of the term "membrane" is too narrow.

[4] (Paragraph 8) 35 U.S.C. 282 begins with the statement, "A patent shall be presumed valid." In *Metropolitan Engineering Co. v. Coe,* 1935 C.D. 54, the court stated that "there is a presumption of operability to a patented device". Affidavits attacking the operability of a patent reference, though entitled to consideration are treated as an expression of the opinion by an expert in the art and are not conclusive of factual matters presented. In *In re Luerelle Guild,* 1953 C.D. 310, the C.C.P.A. said, "A patent enjoys a presumption of validity and a party attacking its validity on the ground of inoperativeness must establish his case by a preponderance of

proof. An ex parte affidavit, while not to be lightly disregarded, is seldom acceptable as being *conclusive* of the factual matter stated therein, and, in general, such affidavits are accorded the status of an expression of opinion by an expert in the art." In *In re Pappas et al.*, 1954 C.D. 278, the C.C.P.A. stated, "We have studied the affidavit carefully but fail to find any factual data set out therein . . . An affidavit which is merely a statement of the affiant's opinion is not entitled to any weight." In *In re Reid, 1950 C.D. 194*, affidavits were submitted by the assignee giving opinions as to what the references disclosed and also the reports of experiments which were said to show that the disclosure of the patents produced inoperative or unsatisfactory results. The opinion portions were inadmissible.

[5] (Paragraph 9) The affidavit must set forth facts and not merely conclusions. In *In re Pike et al.*, 1950 C.D. 105, two affidavits were submitted. The critical deficiencies of one affidavit were pointed out by the Primary Examiner who, among other things, observed that no comparative data was submitted in the affidavit with respect to the actual adhesiveness of specific compositions, including the sample submitted. The examiner concluded that the affidavits were unsupported by factual evidence, both the board and the C.C.P.A. agreed.

The facts presented in the affidavits must be pertinent to the rejection; otherwise, the affidavits have no probative value. In *In re Renstrom*, 1949 C.D. 306, an affidavit was submitted, pointing out advantages of the article claimed over those formerly produced at the plant where appellant was employed, but the C.C.P.A. held that since it did not appear from the records that articles were made in accordance with the Soloman patent, used for rejection,

such advantages were not material to the issue of patentability of the appealed claims over the patent.

Thus the instant application fails to present a side-by-side comparison with the product of the Karn reference in order to avoid the application of Karn against the claims under 35 U.S.C. 103.

The previous objections and rejections of all claims as set out in paragraphs 1-8 of the previous Office action mailed March 2, 1979 are maintained.

This rejection is made *FINAL*.

/s/ W. J. Van Balen
Examiner
Group Art Unit 164

/s/ George F. Lesmes
Supervisory Patent Examiner
Art Unit 164

WJ Van Balen:pc
(703) 557-1897
7/9/79

PATENT OFFICE EXAMINER'S REJECTION OF AMENDED REISSUE APPLICATION

(Filed November 16, 1979)

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 34

Mailed

NOV 16 1979

In Reply Please Refer To The Following:		
EXAMINER'S NAME	W. J. Van Balen	
164	09-19-77	834,136
GR ART UN	FILING DATE	SERIAL NO
BURTON D. MORGAN		
APPLICANT		INVENTION
SCORED ADHESIVE LAMINATE		

Oldham and Oldham Co.,
627 First Natl. Tower
Akron, OH 44308

Below is a communication from the EXAMINER in charge of this application

Commissioner of Patents and Trademarks

ADVISORY ACTION

☒ THE PERIOD FOR RESPONSE IS EXTENDED TO RUN 6 MONTHS FROM THE DATE OF THE FINAL REJECTION. 855 O.G. 1109

☐ Appellant's Brief is due in accordance with Rule 192(a).

Applicant's response to the final rejection, filed _____, has been considered with the following effect, but it is not deemed to place the application in condition for allowance.

1. ☐ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:
   a. ☐ There is no convincing showing under Rule 116(b).
   b. ☐ They raise new issues that would require further consideration and/or search.
   c. ☐ They raise the issue of new matter.
   d. ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
   e. ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

2. ☐ Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.

3. ☒ Upon the filing of an appeal, the proposed amendment ☒ will be ☐ will not be entered and the status of the claims in this application would be as follows:
   a. ☒ Claims None would be allowable.
   b. ☒ Claims 1-4 would not be allowable.
   However,
   (1) ☐ The rejection of claims _____ on references is deemed to be overcome by applicant's response.
   (2) ☐ The rejection of claims _____ on non-reference grounds only is deemed to be overcome by applicant's response.

4. ☐ The affidavit, exhibit or request for reconsideration has been entered but does not overcome the rejection.

5. ☐ The affidavit or exhibit will not be admitted because applicant has not shown good and sufficient reasons why it was not earlier presented.

6. ☐ The application having been examined under the special accelerated examining procedure (M.P.E.P. 708.02), the proposed amendment has not been considered since it does not prima facie place the application in condition for allowance or in better condition for appeal.

[2] If the amendment as proposed were entered paragraphs 1 and 2 of the Office action mailed March 2, 1979, would be withdrawn. Accordingly, near the bottom of page 5 of the final rejection mailed July 13, 1979, the expression "as set out in paragraphs 1-8" would be modified to "as set out in paragraphs 3-8 of the previous Office action mailed March 2, 1979 are maintained."

Applicant has urged that the principal concept of the invention is compacting potential tear lines or break point of embrittlement such that they crack or break when bent. However, in the specification generally, and more specifically on page 4, lines 18-22, reference is made to the fibrous material forming the sheet as crushed or weakened by compaction of fibers in the sheet in lineal zones or lines. There is no actual disclosure to said "embrittlement" feature. It further appears that the compacted fibers "split or tear" as disclosed on page 5, lines 20-25 in the specification rather than crack or break as urged.

The affidavit of Robert C. McKee filed October 15, 1979 under 37 CFR 132 has been given careful consideration. The affidavit is held to be insufficient because (1) a steel wire having a diameter of 0.012 inch would have an edge radius of 0.006 inch (i.e. 1/2 of diameter = radius) which corresponds to the "B" edge in the Cameron Bulletin of record whereas the instant disclosure refers to the wire as having a diameter [3] of approximately 0.010 inch (edge radius of 0.005 inch) which is well known to be sufficiently sharp to provide a knife edge for cutting paper. The 0.005 inch edge radius falls between the Cameron "A" edge and "B" edge. Accordingly, it is not seen how the 0.012 inch diameter wire conforms to the teachings of this application and it is not seen how it should

function in the same manner as a wire having a diameter of 0.010 inch. (2) paper fiber network compacted to "embrittlement" is not actually disclosed. (3) there are no good and sufficient reasons given for using a rotary score cut knife having an edge radius of 0.002-0.003 inch or a razor blade in attempting to follow the teachings of the Karn patent 3,230,649, especially column 3, lines 59 et seq. and Figure 5. An edge radius of 0.002-0.003 inch falls within the range of 0.002-0.004 inch "A" edge of the Cameron Bulletin. The "B" and "C" edge radii of the Cameron Bulletin were not used in attempting to follow the teachings of Karn loc. cit. supra. (4) The pressures in all instances are uninformative since there are mere broad references to adjusting pressures without regard to their frequency and numerical values so that a direct comparison is impossible. Thus, the instant affidavits lack factual evidence. In re Fay and Fox, 146 USPQ 47; In re Metcalf et al, 157 USPQ 423 and In re Andrews, 168 USPQ 360, cited by applicant, supporting the examiner's position. Where the comparison is not identical with the reference disclosure, deviations therefrom should be satisfactorily explained. In re Finley, 81 USPQ 383 (CCPA).

[4] A telephone interview between Mr. Ray Weber and the Examiner was held on November 13, 1979. Mr. Weber alleged that column 3, lines 59-62 were inconsistent with column 3, lines 63-69 in Karn, i.e. crush-cutting rotary knives as opposed to a die cutting operation. The Examiner's position was and always has been that the crush-cutting inherently includes compaction of the fibers resulting in thin membranes in the channels. Note Figure

5. The Examiner further noted that no product samples were filed with the affidavit.

/s/ W. J. VAN BALEN
Examiner
Group Art Unit 164

/s/ GEORGE F. LESMES
Supervisory Patent Examiner
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Supreme Court, U.S.
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CLERK

No. 85-20

In The
Supreme Court of the United States
October Term, 1985

MORGAN ADHESIVES COMPANY,
Petitioner,

v.

CHEMTROL ADHESIVES, INC.,
Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF OF RESPONDENT CHEMTROL ADHESIVES, INC. IN OPPOSITION

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July 31, 1985

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QUESTIONS PRESENTED FOR REVIEW

1. Whether the District Court properly granted, and the Court of Appeals properly upheld, summary judgment to Chemtrol holding invalid U.S. Letters Patent 3,900,645 on collateral estoppel grounds where the U.S. Court of Customs and Patent Appeals held the claims not patentable, and after Morgan litigated the patentability of the claims for five (5) years?

2. Whether the Courts below properly held that the U.S. Court of Customs and Patent Appeals had jurisdiction over reissue proceedings concerning U.S. Letters Patent 3,900,645, where a reissue patent could have issued to Morgan had allowable subject matter been found?

3. Whether the District Court properly held that Morgan may not challenge the subject matter jurisdiction of the U.S. Court of Customs and Patent Appeals by collateral attack where Morgan invoked the jurisdiction of the Court and made no challenge to jurisdiction before the C.C.P.A. or on direct review?

4. Whether Morgan has set forth any ground under Rule 17 of this Court why the decisions below ought to be reviewed by this Court?

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OPINIONS

In addition to those Opinions listed in the Petition, the following are relevant to this proceeding:

1. Patent Board of Appeals' Denial of Morgan's Request for Reconsideration (A. 97)
2. Court of Customs and Patent Appeals Denial of Morgan's Petition for Rehearing (A. 99)
3. Patent Office's Rejection of Morgan's Continued Reissue Application (A. 100)

———o———

STATUTES AND REGULATIONS

In addition to those cited in the Petition, this action involves the following statutes and regulations, the text of which are set forth in the Appendix to the brief:

1. 35 U.S.C. § 102(b)
2. 35 U.S.C. § 103
3. 35 U.C.S. § 112
4. 35 U.S.C. § 132
5. Manual of Patent Examining Procedure § 716

———o———

STATEMENT OF THE CASE

Because Petitioner Morgan Adhesives Company's Statement of the Case excludes highly relevant events crucial to this Court's understanding of this Petition, Respondent Chemtrol Adhesives, Inc.[1] presents a comprehensive statement of the relevant procedural and factual events below.

---

[1] Chemtrol Adhesives, Inc. has no parent company and no subsidiaries.

Petitioner Morgan and Respondent Chemtrol are competitors in the adhesive laminate industry. Chemtrol was founded in 1973 by Harold Robinson, a former Morgan employee. Both companies are located between Cleveland and Akron in Northeast Ohio. Morgan filed this patent infringement and unfair competition action for damages and injunctive relief in the United States District Court for the Northern District of Ohio on February 2, 1976. Between 1976 and May 20, 1983, when that court entered summary judgment for Chemtrol on collateral estoppel grounds, the primary patent claim raised by this action also proceeded through the United States Patent and Trademark Office (the "Patent Office"), the Board of Appeals therein, and ultimately to the United States Court of Customs and Patent Appeals ("CCPA"). Having no success before any of the above bodies, Petitioner returned to the District Court, which subsequently granted summary judgment on that patent claim, the balance of the claims having been dismissed by Morgan. (A. 15).

Morgan filed its Complaint on February 2, 1976. After limited discovery, Morgan, on September 20, 1977, moved to stay proceedings below in order to file a reissue application with the Patent Office respecting U.S. Letters Patent No. 3,900,645 ("Patent '645"). (A. 41-3). This motion to stay was made apparently in response to Chemtrol's Answer and Counterclaim, alleging Patent '645 to be invalid, void and unenforceable on the basis of prior art not considered by the Patent Office during the patent's prosecution. As Morgan represented to the District Court, the reissue proceeding "allows a patentee to obtain reconsideration of a patent in view of prior art and other information relevant to patentability which may not have been previously considered by the USPTO." Brief in

Support of Plaintiff's Motion to Stay Proceedings at 1. (A. 108). Morgan placed the prior art raised by Chemtrol squarely before the Patent Office, stating in its Brief in Support of Plaintiff's Motion to Stay Proceedings, at 2:

> *The greatest expertise respecting the applicablity of prior art to the claimed invention resides in the USPTO* and the new rule provides the vehicle by which the Court may avail itself of such expertise. Further, *a substantial savings in time, money, and energy of not only the parties but also the Court will be realized if all concerned are allowed to gain the benefit of the consideration given by the USPTO to the issue of applicability of the Karn, Starr and Brady references to the claimed invention.*
>
> A further amendment to the rules, 35 CFR 1.291 [sic] (1977), allows members of the public to bring to the attention of the Patent Examiner such prior art, and papers related thereto, as may be deemed relevant to a patent's prosecution. Chemtrol is thus afforded an opportunity to advise the USPTO of its position regarding the applicability of the referenced prior art or any other prior art of which it may become aware. *Full consideration may thus be made of the prior art issues at bar via the expertise of the USPTO.*

(A. 109) (emphasis added).

Morgan filed its Reissue Application on September 19, 1977, and presented its full case to the Patent Examiner. (A. 57). *Morgan surrendered its original patent as part of its application.* (A. 76). In its Brief in Support, Morgan referred to the "great commercial success" of Patent '645. Four protesters, Chemtrol among them, presented their arguments to the Patent Office. Chemtrol received copies of all Office actions in the proceeding, and Morgan was required to serve any papers filed in the proceeding upon Chemtrol.

On October 11, 1978, the Examiner, in his first Office Action, rejected all of the claims of the reissue application on five alternate grounds. (A. 77). On January 9, 1979, Morgan responded to the Patent Office action and amended *both* the specification of the reissue application and independent claim 1 and dependent claim 4 thereof. (A. 44-6). In its Supplemental Response of February 20, 1979, Morgan again referred to the commercial success of Patent '645. The Examiner, in his Office Action of March 2, 1979, objected to the amendment to the specification because it contained new matter and because it was inaccurate and misdescriptive. The Examiner then made his action final. (A. 83).

After further proceedings resulted in a new final rejection, (A. 86), Morgan, on October 11, 1979, again amended both the claims and the specification of its reissue application stating, "In response to the final rejection dated July 13, 1979, kindly enter the following amendments . . ." (A. 47). In the amendment, Morgan deleted the amendatory matter provided in the amendment of January 10, 1979 as to the specification and substituted therefor a new amendment to the specification at page 5, line 25:

> As shown in Fig. 6, the paper backing layer may be less than one-half its uncompacted thickness at the potential tear line 18.

(A. 47). Morgan amended its claims 1 and 4 a second time "to conform to the language of those claims as originally filed." (A. 48). In its "Supplemental Response to Final Rejection," filed October 26, 1979, Morgan again referred to the commercial success of Patent '645.

On November 16, 1979, the Examiner advised Morgan that the Amendment of October 15, 1979 would be entered

upon the filing of a notice of appeal. (A. 91). Morgan's application on appeal thus consisted of claims that had been twice amended and a specification that had been twice amended. (A. 44, 47).

Failing to persuade the Examiner to withdraw his final rejection, Morgan appealed the decision of the Examiner to the United States Patent and Trademark Office Board of Appeals (the "Board"). Chemtrol was granted the right to participate fully in the appeal. In its Brief, Morgan twice recited the commercial success of Patent '645. Morgan and Chemtrol both were heard at the oral argument before the Board. The Board affirmed the Examiner's rejection of Morgan's reissue application claims on a number of grounds, among them the rejection of all claims under 35 U.S.C. § 102(b) and 35 U.S.C. § 103. (A. 4-11). Morgan thereupon requested the Board to reconsider its decision. The Board, in a two page opinion, denied the request for reconsideration. (A. 97-98).

Morgan then appealed the adverse Board decision to the United States Court of Customs and Patent Appeals ("CCPA"), an Article III court. Of course, in invoking the jurisdiction of the CCPA, Morgan did not assert that it was seeking only an "advisory opinion" from the Court. In its Brief, Morgan yet again recited the commercial success of Patent '645. Again, Chemtrol intervened and submitted a brief to the CCPA and participated in oral argument. Morgan, in addition to using the same series of charts purporting to demonstrate the scope of prior art as had been used before the Board, made a film presentation to the CCPA showing manufacturing processes and distributed samples of a product made by one of Morgan's experts. The Court affirmed the Patent Office's rejection of all claims of the reissue application under 35 U.S.C.

§ 103. (A. 12-14). Morgan petitioned the Court for rehearing, but was denied. (A. 99). At no time did Morgan question or challenge the jurisdiction of the CCPA, nor did Morgan at that time petition this Court for writ of certiorari.

Morgan subsequently abandoned its reissue application but, undaunted, filed a "continuation reissue application" in the Patent Office. Again, Chemtrol participated fully. On November 3, 1982, the Examiner rejected all claims of the continuation reissue application. (A. 100-08). Although the Examiner needed to tender only a single ground of rejection, he tendered four alternate and distinct grounds for rejection of all of the Morgan claims, among them being rejection of all claims on res judicata grounds, arising from the decision of the United States Court of Customs and Patent Appeals on the reissue appeal. *Id.* Morgan then abandoned its continuation reissue proceeding.

On January 24, 1983, Chemtrol moved for summary judgment as to the infringement claims relating to Patent '645 in the District Court below, maintaining that the CCPA's decision finding the claims of Patent '645 to be not patentable was determinative of that Patent's validity, and that Morgan was collaterally estopped from further arguing the validity of Patent '645. Chemtrol demonstrated that Morgan had received a full and fair hearing on the issue of the validity of Patent '645, and that every prerequisite for the application of collateral estoppel had been satisfied. Chemtrol submitted the Affidavit of Christopher B. Fagan, who had protested the reissue on behalf of Chemtrol, and attached extensive portions of the reissue record.

A flurry of briefing followed Chemtrol's initial motion and memorandum in support. Morgan's briefs included the assertions that the reissue proceeding was advisory only, that the decision of the CCPA was an advisory opinion, and further that collateral estoppel could not apply against Morgan because it had not received a full evidentiary hearing and had been denied due process.

The District Court granted Chemtrol's motion for summary judgment on May 20, 1983. (A. 15-34). In a lengthy opinion, the Court specifically addressed two arguments made by Morgan, the first of which Morgan has presented to this Court: (1) that the decision of the CCPA was advisory only; and (2) that there was no full and fair hearing in the reissue proceedings. The Court rejected both contentions. (A. 24). Following precedent of this Court, the District Court first held that any attack on the subject matter jurisdiction of the CCPA had to be by direct review, and not by collateral attack as Morgan was attempting to do. (A. 29-30). Second, the Court found that, by virtue of Morgan's amendments of the claims and specification of its reissue application, a true reissue proceeding occurred therein. (A. 28-9). Third, the Court agreed with Chemtrol that *California Computer Products, Inc. v. Simplicity Pattern Co.*, 194 U.S.P.Q. 367 (C.D. Cal. 1977), and *W.F. Altenpohl, Inc. v. Gainesville Machine Co.*, 185 U.S.P.Q. 500 (N.D. Ga. 1974), not even cited by Morgan in its Petition, are "dispositive of the question presented in this case." (A. 33). The Court further found Morgan's contention that it was denied a full and fair hearing to be "utterly without merit." *Id.* Finally, the Court dealt with Morgan's claim of due process violations, finding this claim also to be "without merit." (A. 34 n.16).

Morgan appealed the decision of the District Court to the Court of Appeals for the Federal Circuit. In its Brief, Morgan reiterated its "due process" argument at some length. Morgan also repeated its contention that the reissue proceedings were advisory only. Morgan did not attempt to distinguish, nor did it even cite, the two cases the District Court had found to be "dispositive."

On February 7, 1985, the Federal Circuit affirmed the decision of the District Court on the ground of collateral estoppel, specifically finding that Morgan had converted its reissue application into a statutory reissue, thereby obviating Morgan's attack on the jurisdiction of the CCPA. (A. 1-3). The Court further specifically found that Morgan had not been denied due process of law. (A. 3).

Morgan now petitions this Court for a writ of certiorari on the same grounds that have been rejected in the courts below. Based upon the authorities below, and for the reasons which follow, Morgan's petition should be denied.

———o———

ARGUMENT

I. The Courts Below Held Correctly That Morgan Is Collaterally Estopped From Relitigating The Validity Of U.S. Letters Patent 3,900,645.

The Courts below held correctly that Morgan is collaterally estopped from relitigating the validity of Patent '645. The doctrine of collateral estoppel acts to conserve judicial resources by preventing a party from litigating the same issue more than once:

> Under collateral estoppel, once an issue is actually and necessarily determined by a court of competent jurisdiction, that determination is conclusive in subsequent suits based on a different cause of action involving a party to the prior litigation.

Montana v. United States, 440 U.S. 147, 154 (1979). Although variously stated, the doctrine has four main elements. First, the issue involved in the action in which estoppel is asserted must be the same as, or embraced within, an issue involved in prior adjudication. Second, there must have been a final judgment on the merits in the prior action. Third, the estopped party must have been a party or in privity with a party to the prior adjudication. Fourth, the estopped party must have had a full and fair opportunity to be heard on the issue in question. *Oldham v. Pritchett,* 599 F.2d 278, 279 (8th Cir. 1979); *Westwood Chemical, Inc. v. Molded Fiber Glass Body Co.,* 498 F.2d 1115, 1116, 1119 (6th Cir. 1974). The Courts below correctly found that all of these elements are satisfied here.

In the context of patent litigation, the landmark case concerning collateral estoppel is *Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation,* 402 U.S. 313 (1971), quoted extensively by the District Court. (A. 22-23). In *Blonder-Tongue,* this Court addressed the respective burdens of proof upon the parties when collateral estoppel is raised. If the defendant raises estoppel, the defendant has the burden of showing that the plaintiff seeks to relitigate the same issue decided adversely to the plaintiff in the prior case. The plaintiff must then prove, "if he can," that he did not have a fair opportunity to litigate the claim the first time. 402 U.S. at 802. The factors to be evaluated when examining whether a full

and fair opportunity to litigate was afforded were explained by this Court in *Blonder-Tongue* (and quoted by the District Court) as follows:

> Determining whether a patentee has had a full and fair chance to litigate the validity of his patent in an earlier case is of necessity not a simple matter. *In addition to the considerations of choice of forum and incentive to litigate* mentioned above, certain other factors immediately emerge. For example, if the issue is nonobviousness, *appropriate inquiries would be whether the first validity determination purported to employ the standards announced in Graham v. Deere Co., supra; whether the opinions filed by the District Court and the reviewing court, if any, indicate that the prior case was one of those relatively rare instances where the courts wholly failed to grasp the technical subject matter and issues in suit; and whether without fault of his own the patentee was deprived of crucial evidence or witnesses in the first litigation.* But as so often is the case, no one set of facts, no one collection of words or phrases, will provide an automatic formula for proper rulings on estoppel pleas. In the end, decision will necessarily rest on the trial court's sense of justice and equity.

(A. 23) (quoting 402 U.S. at 333-34) (footnote omitted) (emphasis in original); *see Stevenson v. Sears, Roebuck & Co.*, 713 F.2d 705, 709 (Fed. Cir. 1983). The above standard was correctly applied by the Courts below.

The second and third elements of collateral estoppel mentioned above may be dealt with summarily. There is no dispute that the CCPA reached a final judgment on the merits of the patentability of the claims of Patent '645. The purported issue of the Court's jurisdiction will be dealt with below. Likewise, there is no dispute that Morgan was a party to the prior reissue litigation.

The only two issues remaining for the application of collateral estoppel are: (1) identity of issues; and (2)

whether Morgan received a full and fair opportunity to litigate.

A. The U.S. Court of Customs and Patent Appeals' Affirmance of the Rejection of the Claims of the Reissue Application Is Equivalent to a Finding of Invalidity of Patent 3,900,645.

The issue before the Patent Office, the Board of Appeals, and the CCPA was the patentability of the claims of the reissue application, and therefore necessarily the validity of Patent '645. The Courts below could not have found Patent '645 valid without contradicting the judgments of the Patent Office and the CCPA that the claims of this patent are unpatentable. Similarly, the Courts below could not have found Patent '645 infringed without finding it valid, again contradicting the judgment of the forums Morgan chose to litigate the patentability of the claims of this patent. *See Westwood Chemical, Inc. v. Molded Fiber Glass Body Co.*, 380 F. Supp. 517, 527 (N.D. Ohio 1973), *aff'd*, 498 F.2d 1115 (6th Cir. 1974). Thus, the issue of validity of Patent '645 is necessarily embraced within and identical to the issue decided adversely to Morgan by the CCPA and the Patent Office.

That identity of issues exists in this action becomes even clearer upon examination of the two cases the District Court found "dispositive of the question presented in this case" (A. 33), and which Morgan did not even attempt to distinguish in its Petition. In *California Computer Products, Inc. v. Simplicity Pattern Co.*, 194 U.S.P.Q. 367 (C.D. Cal. 1977), presenting "facts nearly identical to those before this Court" (A. 30), the matter before the court was defendants' motion for summary

judgment on collateral estoppel grounds. 194 U.S.P.Q. at 368. As in the instant case, the plaintiff in *Computer Products* brought a patent infringement suit in federal court. The parties "vigorously prosecuted and defended the action" for two years, until plaintiff filed an application for reissue of its patent with the Patent Office. The case lay dormant in federal court while plaintiff pursued the reissue proceedings.

The Patent Office ultimately rejected the reissue application. Plaintiff appealed to the Board of Appeals, which affirmed the rejection. 194 U.S.P.Q. at 368. The plaintiff then appealed to the CCPA. After the CCPA rendered its decision, plaintiff filed a continuation reissue application in the Patent Office. *Id.* at 369. The Patent Office again rejected the claims of plaintiff's application. The Court in *Computer Products* then addressed defendant's motion for summary judgment and held:

> The decision in Blonder-Tongue approves a plea of estoppel in patent cases where the party asserting the patent had enjoyed a full opportunity to present his side of the case. Blonder-Tongue concerned the effect of a judgment in one patent infringement suit on another infringement suit on the same patent. Where, as here, the litigation centered in the Court of Customs and Patent Appeals, and concerned whether a patent even exists, the logic of Blonder-Tongue is even more compelling. *Plaintiff cannot create a patent in this Court; he must first have one authorized by the Patent Office. Once the Court of Customs and Patent Appeals finally decides that he has no patent, this Court cannot entertain a claim of infringement.*
>
> . . . .
>
> *Plaintiff has long represented to this Court that we should have the benefit of the expertise of the Pa-*

> *tent Office. Now that we have that benefit, plaintiff would have us ignore it because the expertise weighs against him. We decline to follow such an approach.*

(A. 31) (quoting 194 U.S.P.Q. at 369-70) (emphasis in original). The Court in *Computer Products*, viewing facts almost identical to those of this action, granted summary judgment for defendant. The District Court also correctly cited *W.F. Altenpohl, Inc. v. Gainesville Machine Co.*, 185 U.S.P.Q. 500 (N.D. Ga. 1974), as being dispositive of the instant case. (A. 32-3).

Computer Products and *Altenpohl* demonstrate clearly that an adverse determination by the Court of Customs and Patent Appeals in reissue proceedings estops Morgan from later relitigating the validity or the infringement of the patent in issue therein, and for this reason, the Courts below held correctly that any part of Morgan's claim relating to Patent '645 is properly disposed of by summary judgment in favor of Chemtrol. Understandably, Morgan fails to cite this precedent, and indeed asserts that it does not exist.[2]

B. Morgan Had a Full and Fair Opportunity to Litigate the Validity of Its Patent in Reissue Proceedings.

The Courts below also found that Morgan had a full and fair opportunity to litigate. The District Court held Morgan's contentions to the contrary in this regard to be "utterly without merit":

---

[2] At p. 16 of its Petition, Morgan states that "No reissue proceeding invalidates a patent. But in our case, two courts [those below] have held that it does." In reality, at least four courts have so held.

> During the five (5) years that Morgan was before the patent office, the board of patent appeals and the CCPA, it filed numerous briefs and reply briefs, presented affidavits of experts, used deposition testimony taken in discovery in this case and orally argued validity twice. Indeed when it was before the CCPA Morgan presented a movie and distributed samples of its product. In *Kaiser Industries Corp. v. Jones & Laughlin Steel Corp., supra,* the Court of Appeals for the Third Circuit construed the decision of the United States Supreme Court in *Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation, supra,* and held:
>
> > *The guidelines suggested for reaching a result permitting relitigation are replete with qualifying words making a patentee's burden onerous. In effect, a patentee must persuade a second trial court 'that the prior proceedings were seriously defective.'*
>
> (Footnote omitted) (emphasis added). The court holds that Morgan has failed to meet its burden of showing "that the prior proceedings were seriously defective."

(A. 33; *see* A. 3) (emphasis in original).

Perhaps most telling of the nature and scope of the Patent Office proceedings regarding Patent '645 is Plaintiff's own Request for Additional Time for Oral Argument before the Board of Appeals:

> The need for additional time to fairly present appellant's case is further supported by the *sheer volume of material* lodged during the prosecution before the Examiner and before this Board on Appeal . . . The requested five (5) minute rebuttal period would afford appellant a minimum of time necessary for a *full and fair hearing.*

(A. 111-12) (emphasis added) (the request was granted).

Undaunted by the specific findings against it below, Morgan has argued in its Petition, for the first time in this action, that it did not receive a full and fair hearing "because it never had the opportunity to argue commercial success of its patent." Petition at 230. This assertion is patently false. Not only did Morgan have the opportunity to argue commercial success, *it did so* at several points during the reissue proceeding. These are set forth, in part, in the statement of the Case, *supra,* at 3-5.

Despite the facts Morgan asserts that commercial success "was not considered, and would not have been relevant, to the no-defect proceeding." Petition at 21. Understandably, no citation follows this assertion, which is yet another attempt to mislead this Court. Manual of Patent Examining Procedure § 716(4), provides that "Affidavits or declarations submitting evidence of commercial success . . . must be considered by the examiner in determining the issue of obviousness of claims for patentability under 35 U.S.C. 103." Morgan had the opportunity to, and did, argue commercial success following the Examiner's rejection of Patent '645 under 35 U.S.C. § 103. Morgan's assertion to the contrary is disingenuous at best.

In view of the length of time and intensity with which Patent '645 was litigated, before the bodies that Morgan admitted have "the greatest expertise" regarding these matters, the Courts below held correctly that Morgan had a full and fair opportunity to litigate the validity of Patent '645. This Court should, therefore, deny Morgan's Petition.

II. The Courts Below Held Correctly That The U.S. Court Of Customs And Patent Appeals Had Jurisdiction Over Morgan's Appeal Of Adverse Patent Office Actions On Reissue.

A. The Reissue Proceeding Concerning Patent '645 Was Not an Advisory Reissue.

In its Petition, Morgan argues in the face of specific findings below that its reissue application regarding Patent '645 was advisory only and that such application could not be converted into an adjudicatory proceeding. Petition at 13-16. Review of the facts and applicable law, however, demonstrates that Morgan prosecuted a true reissue application, and that a reissue patent could have issued had allowable subject matter been found.

In the first Official Action of the Patent Office, the Examiner rejected the Morgan reissue claims on five (5) alternate grounds, including rejections under 35 U.S.C. § 112 (first paragraph), 35 U.S.C. § 112 (first and second paragraphs), 35 U.S.C. § 102(b) (based on Karn), 35 U.S.C. § 103 (based on Karn in view of Brady or Brady, Jr.), and 35 U.S.C. § 103 (based on Karn in view of *Cameron Bulletin*). (A. 78-81). In addition, the Examiner objected to the specification for lack of an antecedent basis therein for the limitation of claim 3. (A. 78).

In response to the Patent Office Action,[3] Morgan amended the specification by inserting at page 5, line 25, the following language:

> As shown in FIGURE 6, the lines 18 of the processed sheet 12 are compacted to a reduced thickness which

---

[3] Morgan's printing of the Appendix characterizes the Morgan response of January 9, 1979 as "Morgan's Amended Reissue Application." (A. 44).

> may, for example, be less than one-half of the thickness of the sheet 12 proper.

(A. 44). In addition, Morgan amended independent claim 1 and dependent claim 4. (A. 44-5). In amending the claims, Morgan stated "These amendments have been made to correct the shortcomings of claims 1 and 4 as noted in paragraph 2 of the Office Action . . ." (A. 45).

In the Official Action that followed, the Examiner objected to the amendatory matter inserted in the specification as containing new matter and as being inaccurate and misdescriptive. (A. 84). The Examiner then rejected claims 1-4 under 35 U.S.C. § 132 as being based on new matter and under 35 U.S.C. § 112 (first and second paragraphs). (A. 84). In addition, the Examiner repeated the five (5) grounds of rejection of the claims as noted in the first Official Action. (A. 85). At this time, the Examiner made his action final. *Id.*

Subsequently, the Examiner withdrew the final rejection in favor of a new final rejection which issued on July 9, 1979. (A. 86-90). In the new final rejection, the Examiner responded to arguments raised by Morgan and, in addition, repeated the previous objections and rejections of all of the claims set out in the prior Official Action. *Id.*

In response to the final rejection of July 13, 1979, Morgan deleted the earlier amendment to the specification in favor of a substituted amendment to the specification which read as follows:

> As shown in FIGURE 6, the paper backing layer may be less than one-half of its uncompacted thickness at the potential tear line 18.

(A. 47). Morgan made this amendment to the specification:

> [T]o conform to the helpful suggestion of the Examiner as set forth in the Office Action dated March 2, 1979. Particularly, line 25 of page 2 has been amended to include the acceptable language of claim 3 with respect to the nature of the potential tear line 18.

(A. 48). In addition, Morgan amended its claims 1 and 4 a second time "to conform to the language of those claims as originally filed."[4] *Id.*

In the appeal to the Board of Appeals that followed, the Examiner's rejections of the claims under 35 U.S.C. § 102(b) (based on Karn), 35 U.S.C. § 103 (based on Karn in view of Brady ('732) or Brady ('545) and 35 U.S.C. § 103 (based on Karn in view of the *Cameron Bulletin)* were affirmed. In view of the breadth of this affirmance, Morgan's contention that the Board "merely decided whether the PTO correctly refused to reflect on the original patent record that certain prior art had been considered," Petition at 16, is patently false. (A. 4-11). Morgan's request for reconsideration was denied. (A. 97). Morgan then appealed to the CCPA.

As the case came to the CCPA, the *claims* were in the same form which had originally issued from the Patent Office in Patent '645 although, as noted above, two amendments had been made to the claims during the prosecution before the Examiner. The second amendment brought the claims back into conformity with the original claim language of Patent '645. The specification, however, had

---

[4] Morgan's printing of the Appendix characterizes the Morgan response of October 11, 1979 as "Morgan's Amendments to Reissue Application." (A. 47).

been amended — twice — ending up in a form *different* from that of the original Patent '645 as noted above. Were this an "advisory" reissue, *none* of the above amendments could have been made.

The Courts below properly recognized that a change in the specification was enough to convert this reissue from an advisory to a "true" reissue proceeding. As stated by the Court of Appeals:

> Although appellant withdrew its amendments to the claims, it did not withdraw its amendment to the specification. Appellant, in fact, admits in its brief "as the case came to the CCPA the patent was in precisely the same form in which it had originally issued from the Patent Office, *except* only for the insertion of one sentence in the specification." (Emphasis added). The sentence was added to overcome a rejection of claim 3 based on the lack of antecedent basis for the limitation in claim 3. *The change thereby converted the application into a statutory reissue application.*

(A. 2) (emphasis added). The Court of Appeals then distinguished *In re Bose,* 687 F.2d 432 (C.C.P.A. 1982), and *In re Dien,* 680 F.2d 151 (C.C.P.A. 1982), relied on by Morgan:

> In both cases the proceedings were held to be advisory only. The basis for those conclusions was that no reissue patents could have issued that would have differed from the original patents because no new specifications or claims were present in the reissue applications. By contrast, *in the present case, had the Court of Customs and Patent Appeals (CCPA) reversed the rejection, appellant would have received a new patent containing new language* . . . . The proceedings in the Patent and Trademark Office (PTO) *were therefore not advisory in this case.*

(A. 2) (emphasis added).

Morgan goes to great lengths in its Petition to state that it was only seeking an advisory opinion all along. Curiously, Morgan does not cite to any part of the voluminous record to support this assertion. The reason is clear — there is no such support. Morgan also argues that because it labeled its reissue as advisory under 37 C.F.R. § 1.175(a)(4), it must have, therefore, been merely an advisory reissue. This same argument was rejected in *In re Bose, supra,* where the applicant refused to execute a reissue oath or declaration and argued that the entire proceeding was advisory. In response, the CCPA noted:

> [T]he label attached by the PTO or appellant to a reissue proceeding, whether it be (a)(3) or (a)(4), is not determinative of whether a case or controversy exists for purposes of Article III of the Constitution of the United States.

687 F.2d at 435.

The *Bose* case, besides demonstrating the unimportance of the label placed on a reissue application, also answers Morgan's argument that its reissue application did not have a proper separate declaration or oath to support it, as required under 37 C.F.R. § 1.175(a)(3). The placing of an affidavit in the file is a matter of formality and need not be done until the reissue patent is ready to issue. The Examiner has discretion to accept a new or supplemental oath at any time during the prosecution of the application. Because Morgan's reissue application was never in condition for allowance, it was not necessary for the Examiner to request the filing of a suitable oath or declaration pursuant to 37 C.F.R. § 1.175(a)(3). In *Bose,* the Board of Appeals, in compliance with the mandate of MPEP § 1404.02, concluded that appellant had in effect

converted his reissue application from an (a) (4) to an (a) (3) application, though no new oath or declaration had been filed. 687 F.2d at 434. Thus, the absence of such an oath does not affect the classification of a reissue, which is, in any event, unimportant. *See Cutter Co. v. Metropolitan Electric Manufacturing Co.*, 275 F. 158 (2d Cir. 1921) (supplemental oaths may be accepted even after the case is allowed).

In summary, Morgan prosecuted a reissue application in which two amendments were made to the specification and two amendments were made to claims 1 and 4. The amendments to the specification clearly could have resulted in the issuance of a reissue patent had the CCPA found allowable subject matter. The Courts below, therefore, were correct in holding that Morgan converted its application from an advisory to a "true" reissue.

B. Morgan Was Not Denied Due Process.

Morgan's arguments in its Petition that it was denied due process because it did not voluntarily surrender its patent (which it actually had done) and because the Courts below somehow converted its reissue from advisory to "regular" is again contrary to the facts in this case and the applicable law. *Morgan*, and not the courts below, converted its reissue application from a 37 C.F.R. § 1.175(a)(4) reissue to an (a)(3) reissue. The conversion was not without warning — it was, in fact, performed by Morgan itself when it amended both its specification and claims.[5] At that point in time, Morgan knew that it

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[5] Morgan's assertion at p. 16 of its Petition that "any conversion which took place was performed by the Courts in this case, not by Morgan," is patently false and directly contrary to MPEP § 1414.02, quoted by Morgan in its next paragraph.

was no longer seeking merely an advisory opinion but that it was, rather, attempting to obtain allowance of amended claims with reference to an amended specification, all in response to objections and rejections made by the Examiner. Morgan's protestations that it has been subjected to a conversion without warning of its reissue application ignore the facts that:

(a) Morgan filed its reissue application and actually surrendered Patent '645 to the Patent Office after litigation was commenced against Chemtrol voluntarily and with full knowledge of the Patent Office reissue statutes (A.76);

(b) Morgan voluntarily filed a motion to stay proceedings in the United States District Court during the pendency of its reissue application;

(c) Morgan voluntarily amended its specification and claims on two occasions in response to Examiner objections and rejections;

(d) Morgan voluntarily appealed the adverse decision of the Patent Office Examiner to the Board of Appeals;

(e) Morgan voluntarily appealed the adverse decision of the Patent Office Board of Appeals to the CCPA;

(f) Morgan voluntarily petitioned for a rehearing in the CCPA. In its petition, Morgan made no reference to the CCPA's alleged lack of jurisdiction; and

(g) Morgan voluntarily elected not to file a petition at that time for a writ of certiorari in this Court but, rather, elected to:

(i) Voluntarily file a continuation reissue application in the Patent Office; and

(ii) Voluntarily abandon its continuation reissue application after the first action in which the Examiner continued to reject all of the claims.

Morgan's own actions clearly distinguish its reissue applications from any semblance of an advisory proceeding; Morgan cannot be heard to complain now because the results of its actions are not to its liking. The Courts below held correctly that Morgan was not denied due process.

III. The Courts Below Held Correctly That Morgan May Not Collaterally Attack The Subject Matter Jurisdiction Of The United States Court Of Customs And Patent Appeals.

Fundamentally, Morgan's Petition is an attack on the prior judgment of the CCPA in Morgan's reissue proceeding. The District Court opinion, while demonstrating that Morgan's position on the prior CCPA judgment is without merit, also properly rebuffs Morgan's attempt to collaterally attack the CCPA judgment. (A. 27-30).

Morgan argues that because the CCPA recently decided in *In re Dien*, 680 F.2d 151 (C.C.P.A. 1982), that it no longer had jurisdiction over *advisory* reissue proceedings, that, therefore, the prior judgment of the CCPA against it must have been "in the teeth" of precedent[6]

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[6] Morgan seems to assert that the CCPA decided Morgan's appeal—in 1981—in the teeth of "precedent" decided in 1982 that no jurisdiction existed. No further comment on this position seems necessary, other than to say that it cannot possibly be taken in good faith.

that jurisdiction does not exist. Petition at 19. Chemtrol has already demonstrated, *supra,* that the District Court was correct in holding that Morgan's reissue was not an advisory one. However, it is clear that Morgan may not attack the CCPA's judgment in any event before this Court, because the CCPA's assumption of subject matter jurisdiction on reissue is res judicata and no longer subject to attack.

The District Court dealt with the issue of collateral attack at some length below:

> In *Chicot County Drainage Dist. v. Baxter State Bank,* 308 U.S. 371, 60 S. Ct. 317 (1940), the United States Supreme Court held that although subject to "direct review," a determination by a federal court that it sustains subject matter jurisdiction over a cause of action "*may not be assailed collaterally.*" 308 U.S. at 376, 60 S. Ct. at 319 (Emphasis added). The Court of Appeals for the Third Circuit has held:
>
> > It was settled long ago by *Chicot County Drainage District v. Baxter State Bank,* 308 U.S. 371, 60 S. Ct. 317, 84 L.Ed. 329 (1940), that when a federal court proceeds to final judgment on the merits, the issue of its subject matter jurisdiction is res judicata even though it was not litigated or, indeed, even though the decree was totally uncontested.
>
> *Hodge v. Hodge,* 621 F.2d 590, 592 (3d Cir. 1980) (footnote omitted).

(A. 27-28).

Morgan made no attempt to assail the CCPA's subject matter jurisdiction either before the CCPA or on direct review, though it had two opportunities to do so subsequent to the CCPA's adverse adjudication of Morgan's appeal from the Patent Office Board of Appeals. First,

Morgan could have raised the issue, but did not, in its petition for rehearing to the CCPA. Second, Morgan could have petitioned for certiorari to this Court at that time. Morgan failed to do so. Collaterally, Morgan now asserts the anomalous position of attacking the jurisdiction of the CCPA after deliberately invoking it, in the hope of somehow obtaining a different result. This it cannot do.

In support of its holding, the District Court cited the landmark case of *Chicot County Drainage District v. Baxter State Bank,* 308 U.S. 371 (1940). In *Chicot,* this Court addressed a situation similar to that before the Courts below and now on appeal to this Court. This Court addressed the collateral attack of a decision under a statute later declared unconstitutional. The Court denied the propriety of the collateral attack:

> The lower federal courts are all courts of limited jurisdiction, that is, with only the jurisdiction which Congress has prescribed. But nonetheless *they are courts with authority, when parties are brought before them in accordance with the requirements of due process, to determine whether or not they have jurisdiction to entertain the cause and for this purpose to construe and apply the statute under which they are asked to act. Their determinations of such questions, while open to direct review, may not be assailed collaterally.*
>
> . . . .
>
> The remaining question is simply whether respondents have failed to raise the question in the proceeding to which they were parties and in which they could have raised it and had it finally determined, were privileged to remain quiet and raise it in a subsequent suit. Such a view is contrary to the well-settled principle that res judicata may be pleaded as a bar, not only as respects matters actually presented to

> sustain or defeat the right asserted in the earlier proceeding, "but also as respects any other available matter which might have been presented to that end."

308 U.S. at 376 (quoting *Grubb v. Public Utilities Commission,* 281 U.S. 470 (1930)) (emphasis added). Because Morgan attempts to collaterally attack the jurisdiction of the CCPA, after deliberately invoking it, its Petition should be denied.

IV. Morgan Has Failed To Set Forth Any Reasons Why Its Petition Should Be Granted.

Rule 17 of the Rules of the Supreme Court of the United States provides that review on writ of certiorari "will be granted only when there are special and important reasons therefor." The Rule then lists several reasons which "indicate the character of reasons that will be considered." *See General Talking Pictures Corp. v. Western Electric Co.,* 304 U.S. 175, 178 (1937) (granting writ "would not be warranted merely to review the evidence or inferences drawn from it . . . concurrent findings [by Courts below] . . . are not to be disturbed unless plainly without support"); *Layne & Bowler Corp. v. Western Well Works, Inc.,* 261 U.S. 387, 393 (1923) (writ not granted "except in cases involving principles the settlement of which is important to the public as distiguished from that of the parties, and in cases where there is a real and embarrassing conflict of opinion between the circuit courts of appeal"). Morgan understandably does not cite nor attempt to comply with any portion of this Rule. Morgan's only colorable attempt at compliance is breathtaking but ridiculous. At p. 22 of its Petition, Morgan asserts that "This Court should grant certiorari to reverse a decision in conflict with its own proper decisions . . . ." After

making this assertion, *Morgan fails to cite a single decision of this Court that conflicts with the decisions below.* All that appears, for the first time, is a "suggestion" that this Court "should further reexamine or clarify *Blonder-Tongue,*" a watershed case in both patent and procedural jurisprudence. Petition at 23. By so suggesting, Morgan recognizes that *Blonder-Tongue* and its progeny control in this action, and that its only hope is that this Court will overrule *Blonder-Tongue.*

In its Conclusion, Morgan again asserts that "a conflict has been created with decisions of this Court." Petition at 24. Zealous advocacy does not encompass willful misrepresentation and, for this reason alone, independent of the bankruptcy of Morgan's contentions, Morgan's Petition should be denied.

CONCLUSION

For all of the above reasons, Morgan's Petition should be denied.

Respectfully submitted,

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Attorneys for Respondent
Chemtrol Adhesives, Inc.

APPENDIX

35 U.S.C. § 102(b) provides as follows:

> A person shall be entitled to a patent unless —
>
> . . . .
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States . . .

35 U.S.C. § 103 provides as follows:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made. Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

35 U.S.C. § 112 provides as follows:

> The specification shall contain a writen description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

35 U.S.C. § 132 provides as follows:

Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Commissioner shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of

> continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

Manual of Patent Examining Procedure § 716 provides in pertinent part as follows:

> Affidavits or declarations submitting evidence of commercial success, long-felt but unsolved needs, failure of others, etc., must be considered by the examiner in determining the issue of obviousness of claims for patentability under 35 U.S.C. 103 . . . .

PATENT BOARD OF APPEALS' DENIAL OF MORGAN'S REQUEST FOR RECONSIDERATION

(Dated December 23, 1980)

ON REQUEST FOR RECONSIDERATION

This is a request for reconsideration of our decision of October 30, 1980, wherein we affirmed the rejection of all [2] the claims.

We note Protestor's memorandum.

Appellant contends that we have not properly interpreted the McKee and Ferrell affidavits. According to appellant, these affidavits clearly indicate that the Karn procedure may not be used to compress a backing paper or liner and that, when the described cutting takes place, it is either partial or complete, the partial cut paper remaining flexible.

Appellant's comments are basically the same as those set forth in the record before us. While Karn describes cutting through the liner, he also specifically describes an embodiment (column 3, line 59-73) in which channels

can be formed by crush-cutting rotary knives in which the liner fibers remain *unruptured* and become weakened at the channels. Such channels are readily ruptured when sharply bent and form a tab for removal of said liner. We have no valid reason to doubt that the product described by Karn is equivalent to that claimed. We are still of the opinion that one skilled in this art would clearly understand how to use the crush-cutter to obtain the result described by Karn.

Appellant's position would be tenable if Karn did not describe the final product. However, Karn clearly indicates a final product having the characteristics defined by appellant.

Appellant argues that the simultaneous rejection on Sections 103 and 102 is evidence that there is evidence that [3] there is uncertainty as to the teachings in Karn.

The examiner has the option of using any rejection which is appropriate, and we do not believe that the use of one rejection is prejudicial in any manner to the use of an alternative rejection.

We have reconsidered our decision as requested by appellant, but we decline to modify it in any respect.
DENIED

/s/ SAMUEL BLECH
Examiner-in-Chief

/s/ MURRAY KATZ
Examiner-in-Chief

BOARD OF APPEALS

/s/ IRVING PELLMAN
Examiner-in-Chief
(Acting)

COURT OF CUSTOMS AND PATENT APPEALS' DENIAL OF MORGAN'S PETITION FOR REHEARING

(Dated September 3, 1981)

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS
717 Madison Place NW.
Washington, D.C. 20439

George E. Hutchinson
Clerk

September 3, 1981

Ray L. Weber, Esq.
Oldham, Oldham, Hudak & Weber
627 First National Tower
Akron, OH 44308

Re: Appeal No. 81-552
Ex parte Morgan

Dear Mr. Weber:

The court denied today the petition for rehearing in the above appeal.

Very truly yours,

/s/ GEORGE E. HUTCHINSON

cc: Solicitor
Christopher B. Fagan, Esq.

PATENT OFFICE'S REJECTION OF MORGAN'S CONTINUED REISSUE APPLICATION

(Dated November 1, 1982)

301140

Entered

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1. Applications papers
2. Letter Request filed Dec. 23, 1982
3. Ltr Draft A Ltr 11 pp
4. [illegible]
5. [illegible]
6. Dec Ltr Pet for Comment & Dec Ltr. for Exam, Aug 5, 198[illegible]
7. [illegible]
8. [illegible]
9. Appeal Brief 6 pages filed [illegible]
10. Reply of Ctrl. & Morgan Ltr Dec 3, 19[illegible]
11. Letter Comm Pats of Ctrl & Brief Rec'd
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* * *

(SEAL)

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS

Washington, D.C. 20231

Serial Number, Filing Date, First Named Applicant, Attorney Docket No.

Examiner, Art Unit, Paper Number 12.

Date Mailed:

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

[X] The applicaton has been examined. [X] Responsive to communication filed Nov. 1, 1982, Sept. 23, 1982, Oct. 22, 1982. [ ] The action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s) from the date of this letter.

Failure to respond within the period for response will cause the application to become abandoned. 36 U.S.C. 133.

Part 1. THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION.

1. [X] Notice of References Cited by Examiner. PTO-892. 2. [ ] Notice of Informal Patent Drawing, PTO 948. 3. [ ] Notice of References Cited by Applicant, PTO-1449. 4. [ ] Notice of Informal Patent Application, Form PTO-152. 5.[ ]

Part II SUMMARY OF ACTION.

1. [ ] Claims 1-4 are pending in the application.

Of the above claims —— are withdrawn from consideration.

2. [ ] Claims ———— have been cancelled.

3. [ ] Claims ———— are allowed.

4. [X] Claims 1-4 are rejected.

5. [ ] Claims ———— are objected to

6. [ ] Claims — are subject to restriction or objection requirements

7. [ ] The formal drawings filed on — are acceptable

8. [ ] The drawing correction requests filed on—— has been [ ] approved [ ] disapproved

9. [ ] Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has

[ ] been received. [ ] not been received.

[ ] been filed in permit application, serial no. ———— filed on ————

10. [ ] Since this application appears to be in condition for allowance accept for formal matters, prosecution as to the merits is claimed in accordance with the practice under Ex parte quayle, 1935 C.D. 11; 453 O.G. 213.

11. [X] Other. No reference enclosed as all references are of record in the prior reissue application SN 834,136, abandoned.

PTOL-326 (rev. 7-79)

EXAMINER'S ACTION

[2] 1. Applicant's brief in support of this reissue application has urged a new issue which could not have been presented earlier is now presented by virtue of a newly filed affidavit by Robert C. McKee under 37 CFR

1.132, and citing: In re Herr, 153 USPQ 548 (CCPA 1967); In re Fisher, 166 USPQ 18 (CCPA 1970); In re Irish, 167 USPQ 764 (CCPA 1970); In re Russell, 169 USPQ 426 (CCPA 1971) in support thereof. The case law appears to support applicant's arguments.

2. The New and Supplemental Protest Of Chemtrol Adhesives, Inc., filed October 14, 1982 has been received. In a letter signed by C.K. Weiffenbach Examiner, Office of the Assistant Commissioner mailed August 25, 1982, paragraph V reads in part:

—"active participation by the protestor ends with the filing of its protest and no further submissions on behalf of the protestor will be acknowledged or considered and no further communications from the Office will be sent to the protestor unless such further submissions raise new issues which could not have been earlier presented such as to constitute a new protest."

The instant McKee affidavit raises a new issue as applicant admits.

3. Reply of Chemtrol To Morgan Response filed October 26, 1982 has been received.

[3] 4. 35 U.S.C. 103 reads:

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be

negatived by the manner in which the invention was made".

5. Claims 1-3 are rejected under 35 U.S.C. 103, recited above, as being unpatentable over Karn in view of Brady ('732) or Brady, Jr. et al ('545).

This rejection assumes that the "potential tear line", score or indentation can be on that surface of the paper in contact with an adhesive. Each of Brady ('732) such as Figure 3 and Brady ('545) such as Figures 2 and 3 disclose a similar laminate having the tear line on the adhesive side of the paper. For the tear line of Karn to be on the adhesive side of the paper would be obvious in view of Brady ('732) or Brady ('545). The affidavit filed September 23, 1982 under 37 CFR 1.132 by Robert C. McKee has been given careful consideration, however, the affidavit is insufficient because: (1) there is no side-by-side comparison with the Karn reference which is a crush-cut product and not merely cut; (2) Karn and the instant [4] specification and claims are devoid of clay-coated Kraft paper. This is not an invitation to introduce new matter into the specification and/or claims; (3) the comparison must be identical with the disclosure of the reference, In re Tatincloux et al, 1956 GD 102 (CCPA); (4) it is elementary that the claims presented by applicant must distinguish from the reference disclosure, In re Crecilius, 1937 CD 112.

6. Claims 1-4 are rejected under 35 U.S.C. 103, recited above, as being unpatentable over Karn in view of Cameron Machine Co. Bulletin 4010 and Paper, Film and Foil Converter Publication.

This rejection assumes that there is some structural distinction in the configuration of the tear line of Karn. However, it would be obvious to employ the apparatus of the Bulletin 4010 and the converter publication which show rounded means conventionally used for scoring the paper in Karn. The affidavit referred to immediately above is insufficient for the same reasons given above.

7. Claims 1-4 are rejected under 35 U.S.C. 102(b) as anticipated by Karn because the invention was patented or described in a printed publication in this or a foreign country, more than one year prior to the date of the application for patent in the United States.

Especially note column 13, lines 8-12; column 2, lines 23-32; column 3, lines 51-64 and 70-73, and Figure 5. [5] The "crush-cutting" technique of Karn in column 3, lines 59 is presumed to yield appreciable compacting at the potential tear line. The "thin membranes" in column 3, line 59 and Figure 5 indicate that the paper backing layer is less than one-half of its uncompacted thickness at the potential tear line.

8. Claims 1-4 are rejected on the ground of *res judicata*. The instant micrometer steps or variable pressures in the affidavit is assumed to be a mere amplification of issues in the prior McKee affidavit paper No. 32½ filed October 15, 1979 (cutting limited by rollers or variable pressures), and the Ferrell affidavit paper No. 37 filed January 10, 1980 (cutting limited by bears), the two latter affidavits filed in prior reissue application SN 834,136, now abandoned. Thus, the case law, especially In re Russell 169 USPQ 426 (CCPA 1971) cited by applicant sup-

ports the Examiner's position in this rejection of all claims.

9. In re Dien 214 USPQ 10, suggests one advisory opinion by the Board of Appeals on the same claims as are contained in the patent is enough; even when claims are canceled in In re Bose, 215 USPQ 1.

/s/ W. J. Van Balen
PRIMARY EXAMINER
ART UNIT 164

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11-01-82
FORM PTO 897
(REV. 3-78)

U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE

NOTICE OF REFERENCES CITED
Serial No. 301140, Group Art Unit 164,
Attachment to Paper Number

APPLICANT(S) Burton D. Morgan

U.S. PATENT DOCUMENTS

	Document No.	Date	Name	Class	Sub-class	Filing Date If Appropriate
✓	A 2 3 1 9 2 7 2	5/1943	Starr	428	43	
✓	B 2 4 3 4 5 4 5	1/1948	Brady, Jr., et al.	40	2R	
✓	C 2 6 3 6 2 9 7	4/1953	Johnson	428	41	
✓	D 2 6 8 1 7 3 2	6/1954	Brady	428	41	
✓	E 2 8 0 0 2 1 4	7/1957	Symonds	428	41	
✓	F 2 9 5 6 7 0 3	10/1960	Royal	428	41	
✓	G 3 0 0 6 7 9 3	10/1961	Wheeler, III	428	41	
✓	H 3 0 2 8 2 8 0	4/1962	Hoffman	428	40	
✓	I 3 0 3 1 3 5 9	4/1962	Blank, et al.	428	77	
✓	J 3 0 3 5 9 5 7	5/1962	Morgan	428	41	
✓	K 3 2 3 0 6 4 9	1/1966	Karn	40	2R	

FOREIGN PATENT DOCUMENTS

Document No., Date, Country, Name, Class, Subclass, Pertinent (Illegible)

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M
N
O
P
Q

OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, Etc.)

✓ R Bulletin 4010, Cameron Machine Co., Dover, New Jersey (no date.)

✓ S "Paper, Film and Foil Converter", July 1958, pages 24-28

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U

EXAMINER WILLIAM J. VAN BALEN, PRIMARY EXAMINER ART UNIT 164, Date 10/1/82

A copy of this reference is not being furnished with this office action. (See Manual of Patent Examining Procedure, section 707.05(a).)

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF OHIO
EASTERN DIVISION

Civil Action No. C-76-101A

JUDGE JOHN M. MANOS

MORGAN ADHESIVES COMPANY,

Plaintiff,

vs.

CHEMTROL ADHESIVES, INC.,

Defendant.

BRIEF IN SUPPORT OF PLAINTIFF'S MOTION TO STAY PROCEEDINGS

On March 1, 1977, the USPTO placed into effect a new rule, 35 CFR 1.175 (1977), which allows a patentee to obtain reconsideration of a patent in view of prior art and other information relevant to patentability which may not have been previously considered by the USPTO. The announcement of the new rule was prefaced by an introduction stating that "a Federal Court may, if it chooses, stay proceedings" of litigation during the pendency of the reissue application. 955 *Official Gazette* USPTO 1054 (February 22, 1977). On Friday, September 16, 1977, Morgan forwarded a reissue application to the USPTO and files herewith PLAINTIFF'S MOTION TO STAY PROCEEDINGS pending the outcome of that reissue application.

While a grant or denial of the stay is within the sound discretion of the Court, it is urged that the requested stay will achieve the most efficient disposition

of this litigation without prejudicing the rights of the parties thereto. Chemtrol has argued in Exhibits A and B to its ANSWER AND COUNTERCLAIM and in its BRIEF IN SUPPORT OF DEFENDANT'S MOTION FOR SUMMARY JUDGMENT that had the Karn, Starr, and two Brady patents been before the USPTO during the prosecution of U.S. Patent No. 3,900,645, that patent would not have issued. The new rules of practice promulgated by the USPTO provide a means to determine whether or not there is merit to such an allegation.

The greatest expertise respecting the applicability of prior art to the claimed invention resides in the USPTO and the new rule provides the vehicle by which the Court may avail itself of such expertise. Further, a substantial savings in time, money, and energy of not only the parties but also the Court will be realized if all concerned are allowed to gain the benefit of the consideration given by the USPTO to the issue of applicability of the Karn, Starr, and Brady references to the claimed invention.

A further amendment to the rules, 35 CFR 1.291 (1977), allows members of the public to bring to the attention of the Patent Examiner such prior art, and papers related thereto, as may be deemed relevant to a patent's prosecution. Chemtrol is thus afforded an opportunity to advise the USPTO of its position regarding the applicability of the referenced prior art or any other prior art of which it may become aware. Full consideration may thus be made of the prior art issues at bar via the expertise of the USPTO.

The requested stay of proceedings should not be a lengthy one in that reissue applications are treated as

"special" and "will be acted on by the Examiner in advance of other applications." 37 CFR 1.176 (1977), and *Manual of Patent Examining Procedures* Section 1401.09 (1976). Morgan hereby assures this Court that it will make every effort to expedite the prosecution of its reissue application in order that the Court may have the benefit of the analysis of the USPTO at the earliest possible date. Plaintiff will further make every reasonable effort to be prepared to promptly resume such proceedings at the termination of the prosecution of the reissue application.

Respectfully submitted,

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MORGAN'S REQUEST FOR ADDITIONAL TIME FOR ORAL ARGUMENT BEFORE THE PATENT BOARD OF APPEALS

(Filed August 27, 1980)

REQUEST FOR ADDITIONAL TIME FOR ORAL ARGUMENT

Sir:

The undersigned, attorney for appellant, requests that he be granted an additional ten (10) minutes for oral argument at the hearing scheduled for September 18, 1980, 1:00 P.M. It is particularly requested that five (5) additional minutes be granted for the presentation of appellant's case in chief and that five (5) minutes be provided for rebuttal following the protestor's oral arguments.

The Examiner has maintained five bases of rejection, each of which is brought to the Board on appeal. Each such rejection will require attention at the hearing. If the request is granted, appellant will be provided with twenty-five (25) minutes for his case in chief, or five (5) minutes per main issue.

[2] The need for additional time to fairly present appellant's case is further supported by the sheer volume of material lodged during the prosecution before the Examiner and before this Board on appeal. To briefly touch upon selected topics of those listed in the Table of Contents of Appellant's Appeal Brief will require at least the additional time requested.

In keeping with proper procedure for *inter partes* hearings the moving party (appellant) should be alloted time to rebut arguments of the protestor and to attend to

any new issues which might be raised by the protestor during the oral argument. The requested five (5) minute rebuttal period would afford appellant a minimum of time necessary for a full and fair hearing.

Favorable action on the foregoing request is most earnestly and respectfully solicited from your Honorable Board of Appeals.

Respectfully submitted,

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Supreme Court, U.S.
FILED
AUG 19 1985
JOSEPH F. SPANIOL, JR.
CLERK

(3)

No. 85-20

In the Supreme Court of the United States

October Term, 1985

MORGAN ADHESIVES COMPANY,
Petitioner,

vs.

CHEMTROL ADHESIVES, INC.,
Respondent.

ON CERTIORARI TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

REPLY BRIEF OF PETITIONER

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BEST AVAILABLE COPY

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No. 85-20

In the Supreme Court of the United States

October Term, 1985

MORGAN ADHESIVES COMPANY,
Petitioner,

vs.

CHEMTROL ADHESIVES, INC.,
Respondent.

ON CERTIORARI TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

REPLY OF PETITIONER TO RESPONDENT'S BRIEF IN OPPOSITION

PREFACE

This case involves the question of whether a Federal District Court properly granted summary judgment in favor of Chemtrol Adhesives, Inc. ("Chemtrol") on the grounds that Morgan Adhesives Co. ("Morgan") could no longer prosecute its infringement action because the Patent and Trademark Office ("PTO") had rendered an opinion in an advisory reissue proceeding that the claims of the Morgan patent were unpatentable in light of additional prior art not available to the examiner at the time of the original application, and the PTO's opinion had been affirmed by the Court of Customs and Patent Appeals ("CCPA").

Respondent's allegations that various statements in Morgan's Brief are "patently false" (Chemtrol Brief, pp. 15, 21, n.5), "willful misrepresentation" (*Id.* at p. 27), or advocate a position which "cannot possibly be taken in good faith" (*Id.* at p. 23, n.6) are not supported by the Record.

1. Morgan Did Not Willfully Misrepresent to the Court That the Decision Below Is in Conflict With Opinions From This Court.

As is obvious from Morgan's entire Petition, and particularly the discussion at pages 9-11, the decision below is in conflict with this Court's decisions in *McCormick Machine Co. v. Aultman,* 169 U.S. 606 (1897) and *Allen v. Culp,* 166 U.S. 501 (1897), that:

> Although the PTO has the power to grant a patent, only the Courts of the United States have the power to invalidate a patent.

Morgan Petition at p. 9. In this case, the District Court, as affirmed by the CAFC, held that Morgan was precluded from arguing that its patent is valid because of an advisory opinion rendered by the Patent Office and reviewed by the CCPA that the claims were not patentable in light of additional prior art not available to the examiner at the time of the original application. This holding, in our case, is in direct conflict with *McCormick, supra,* and *Allen, supra,* in that it permits the PTO to invalidate a patent which it had issued. Nor does review of the PTO action by the CCPA require a different result, as more fully set forth in the discussion and cases at pages 11 through 13 and 17 through 20 of Morgan's Petition. The PTO invalidated Morgan's patent in this case through the back door, contrary to longstanding precedent of this Court.

2. Morgan Did Not Have an Opportunity to Argue the Commercial Success of Its Patent as a Defense Against the Charge of Invalidity in the Proceedings Before the PTO and CCPA.

No evidence, testimony, or argument was presented to the PTO on commercial success. Rather, the proceedings were dedicated to arguing the only issue before the PTO—whether the PTO record should reflect that additional prior art was considered at the time of the original application. As pointed out in Morgan's Petition at pp. 20-21, commercial success could not have been argued and would not have been relevant in a no-defect proceeding before the PTO because the only purpose of that proceeding was to determine whether the patent would have issued *at the time of the original application* had the examiner been aware of the prior art. Commercial success after issuance was irrelevant in that proceeding. In contrast, in the case at bar, when prior art is alleged to invalidate a patent years after its issuance, secondary considerations, including commercial success:

> . . . may often establish that an invention appearing to have been obvious in light of the prior art was not.

Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1538-39 (C.A.F.C. 1983).

3. The Court, Not Morgan, Converted the No-Defect Proceeding to a Regular Reissue.

Conversion of a no-defect proceeding under 37 C.F.R. §1.175(a)(4) into a regular reissue can occur only upon compliance with the other subsections of that regulation as well as 35 U.S.C. §251. The provisions of MPEP §1414.02 are not controlling:

> Appellant's reissue application was filed pursuant only to 37 C.F.R. 1.175(a)(4) and has not been converted to a regular reissue application under 35 U.S.C. §251 complying with the other provisions of §1.175.

In Re Bose, 687 F.2d 432 (C.C.P.A. 1982). If, indeed, courts were bound by MPEP §1414.02, the Court in *In Re Bose, supra*, would have reached an opposite result. The patent-holder in that case amended the patent claims during no-defect reissue proceedings by striking certain claims. Nevertheless, the Court held, the PTO's rejection of certain claims was purely advisory. Morgan did not comply with the other provisions of §1.175 and did not convert the advisory reissue into a regular reissue.

4. The CCPA Rendered an Advisory Opinion "in the Teeth of" Precedent to the Contrary.

Chemtrol claims there could have been no precedent for the CCPA to disregard in 1981 because *In Re Dien*, 680 F.2d 151 (C.C.P.A. 1982), was not decided until 1982. Precedent that a Court cannot render an advisory opinion appears in Article III, Section 2 of the United States Constitution, as well as numerous decisions of this Court. *See, e.g., Muskrat v. United States*, 219 U.S. 346 (1910); *Glidden Co. v. Zdanok*, 370 U.S. 530, 587, 602 (1962). The proceeding in this case was advisory when initiated in 1977 and advisory when the CCPA rendered its opinion in 1981. *See, e.g., Bally Manufacturing Corp. v. Diamond*, 629 F.2d 955, 957-58 (4th Cir. 1980), noting, in 1980, that reissue proceedings under 37 C.F.R §175(a)(4), were "purely advisory." Even the CCPA admitted its "awakening" to the fact that it was rendering advisory opinions in these cases was "belated." *In Re Dien, supra.* The CCPA had no more jurisdiction to render an advisory opinion in 1981 than it did in 1982.

5. Morgan Did Not Surrender Its Patent by Invoking the No-Defect Reissue Proceeding.

Finally, Morgan wishes to clear up any confusion caused by Chemtrol's repeated assertions that Morgan "actually surrendered" its patent in the no-defect reissue proceeding. Chemtrol Brief, pp. 3, 21, 22. In support of that allegation, Chemtrol miscites to "A. 76" (Chemtrol Brief, p. 3). It is assumed that Chemtrol intended to cite to A. 71, where Petitioner Burton Morgan:

> . . . prays that he may be allowed to surrender the Letters Patent . . .

as part of his reissue application. As explained by Morgan in its Petition at p. 10, a patentholder invoking a reissue proceeding of *any* type—advisory or regular—must offer to surrender the patent to the PTO. No "actual" surrender takes place unless a reissue is granted. If the reissue is not granted, the patent is retained and not surrendered. *Allen v. Culp*, 166 U.S. 501, 505 (1897); 37 C.F.R. §1.178. *See also, Dresser Industries, Inc. v. Ford Motor Co.*, 530 F. Supp. 303, 309 (N.D. Tex. 1981), stating that "This has been the law for eight decades." In fact, when the offer to surrender is made as part of a no-defect reissue proceeding, the offer itself is no more than a semantic technicality. Since the PTO provides only an advisory opinion, the patent would never be surrendered to the PTO unless the patentholder were to make additional oaths and take additional steps necessary to convert the no-defect proceeding into a regular reissue proceeding. *In Re Dien, supra*, 680 F.2d at 152-153.

ARGUMENT

Morgan responds to new matter raised by Chemtrol as follows.

A. The Trial Court Can Determine the Validity of the Morgan Patent Without Contradicting the CCPA or the PTO.

The Trial Court in this case was not faced with a dilemma of choosing between precluding Morgan from arguing the validity of its patent or "contradicting" the PTO and the CCPA for two reasons. First, the role of the no-defect proceeding is to provide an advisory opinion helpful to the Trial Court—not render a decision binding on the Trial Court. As noted in *Bally Manufacturing Corp. v. Diamond, supra,* 629 F.2d at 958:

> The examiner's expert opinion may carry substantial weight in an infringement action involving the same patent and prior art.

See also, Dresser Industries, Inc. v. Ford Motor Co., supra, 530 F. Supp. 303, where the Court noted that granting a stay of infringement proceedings and ordering a patentholder to submit to reissue proceedings, regular or advisory, was equivalent to appointing an expert for technical assistance to the Court (530 F. Supp. at 313, n.14) and would not deprive the patentholder of due process or a jury trial since the PTO opinion would be purely advisory. *Id.* at 309-12.

The Trial Court would not be contradicting the CCPA since the CCPA decision was advisory and would not bind the Trial Court. Morgan Petition at pp. 17-20.

Second, the Trial Court would not be contradicting the decision of the PTO or the CCPA because the narrow issue in the no-defect proceeding was whether the patent record, at the time of the original application, should reflect that additional prior art had been considered. In a trial on the validity of the patent, a Court must consider not only primary factors, such as obviousness in the light of prior art, but secondary factors as well. These secondary factors, such as commercial success, may arise *after* the issuance of the patent. Such evidence indicates that in hindsight, considering the success of the patent and imitation of its method by competitors, the patent was not obvious in light of the prior art available at the time of the original application. Morgan Petition, pp. 20-22 and cases cited therein; *National Business Systems v. AM International, Inc.*, 743 F.2d 1227 (7th Cir. 1984), *cert. denied*, 53 U.S.L.W. 3808 (1985). If allowed by this Court, Morgan will present evidence to the Trial Court not only that its patent has enjoyed a huge commercial success since its issuance, but that its novelty is such that other competitors have gradually adopted its method, until, at the present time, every major competitor copies this patent.

B. Trial Court Decisions Cited by Chemtrol Indicating That the PTO May Invalidate a Patent Are Not Authoritative and Are Not Persuasive.

In its Brief before this Court, as it has in briefs before the lower courts, Chemtrol relies heavily upon *California Computer Products, Inc. v. Simplicity Pattern Co.*, 194 U.S.P.Q. 367 (C.D. Cal. 1977) and *W.R. Altenpohl, Inc. v. Gainesville Machine Co.*, 185 U.S.P.Q. 500 (N.D. Ga. 1974) for its contention that Morgan is precluded by the decision of the PTO, as reviewed by the CCPA, from arguing the

validity of its patent in the Trial Court. The Trial Court also erroneously relied upon these cases.

As is apparent from the segment quoted in Chemtrol's Brief, p. 12, the trial court in *Computer Products* ignored the law of this Court that a reissue proceeding cannot invalidate a patent (*McCormick, supra; Allen, supra*), by stating that after a rejection of a reissue is affirmed by the CCPA the patentholder "has no patent." The PTO can neither invalidate nor nullify a patent in a reissue proceeding. Appellate review of a PTO decision in a reissue proceeding, as provided for by statute, can neither invalidate nor nullify a patent when the agency below had no such power.

The analysis of *Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation,* 402 U.S. 313 (1971), cannot be lifted from the context of that case, where the validity of the patent in question had been litigated in a prior infringement suit, and applied directly to the situation in our case where the prior proceeding was merely an advisory reissue before the PTO. The purpose of the PTO proceeding was to go back in time and provide an advisory opinion of what an examiner would have done had additional prior art been considered at the time of the original application. The purpose of the court proceeding is to determine whether, at today's date, a patentholder may enforce the rights granted by the patent against an infringer. The issues are not identical because the contexts are radically different.

Similarly, the *Blonder-Tongue* concept of a full and fair hearing does not apply where, in the prior proceeding, a patentholder is seeking to have the record of the original issue reflect additional prior art *and the body hearing the request has no power to invalidate the patent.*

The differences in the purposes of the two proceedings, the expectations of the parties, and the powers of the hearing officer or trial judge in this case are so great as to preclude a finding that certain issues were identical in the two or that one hearing could be determinative of both proceedings. The Trial Court's attempt to force this case into a *Blonder-Tongue* analysis is fatally flawed because it produces a result in direct conflict with this Court's doctrine that the PTO cannot invalidate a patent once issued. The error is not cured by the fact that it follows the flawed reasoning of two other trial courts.

Finally, even if the cases cited by Chemtrol were authoritative or were persuasive as to regular, defect reissues, it is obvious that they would not be dispositive of this case, where the patentholder sought and received an advisory opinion and review of that opinion by the CCPA was void and of no effect.

CONCLUSION

Morgan respectfully requests this Court to reverse summarily the cases below and remand this case for trial on the merits of the patent, as provided in Supreme Court Rule 23.1:

> After consideration of the papers distributed pursuant to Rule 22, the Court will enter an appropriate order. The order may be a summary disposition on the merits.

See, e.g., Flower v. United States, 407 U.S. 197 (1972), granting certiorari and summarily reversing and remanding without full argument.

Summary disposition is appropriate in this case because by granting preclusive effect to the PTO's decision of in-

validity, the Trial Court effectively ruled that the Patent Office has the power to invalidate a patent once issued, in direct contradiction to prior decisions of this Court, including *McCormick, supra,* and *Allen, supra,* thereby depriving Morgan of its valuable property rights without due process of law.

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